

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TEXAS INSTRUMENTS INCORPORATED,  
Petitioner,

v.

ADVANCED SILICON TECHNOLOGIES LLC,  
Patent Owner.

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Case IPR2016-01108 (Patent 8,933,945 B2)

Case IPR2016-01178 (Patent 6,339,428 B1)

Case IPR2016-01266 (Patent 6,546,439 B1)<sup>1</sup>

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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

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

Case IPR2016-01108 (Patent 8,933,945 B2)

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## I. DISCUSSION

In an e-mail dated July 28, 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 the same day, the parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 7<sup>2</sup>), a copy of a written Settlement Agreement (Ex. 1013), and a Joint Request to File Settlement Agreement as Business Confidential Information and to Maintain Said Agreement Separate from the Public File Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 8) in each of the proceedings.<sup>3</sup>

The parties indicate that they have settled their underlying dispute and have agreed to terminate these proceedings. Paper 7 at 1–2. The parties filed what they represent is a true and correct copy of their written 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.* at 2. The parties further indicate that they filed a joint motion to terminate a related U.S. International Trade

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<sup>2</sup> Citations are to IPR2016-01108, unless otherwise indicated.

<sup>3</sup> The parties filed these documents in IPR2016-01178 as Paper 6, Exhibit 1013, and Paper 7, respectively, and in IPR2016-01266 as Paper 6, Exhibit 1011, and Paper 7, respectively.

Case IPR2016-01108 (Patent 8,933,945 B2)

Case IPR2016-01178 (Patent 6,339,428 B1)

Case IPR2016-01266 (Patent 6,546,439 B1)

Commission Investigation, and will file a stipulation or notice to dismiss their related district court litigation. *Id.* at 1–2.

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 that the parties’ Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (IPR2016-01108, Paper 7; IPR2016-01178, Paper 6; IPR2016-01266, Paper 6) is *granted*;

FURTHER ORDERED that the parties’ Joint Request to File Settlement Agreement as Business Confidential Information and to Maintain Said Agreement Separate from the Public File Pursuant to 35 U.S.C.

Case IPR2016-01108 (Patent 8,933,945 B2)

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§ 317(b) and 37 C.F.R. § 42.74(c) (IPR2016-01108, Paper 8;

IPR2016-01178, Paper 7; IPR2016-01266, Paper 7) is *granted*;

FURTHER ORDERED that the Settlement Agreement (IPR2016-01108, Exhibit 1013; IPR2016-01178, Exhibit 1013; IPR2016-01266, Exhibit 1011) 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.

Case IPR2016-01108 (Patent 8,933,945 B2)

Case IPR2016-01178 (Patent 6,339,428 B1)

Case IPR2016-01266 (Patent 6,546,439 B1)

For PETITIONER:

Gregory S. Discher

David A. Garr

Andrea G. Reister

COVINGTON & BURLING LLP

[gdischer@cov.com](mailto:gdischer@cov.com)

[dgarr@cov.com](mailto:dgarr@cov.com)

[areister@cov.com](mailto:areister@cov.com)

For PATENT OWNER:

William Meunier

Michael T. Renaud

Adam S. Rizk

MINTZ, LEVIN, COHEN, FERRIS, GLOVSKY AND POPEO, P.C.

[wameunier@mintz.com](mailto:wameunier@mintz.com)

[mtrenaud@mintz.com](mailto:mtrenaud@mintz.com)

[arizk@mintz.com](mailto:arizk@mintz.com)