

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.,
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

IPR2018-00333 (Patent 7,256,486 B2)

SEOUL SEMICONDUCTOR CO., LTD.,
SEOUL SEMICONDUCTOR, INC., and
EVERLIGHT ELECTRONICS CO., LTD.,
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

IPR2018-00522 (Patent 7,524,087 B1)

IPR2018-00333 (Patent 7,256,486 B2)
IPR2018-00522 (Patent 7,524,087 B1)
IPR2018-00965 (Patent 7,919,787 B2)

NICHIA CORPORATION and
EVERLIGHT ELECTRONICS CO., LTD.,
Petitioner,

v.

DOCUMENT SECURITY SYSTEMS, INC.,
Patent Owner.

IPR2018-00965 (Patent 7,919,787 B2)¹

Before SALLY C. MEDLEY, SCOTT C. MOORE, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate with Respect to
Everlight Electronics Co., Ltd.
35 U.S.C. § 317(a)

¹ This Order addresses issues that are the same in the above-identified proceedings. We exercise our discretion to issue one Order to be entered in each proceeding. The Parties are not authorized to use this joint heading and filing style in their papers.

IPR2018-00333 (Patent 7,256,486 B2)
IPR2018-00522 (Patent 7,524,087 B1)
IPR2018-00965 (Patent 7,919,787 B2)

We instituted trial in each of the above-identified proceedings (IPR2018-00333, Paper 9 (dated June 21, 2018); IPR2018-00522, Paper 10 (dated July 27, 2018); and IPR2018-00965, Paper 15 (dated October 29, 2018)). On April 25, 2019, the parties filed Joint Motions to Terminate in each of these proceedings (collectively “Joint Motions to Terminate”) requesting that these proceedings be terminated with respect to Everlight Electronics Co., Ltd. (“Everlight”) pursuant to 35 U.S.C. § 317(a). Paper 30.² The parties represent that the other petitioners in these proceedings (Seoul Semiconductor Co., Ltd., Seoul Semiconductor, Inc., and Cree, Inc. in IPR2018-00333; Seoul Semiconductor Co., Ltd. and Seoul Semiconductor, Inc. in IPR2018-00522; and Nichia Corporation in IPR2018-00965) intend to continue with each of these proceedings. *Id.* With the Joint Motions to Terminate, Everlight and Patent Owner also filed copies of a written settlement agreement terminating the underlying district court litigation between them. Ex. 2205.³ In each of these proceedings, the parties filed a Joint Request that the settlement agreement be kept confidential. Paper 31.⁴

² For purposes of expediency, we cite to Papers filed in IPR2018-00333. Patent Owner filed a similar Joint Motion to Terminate in IPR2018-00522 (Paper 30) and IPR2018-00965 (Paper 22).

³ For purposes of expediency, we cite to the copy of the written settlement agreement filed in IPR2018-00333. Patent Owner also filed a copy of the written settlement agreement in each of IPR2018-00522 (Ex. 2205) and IPR2018-00965 (Ex. 2205).

⁴ Patent Owner filed similar Joint Requests in IPR2018-00522 (Paper 31) and IPR2018-00965 (Paper 23).

IPR2018-00333 (Patent 7,256,486 B2)
IPR2018-00522 (Patent 7,524,087 B1)
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These proceedings have not resulted in a final decision on the merits. Accordingly, these proceedings are terminated with respect to Everlight. 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.”).

ORDER

Accordingly, it is

ORDERED that the Joint Motions to Terminate the above-identified proceedings with respect to Everlight Electronics Co., Ltd. are *granted*;

FURTHER ORDERED that the Joint Requests that the settlement agreements (IPR2018-00333, Ex. 2205; IPR2018-00522, Ex. 2205; and IPR2018-00965, Ex. 2205) be treated as business confidential information and be kept separate from the files of the above-identified proceedings and from the files of the involved patents under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are *granted*; and

FURTHER ORDERED that the above-identified proceedings will continue with Seoul Semiconductor Co., Ltd., Seoul Semiconductor, Inc., and Cree, Inc. as the named petitioner in IPR2018-00333, with Seoul Semiconductor Co., Ltd. and Seoul Semiconductor, Inc. as the named petitioner in IPR2018-00522, and with Nichia Corporation as the named petitioner in IPR2018-00965.

IPR2018-00333 (Patent 7,256,486 B2)
IPR2018-00522 (Patent 7,524,087 B1)
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