

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE USA, Inc.,
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-00664
Patent 5,812,789

Before MICHAEL R. ZECHER, JAMES B. ARPIN, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Termination of the Proceeding and
Dismissal of Petitioner's Renewed Motion for Joinder
37 C.F.R. §§ 42.72, 42.74, and 42.122(b)

I. DISCUSSION

On August 19, 2016, the parties filed a Joint Motion to Terminate this proceeding (Paper 12), a true copy of the parties' settlement agreement (Ex. 2001), and a request to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 14).

This proceeding is still in its preliminary stages. On February, 26, 2016, Petitioner, ZTE USA, Incorporated ("ZTE"), filed a Petition requesting an *inter partes* review of claims 1, 3–6, 11, and 13 of U.S. Patent No. 5,812,789 (Ex. 1001, "the '789 patent"). Paper 2. ZTE filed its Petition along with an initial Motion for Joinder requesting that we join ZTE as a party with *Samsung Elecs. Co. v. Parthenon Unified Memory Architecture LLC*, Case IPR2015-01944 ("Samsung IPR"). Paper 3. As we explained in an Order dated June 8, 2016, we instituted an *inter partes* review in the Samsung IPR on March 30, 2016, and we granted a Joint Motion to Terminate the Samsung IPR on May 25, 2016. Paper 10, 3. As a consequence, we dismissed without prejudice ZTE's initial Motion for Joinder and authorized ZTE to file a renewed Motion for Joinder that seeks joinder with a Petition filed by Apple Incorporated ("Apple") requesting an *inter partes* review of claims 1, 3–6, 11, and 13 of the '789 patent (Case IPR2016-00923, "Apple IPR"). On June 15, 2016, ZTE filed a Renewed Motion for Joinder requesting that we join ZTE as a party with the Apple IPR. Paper 11. Patent Owner, Parthenon Unified Memory Architecture, Limited Liability Company, waived its right to file a Preliminary Response in this proceeding. Paper 9. We have not entered a decision whether or not to institute an *inter partes* review.

In the Joint Motion to Terminate this proceeding, the parties represent that they have settled all of their disputes regarding the '789 patent. Paper 12, 2. The parties further represent that the '789 patent was asserted against multiple

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companies in the United States District Court for the Eastern District of Texas. *Id.* In addition to this proceeding, the parties represent that they are involved in the following proceedings before the Board: (1) Case IPR2016-00665; (2) Case IPR2016-00666; (3) Case IPR2016-0667; and (4) Case IPR2016-00670. *Id.* at 3. According to the parties, they are in the process of filing a Joint Motion to Terminate in each of these proceedings. *Id.* Lastly, the parties represent that the '789 patent remains at issue in the following proceedings before the Board: (1) Case IPR2016-00847; (2) Case IPR2016-00923; and (3) Case IPR2016-01135. *Id.* Under these particular circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decisions. *See* 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' request to treat the settlement agreement (Ex. 2001) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED;

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is GRANTED, and this proceeding is hereby terminated; and

FURTHER ORDERED that, because this proceeding has been terminated, ZTE's Renewed Motion for Joinder is dismissed as moot.

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