

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING CO., LTD,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

IPR2017-01841¹
Patent 7,893,501

**JOINT MOTION TO TERMINATE THE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
Alexandria, VA 22313-1450

¹ Case IPR2017-01842 has been consolidated with this proceeding. Substantially the same paper was filed in IPR2017-01843 (which has been consolidated with IPR2017-01844) and IPR2017-01862.

Pursuant to 35 U.S.C. § 317(a), Petitioner Taiwan Semiconductor Manufacturing Co., LTD (“Petitioner”) and Patent Owner Godo Kaisha IP Bridge 1 (“Patent Owner”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 7,893,501 (the “’501 patent”), Case Nos. IPR2017-01841 and IPR2017-01842.

On January 14, 2019, the Parties notified the Board that the Parties reached a settlement related to the ’501 patent. As a result of that settlement, there are no longer any disputes between the parties involving the ’501 patent. On that basis, the Parties requested permission to file a joint motion to terminate IPR2017-01841 and IPR2017-01842. On January 14, 2019, the Board authorized the Parties, via email, to file a joint motion to terminate.

The parties have settled their dispute and have reached agreement to terminate IPR2017-01841 and IPR2017-01842. This Settlement Agreement has been made in writing, and a true and correct copy shall be filed with this Office as business confidential pursuant to 35 U.S.C. § 317(b).

Termination of this IPR is appropriate because the Board has not yet “decided the merits of the proceeding.” *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). The merits have not been decided because this proceeding is in a preliminary stage, that is, no decision on institution has been entered. *See, e.g., AM General LLC v. Uusi, LLC*, IPR2016-

01050, Paper 44 (Nov. 7, 2017) (terminating an IPR after the oral hearing); *Lam Research Corp. v. Daniel L. Flamm*, IPR2015-01764, IPR2015-01767, IPR2015-01768 Paper 27 (Dec. 15, 2016) (same); *Hydrite Chemical Co. v. Solenis Technologies, L.P.*, IPR2015-01586, Paper 38, IPR2015-01592, Paper 39 (Nov. 25, 2016) (same); *Clio USA, Inc. v. The Procter & Gamble Company*, IPR2013-00438, Paper 57 (Oct. 31, 2014) (same).

No dispute remains between the Parties involving the '501 patent. Moreover, all currently pending district court litigations and IPR proceedings involving the '501 patent will be dismissed under the terms of the Settlement Agreement. Maintaining this proceeding in the absence of Petitioner would contradict the Board's policy of favoring settlement between the parties to a proceeding, see, e.g., Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("There are strong public policy reasons to favor settlement between the parties to a proceeding . . . The Board expects that a proceeding will terminate after the filing of a settlement agreement."), and would contradict the Congressional goal to establish a more efficient and streamlined patent system that limits unnecessary and counterproductive litigation costs, see, e.g., *AM General LLC*, IPR2016-01050, Paper 44 (terminating an IPR after the oral hearing: "These proceedings are at a late stage of the trial. However, the Board has not yet entered final written decisions on the merits . . . Generally, the Board expects that a

proceeding will terminate after the filing of a settlement agreement.”); *Hydrite Chemical Co.*, IPR2015-01586, Paper 38, pp. 3-4, IPR2015-01592, Paper 39, pp. 3-4 (terminating an IPR after the oral hearing: “We are persuaded that the parties’ disputes are settled completely and, under these circumstances, the public policy favoring settlement outweighs the increased public interest in final written decisions at this late stage in these proceedings.”) Accordingly, termination is appropriate.

As noted above, all currently pending district court litigations and IPR proceedings involving the ’501 patent will be dismissed with prejudice under the terms of the Settlement Agreement.

Therefore, Petitioner and Patent Owner respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 7,893,501, Case Nos. IPR2017-01841 and IPR2017-01842.

Dated: January 22, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6 (e)(4)

I certify that on January 22, 2019 I will cause a copy of the foregoing document, including any exhibits referred to therein, to be served via electronic mail, as previously consented to by Petitioner, upon the following:

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Date: January 22, 2019

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