

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC., and
LG ELECTRONICS, INC.

Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-00847
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 Only as to LG Electronics, Inc.
37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

On August 15, 2016, Petitioner entity, LG Electronics, Incorporated (“LG”), and Patent Owner, Parthenon Unified Memory Architecture Limited Liability Corporation (“Parthenon”), filed a Joint Motion to Terminate this proceeding only as to LG (Paper 13), a true copy of the 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 April 7, 2016, LG, along with remaining Petitioner entities, HTC Corporation and HTC America, Incorporated (collectively, “HTC”), 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 1. Parthenon 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 only as to LG, LG and Parthenon represent that they have settled their disputes regarding the ’789 patent. Paper 13, 2. LG and Parthenon further represent that the ’789 patent was asserted against multiple companies in the United States District Court for the Eastern District of Texas. *Id.* at 2–3. In addition to this proceeding, LG and Parthenon represent that they are parties in the following proceedings before the Board: (1) Case IPR2015-01500; (2) Case IPR2015-01501; (3) Case IPR2015-01502; and (4) Case IPR2016-00848. *Id.* at 3. According to LG and Parthenon, they are in the process of filing a Joint Motion to Terminate in each of these proceedings. *Id.* Lastly, LG and Parthenon represent that the ’789 patent remains at issue in the following proceedings before the Board: (1) Case IPR2016-00664; (2) Case IPR2016-00923; and (3) Case IPR2016-01135. *Id.* Under these particular

circumstances, we determine that it is appropriate to terminate this proceeding only as to LG. *See* 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that LG's and Parthenon's joint 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 only as to LG is GRANTED, and LG may no longer participate as a party in this proceeding; and

FURTHER ORDERED that HTC and Parthenon will continue to participate in this proceeding as adversarial parties.

IPR2016-00847
Patent 5,812,789

For PETITIONER:

Joseph A. Micallef
Samuel A. Dillon
SIDLEY AUSTIN LLP
jmicallef@sidley.com
samuel.dillon@sidley.com

Rajeev Gupta
Joshua Goldberg
Michael V. Young
Elizabeth Niemeyer
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
Raj.gupta@finnegan.com
LGE-CCE-IPR@finnegan.com
Michael.Young@finnegan.com
Elizabeth.Niemeyer@finnegan.com

For PATENT OWNER:

Masood Anjom
Scott Clark
AHMAD, ZAVITSANOS, ANAIPAKOS, ALAVI & MENSING P.C.
manjom@azalaw.com
sclark@azalaw.com