

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEOUL SEMICONDUCTOR CO., LTD., SEOUL SEMICONDUCTOR, INC.,
CREE, INC., AND EVERLIGHT ELECTRONICS CO., LTD.,
Petitioners,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

Case IPR2018-00333¹
Patent 7,256,486 B2

JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317(a)

¹ Cree, Inc., who filed a Petition in IPR2018-01205, and Everlight Electronics Co., Ltd., who filed a Petition in IPR2018-01225, have been joined as petitioners in this proceeding.

Authorization for this motion was given by the Board via email sent to the parties on April 24, 2019. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Patent Owner Document Security Systems, Inc. (“Patent Owner”) and Petitioner Everlight Electronics Co., Ltd. (“Petitioner Everlight”) jointly request termination of the *inter partes* review of U.S. Patent No. 7,256,486 (“the ’486 Patent”), Case No. IPR2018-00333, as to the Petitioner Everlight.

I. Statement of Facts

The Patent Owner and Petitioner Everlight have settled their disputes, and have agreed to terminate this *inter partes* review with respect to the Petitioner Everlight. A settlement agreement has been made in writing between Patent Owner and Petitioner Everlight, and a true copy of the Settlement Agreement is being filed concurrently herewith electronically with access to “Board Only” as confidential Exhibit 2205. The Settlement Agreement addresses: (i) a civil action brought by Patent Owner against Everlight in the Central District of California (Case No. 2:17-cv-04273), and (ii) any pending petitions for *Inter Partes* Review. Pursuant to the Settlement Agreement, a Stipulation and Joint Motion to Dismiss with Prejudice Pursuant to Rule 41(a) was filed by the Patent Owner and Petitioner Everlight with respect to Case No. Case No. 2:17-cv-04273 on April 23, 2019 (Exhibit 2206), and an Order of Dismissal with Prejudice was issued on the same day (Exhibit 2207), which dismissed the civil action with prejudice. No other

litigation or proceeding between the Patent Owner and Petitioner Everlight involving the subject patent is pending or contemplated for the foreseeable future.

Contemporaneously with this Joint Motion to Terminate, the Patent Owner and Petitioner Everlight are filing a Joint Motions to Terminate in IPR2018-00522 and IPR2018-00965 as to Petitioner Everlight.

The Patent Owner and Petitioner Everlight certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review with respect to the Petitioner Everlight.

The petitioner Seoul Semiconductor Co. Ltd. and Seoul Semiconductor, Inc. have not stated their position, but petitioner Cree, Inc. has indicated that it does not oppose this Motion.

The Patent Owner and Petitioner Everlight desire that the Settlement Agreement be maintained as business confidential information under 35 U.S.C. 317(b), and a separate joint request to that effect is being filed pursuant to 37 C.F.R. § 42.74(c) concurrently herewith. In that filing, the Patent Owner and Petitioner Everlight requested that the Settlement Agreement (confidential Exhibit 2205) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) be made available only to Federal Government agencies on written request served on Patent

Owner and Petitioner Everlight, or to persons showing good cause on written request served on Patent Owner and Petitioner Everlight, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). Requirement (1) is addressed in Section II below.

As for requirements (2) and (4), the table below identifies all parties in district court litigations that involve or involved the '486 Patent, and related litigations identified in Patent Owner's mandatory notices, and discusses the current status of these litigations with respect to each party to the litigation. *See Heartland Tanning, Inc.*, Paper No. 26, at *2.

Case Caption	Patents Asserted	Current Status
<i>Document Security Systems, Inc. v. Seoul Semiconductor Co. Ltd. et al.</i> , Case No. 2:17-cv-00308 (E.D. Tex.)	6,949,771 7,256,486 7,524,087	Voluntary dismissal on June 7, 2017
<i>Document Security Systems, Inc. v. Cree, Inc.</i> , Case No. 2:17-cv-	6,949,771 7,256,486	Voluntary dismissal on June 8, 2017

00309 (E.D. Tex.)	7,279,355 7,524,087 7,919,787	
<i>Document Security Systems, Inc. v. Everlight Electronics Co. Ltd. et al.</i> , Case No. 2:17-cv-00310 (E.D. Tex.)	6,949,771 7,256,486 7,524,087 7,919,787	Voluntary dismissal on June 8, 2017
<i>Document Security Systems, Inc. v. Seoul Semiconductor Co. Ltd. et al.</i> , Case No. 8:17-cv-00981 (C.D. Cal.)	6,949,771 7,256,486 7,524,087	Joint Stipulation to Stay Case filed on July 26, 2018 / Order on July 27 2018
<i>Document Security Systems, Inc. v. Cree, Inc.</i> , Case No. 2:17-cv-04263 (C.D. Cal.)	6,949,771 7,256,486 7,524,087 7,919,787	Joint Stipulation to Stay Case filed on July 26, 2018 / Order on July 27 2018
<i>Document Security Systems, Inc. v. Everlight Electronics Co. Ltd. et al.</i>, Case No. 2:17-cv-04273 (C.D. Cal.)	6,949,771 7,256,486 7,524,087 7,919,787	Order of Dismissal with Prejudice issued on April 23, 2019
<i>Document Security Systems, Inc. v. OSRAM GmbH, et al.</i> , Case No. 2:17-cv-05184 (C.D. Cal.)	6,949,771 7,256,486 7,524,087 7,652,297	dismissed with prejudice by Court Order on March 14, 2018
<i>Document Security Systems, Inc. v. Lite-On, Inc., et al.</i> , Case No. 2:17-cv-06050 (C.D. Cal.)	6,949,771 7,256,486 7,524,087	Joint Stipulation to Stay Case filed on July 26, 2018 / Order on July 27 2018
<i>Document Security Systems, Inc. v. Nichia Corporation, et al.</i> , Case No. 2:17-cv-08849 (C.D. Cal.)	6,949,771 7,256,486 7,524,087 7,652,297 7,919,787	Motion to Stay Case Granted on July 24, 2018

As for requirements (3) and (4), the status of each inter partes review proceeding for the '486 Patent, and related *inter partes* review proceedings identified in Patent Owner's mandatory notices, is provided below:

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