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Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,

Petitioner,

v.

DANIEL L. FLAMM,

Patent Owner.

CASE IPR2015-01768
U.S. Patent No. RE40,264 E

**JOINT MOTION TO TERMINATE PROCEEDING IN VIEW OF
SETTLEMENT PURSUANT TO 35 U.S.C. §317(a),**

**JOINT NOTICE OF SETTLEMENT PURSUANT TO 35 U.S.C.
§317(b) AND 37 C.F.R. § 42.74, AND**

**JOINT REQUEST TO KEEP SEPARATE PURSUANT TO 35 U.S.C.
§317(b) AND 37 C.F.R. § 42.74(c)**

The Patent Owner, Daniel L. Flamm, and the Petitioner, Lam Research Corp. (collectively “the Parties”) have entered into a confidential settlement agreement, Confidential Binding Memorandum of Understanding dated December 1, 2016 (“MOA”), that resolves all underlying disputes related to U.S. Patent No. RE40,264 E between the parties, including IPR2015-01768. The Parties are submitting a copy of the MOA (Exhibit 2009) with the PTAB, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

Statement of Precise Relief Requested

The Parties jointly request that the Board terminate this *Inter Partes* Review (“IPR”) and that the Board treat the MOA as business confidential information and keep it separate from the file of the involved patent, and made available only to Federal Government agencies on written request or to any person only on a showing of good cause.

Related Proceedings

Related IPR Proceedings

In addition to the instant proceeding, Lam submitted six petitions for *inter partes* review of the ‘264 patent, one petition for *inter partes* review of U.S. Patent No. 5,711,849 (“the ‘849 patent”), and one petition for *inter partes* review of U.S.

Patent No. 6,017,221 (“the ‘221 patent”).¹ In addition, Samsung Electronics Co., Ltd. has submitted two petitions for *inter partes* review of the ‘264 patent, Intel Corporation has submitted four petitions for *inter partes* review of the ‘264 patent, and Micron Technology, Inc. has submitted one petition for *inter partes* review of the ‘849 patent and one petition for *inter partes* review of the ‘221 patent. Each of these petitions is described below:

IPR Petitions Directed Toward RE40,264		
Petitioner	Petition No.	Status
Lam Research Corp.	IPR2015-01759	PTAB denied institution of the petition.
Lam Research Corp.	IPR2015-01764	Concurrent herewith, the Parties are jointly moving to terminate the petition under 35 U.S.C. § 317(a).
Lam Research Corp.	IPR2015-01766	PTAB denied institution of the petition.
Lam Research Corp.	IPR2016-0468	PTAB denied institution of the petition.
Lam Research Corp.	IPR2016-0469	PTAB denied institution of the petition.
Lam Research Corp.	IPR2016-00470	PTAB denied institution of the petition.
Samsung Electronics Co., Ltd.	IPR2016-01510	Dr. Flamm submitted his preliminary opposition to the petition on November 25, 2016.

¹ Dr. Flamm is the inventor or co-inventor of the ‘849 and the ‘221 patents and currently owns both of those patents. The ‘849 and ‘221 patents are at issue in related district court proceedings that are summarized below.

IPR Petitions Directed Toward RE40,264		
Petitioner	Petition No.	Status
Samsung Electronics Co., Ltd.	IPR2016-01512	Dr. Flamm submitted his preliminary opposition to the petition on November 25, 2016.
Intel Corporation	IPR2017-0279	Intel filed the petition on December 2, 2016.
Intel Corporation	IPR2017-0280	Intel filed the petition on December 2, 2016.
Intel Corporation	IPR2017-0281	Intel filed the petition on December 2, 2016.
Intel Corporation	IPR2017-0282	Intel filed the petition on December 2, 2016.

IPR Petitions Directed Toward 5,711,849		
Petitioner	Petition No.	Status
Lam Research Corp.	IPR2016-0466	PTAB denied institution of the petition.
Micron Technology, Inc.	IPR2017-0392	Micron filed the petition on December 4, 2016.
Micron Technology, Inc.	IPR2017-0406	Micron filed the petition on December 4, 2016.

IPR Petitions Directed Toward 6,017,221		
Petitioner	Petition No.	Status
Lam Research Corp.	IPR2016-01767	Concurrent herewith, the Parties are jointly moving to terminate the petition under 35 U.S.C. § 317(a).
Micron Technology, Inc.	IPR2017-0391	Micron filed the petition on December 2, 2016.

Related District Court Proceedings

The '264 patent, the '849 patent, and the '221 patent are at issue in the following district court actions, all of which are pending in the United States

District Court for the Northern District of California:

Case	Status
<i>Lam Research Corp. v. Daniel L. Flamm</i> , 5:15-cv-01277-BLF	The case has been voluntarily dismissed pursuant to the MOA.
<i>Daniel L. Flamm v. GLOBALFOUNDRIES U.S., Inc.</i> , 5:16-cv-01578-BLF	The case has been stayed pending the resolution of this IPR, IPR2015-01764, and IPR2015-01767.
<i>Daniel L. Flamm v. Intel Corporation</i> , 5:16-cv-01579-BLF	The case has been stayed pending the resolution of this IPR, IPR2015-01764, and IPR2015-01767.
<i>Daniel L. Flamm v. Maxim Integrated Products, Inc.</i> , 5:16-cv-01580-BLF	The case has been stayed pending the resolution of this IPR, IPR2015-01764, and IPR2015-01767.
<i>Daniel L. Flamm v. Micron Technology, Inc.</i> , 5:16-cv-01581-BLF	The case has been stayed pending the resolution of this IPR, IPR2015-01764, and IPR2015-01767.
<i>Daniel L. Flamm v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor, LLC</i> , 5:16-cv-02252-BLF	The case has been stayed pending the resolution of this IPR, IPR2015-01764, and IPR2015-01767.

Argument for Termination

Public Policy favors terminating the present *inter partes* review proceeding. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne*

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