

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

ADVANCED SILICON TECHNOLOGIES LLC,
Patent Owner.

Case IPR2016-01026 (Patent 6,546,439 B1);
Case IPR2016-01060 (Patent 8,933,945 B2);
Case IPR2016-01374 (Patent 6,339,428 B1)¹

Before KRISTEN L. DROESCH, PATRICK R. SCANLON, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

GERSTENBLITH, *Administrative Patent Judge*.

DECISION

Termination and Settlement

35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Decision addresses issues that apply to the three cases. We, therefore, exercise our discretion to issue one Decision to be filed in each of the cases. The parties are not authorized to use this heading style in their papers.

Case IPR2016-01026 (Patent 6,546,439 B1)

Case IPR2016-01060 (Patent 8,933,945 B2)

Case IPR2016-01374 (Patent 6,339,428 B1)

I. DISCUSSION

In an e-mail dated October 5, 2016, we authorized the parties to file joint motions to terminate the instant proceedings with true copies of their agreement(s) in contemplation of termination and joint motions to treat the filed copies of their agreement(s) as business confidential information under 37 C.F.R. § 42.74(c). On October 6, 2016, the parties filed a Joint Motion to Terminate Under 35 U.S.C. § 317(a) (Paper 9²), a copy of a written Settlement Agreement (Ex. 1014), and a Joint Motion to Keep Confidential Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 10) in each of the proceedings.³

The parties indicate that they have settled their underlying dispute and have agreed to terminate these proceedings. Paper 9, 2. The parties filed what they represent is a true and accurate copy of their written confidential settlement agreement (“Settlement Agreement”), and indicate that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of these proceedings. *Id.* The parties further indicate that the Settlement Agreement resolves all underlying disputes between the parties with respect to other cases before the

² Citations are to IPR2016-01026, unless otherwise indicated.

³ The parties filed these documents, respectively, in each of the instant proceedings as follows:

- IPR2016-01060: Paper 9, Exhibit 1017, and Paper 10; and
- IPR2016-01374: Paper 9, Exhibit 1009, and Paper 10.

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U.S. International Trade Commission Investigation, and the U.S. District Court for the District of Delaware. *Id.* at 2, 5–7.

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). For the petitions for *inter partes* review before us, trial has not yet been instituted, and the merits of the proceedings have not been decided. *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate . . .”). We are persuaded that, under these circumstances, termination of these proceedings is appropriate.

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Accordingly, it is

ORDERED the parties’ Joint Motion to Terminate Under 35 U.S.C. § 317(a) (IPR2016-01026, Paper 9; IPR2016-01060, Paper 9; and IPR2016-01374, Paper 9) in each of the instant proceedings is *granted*;

FURTHER ORDERED that the parties’ Joint Motion to Keep Confidential Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (IPR2016-01026, Paper 10; IPR2016-01060, Paper 10; and IPR2016-01374, Paper 10) in each of the instant proceedings is *granted*;

Case IPR2016-01026 (Patent 6,546,439 B1)

Case IPR2016-01060 (Patent 8,933,945 B2)

Case IPR2016-01374 (Patent 6,339,428 B1)

FURTHER ORDERED that the Settlement Agreement (IPR2016-01026, Exhibit 1014; IPR2016-01060, Exhibit 1017; and IPR2016-01374, Exhibit 1009) in each of the instant proceedings shall be kept separate from the file of the above-referenced patents, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that each of these proceedings is terminated.

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Case IPR2016-01060 (Patent 8,933,945 B2)

Case IPR2016-01374 (Patent 6,339,428 B1)

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