

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SK HYNIX INC., SK HYNIX AMERICA INC.,
SK HYNIX MEMORY SOLUTIONS INC., and
HYNIX SEMICONDUCTOR MANUFACTURING AMERICA INC.,
Petitioner,

v.

DSS TECHNOLOGY MANAGEMENT, INC.,
Patent Owner.

Case IPR2016-00192
Patent 6,784,552 B2

Before BRYAN F. MOORE, BRIAN J. McNAMARA, and
MINN CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

ORDER AUTHORIZING FILING OF MOTION TO TERMINATE
Conduct of the Proceeding
37 C.F.R. § 42.5

In an e-mail correspondence on August 24, 2016, the parties advised the Board that a settlement agreement had been reached in the current *inter partes* review of U.S. Patent No. 6,784,552 B2 (the subject patent) and requested authorization to file a Motion to Terminate the matter. The parties may agree to settle any issue in a proceeding pursuant to a written agreement, a copy of which shall be filed with the Board before termination of the trial. 37 C.F.R. § 42.74(a)-(b). Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding made in connection with, or in contemplation of, the termination of an *inter partes* review shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of such review as between the parties. 35 U.S.C. § 317(b).

A Decision on Institution instituting a trial in this proceeding was entered on May 11, 2016. Paper 8. On August 11, 2016, a Patent Owner's Response was filed, which stated that the parties are engaged in settlement negotiations and that, in anticipation of expected settlement, Patent Owner has foregone deposition of Petitioner's expert witness and is not submitting substantive arguments against the grounds for invalidity asserted by Petitioner. Paper 10, 2. Under these circumstances, it may be appropriate to enter judgment and terminate the trial without rendering a final written decision. 37 C.F.R. § 42.72.

The parties are authorized to file a Joint Motion To Terminate this proceeding. The Joint Motion To Terminate must update the Board concerning the status of any litigation or proceeding, including, but not

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limited to proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint Motion To Terminate also must include a copy of any agreement and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. A party to a settlement may request that any written agreement be treated as business confidential information and be kept separate from the files of an involved patent. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). The request must be filed with the settlement agreement. *Id.*

It is **ORDERED** that the parties are authorized to file a Joint Motion To Terminate the proceeding and a Joint Request That The Settlement Agreement Be Treated As Business Confidential Information.

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