

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.,
Petitioners,

v.

DSS Technology Management, Inc.,
Patent Owner.

Case IPR2016-00192
Patent 6,784,552 B2

PATENT OWNER AND PETITIONERS'
JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a)-(b), Patent Owner DSS Technology Management, Inc. (“DSS” or “Patent Owner”) and Petitioners SK hynix Inc., SK hynix America Inc., SK hynix memory solutions Inc., and Hynix Semiconductor Manufacturing America Inc., (“Hynix” or “Petitioners”) hereby jointly move the Patent Trial and Appeal Board (“Board”) to terminate this *Inter Partes* Review of U.S. Patent No. 6,784,552 B2 (Case No. IPR2016-00192).

I. REASONS FOR GRANTING THE JOINT MOTION TO TERMINATE

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing this motion by way of an Order authorizing the filing of a motion to terminate. *See* Paper No. 11 (Aug. 25, 2016) (“the Order”). Guidance as to the content of a motion to terminate is provided in the Order. The Board indicated that the joint motion to terminate should (a) update the Board concerning the status of any litigation or proceeding, including, but not limited to proceedings in the U.S. Patent and Trademark Office, involving the subject patent; (b) advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future; and (c) 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. Paper No. 11 at 2-3. This motion satisfies each of the

above requirements and is accompanied by the Parties' settlement agreement (Ex. 1012), as required by 35 U.S.C. § 317(b) and 35 C.F.R. § 42.74 (b)-(c).

A. Termination is Appropriate

Termination is appropriate under 35 U.S.C. § 317(a) because oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. Petitioners filed its petition for *inter partes* review on November 12, 2015, and trial was instituted on May 11, 2016.

Petitioners and Patent Owner have resolved their dispute and have entered into a written settlement agreement to, *inter alia*, jointly request termination of this *inter partes* review. A true and correct copy of the settlement agreement is being filed herewith as Exhibit 1012, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). The underlying district court litigation between DSS and Hynix is pending dismissal.

Thus, termination of the proceeding satisfies the Congressional goal of establishing a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* "Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents," Final Rule, 77 Fed. Reg., No. 157, p. 48680 (Tuesday, August 14, 2012). By permitting termination of review proceedings as to all Parties, upon settlement of their disputes, the USPTO

provides a measure of certainty as to the outcome of such proceedings. Such certainty helps foster an environment that promotes settlements, creating a timely, cost-effective alternative to litigation. Further, pursuant to 35 U.S.C. § 317(a), no estoppel shall attach to Petitioners or their privies.

B. Status of Related Litigations

U.S. Patent No. 6,784,552 B2 is at issue in the following pending litigations:

- *DSS Tech. Mgmt., Inc., v. Intel Corp., et al.*, No. 6:15-cv-130, (E.D. Tex.) (“*Intel*”);
- *DSS Tech. Mgmt., Inc., v. Qualcomm Inc.*, No. 6:15-cv-692, (E.D. Tex.) (“*Qualcomm*”);
- *DSS Tech. Mgmt., Inc., v. Samsung Elecs. Co., Ltd., et al.*, No. 6:15-cv-690, (E.D. Tex.) (“*Samsung*”);
- *DSS Tech. Mgmt., Inc., v. SK hynix Inc., et al.*, No. 6:15-cv-691, (E.D. Tex.) (“*Hynix*”)¹;

In *Intel*, on March 18, 2016, the U.S. District Court for the Eastern District of Texas entered an Order staying the case pending a final written decision from the

¹ On October 28, 2015, Judge Gilstrap entered an order consolidating the *Qualcomm*, *Samsung*, and *Hynix* cases.

Board on IPR2016-00287, IPR2016-00288², IPR2016-00289, and IPR2016-00290 (“the Intel IPRs”). Shortly thereafter, on April 5, 2016, Judge Gilstrap entered an order staying the *Qualcomm*, *Samsung*, and *Hynix* cases pending final written decisions in the Intel IPRs.

C. Status of Related Proceedings

As mentioned above, the ’552 Patent is also at issue in IPR2016-00287 and IPR2016-00288. On June 8, 2016, the Board instituted IPR2016-00287 and IPR2016-00288. Patent Owner’s response is due on September 8, 2016 in IPR2016-00287 and IPR2016-00288.

The ’552 Patent is also at issue in IPR2016-01311 and IPR2016-01314 (“the Qualcomm IPR Petitions”). Qualcomm filed both of its petitions requesting *inter partes* review on July 1, 2016. The Board has yet to issue its institution decision on the Qualcomm IPR Petitions.

The ’552 Patent is also at issue in IPR2016-00782 (“the Samsung IPR Petition”). Samsung filed its petition requesting *inter partes* review on March 18, 2016. The Board has yet to issue its institution decision on the Samsung IPR Petition.

² U.S. Patent No. 6,784,552 B2 (“the ’552 Patent”) is only challenged by Intel in IPR2016-00287 and IPR2016-00288.

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