

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TIANMA MICROELECTRONICS CO. LTD.,  
Petitioner,

v.

JAPAN DISPLAY INC. and PANASONIC LIQUID  
CRYSTAL DISPLAY CO., LTD.,<sup>1</sup>  
Patent Owner.

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IPR2021-01028 (Patent 9,793,299 B2)  
IPR2021-01029 (Patent 9,310,654 B2)  
IPR2021-01057 (Patent 7,385,665 B2)  
IPR2021-01058 (Patent 7,636,142 B2)  
IPR2021-01061 (Patent 10,423,034 B2)<sup>2</sup>

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Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and  
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

PER CURIAM.

TERMINATION

Due to Settlement After Institution of Trial and  
*Granting* Joint Request to Treat Settlement Agreement as  
Business Confidential Information  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

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<sup>1</sup> Japan Display Inc. is the only Patent Owner in IPR2021-01029, IPR2021-01057, and IPR2021-01058.

<sup>2</sup> This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

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IPR2021-01061 (Patent 10,423,034 B2)

## I. INTRODUCTION

Petitioner and Patent Owner (collectively “the Parties”) have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On January 26, 2022, the Parties filed a Joint Motion to Terminate Proceeding (“Joint Motion”) in each of the above-identified proceedings. Paper 20.<sup>3</sup> The Parties also filed a copy of a settlement agreement (Ex. 1028, “Settlement Agreement”) and filed a Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (Paper 21, “Joint Request”) in each of the proceedings.

## II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *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.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the *inter partes* review proceedings, that the filed copy of the Settlement Agreement is a true copy, and that, aside from the filed copy, “[t]here are no other agreements, oral or written,

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<sup>3</sup> For expediency, we cite to the Papers and Exhibits filed in IPR2021-01028, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2021-01029, IPR2021-01057, IPR2021-01058, and IPR2021-01061.

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IPR2021-01061 (Patent 10,423,034 B2)

between the parties made in connection with, or in contemplation of, the termination of the proceeding.” Joint Motion 2.

We instituted trial in the above-identified proceedings. *See, e.g.*, Paper 14. The trials are still at an early stage. Oral hearings have not yet been held, we have not yet decided the merits of the proceedings, and final written decisions have not yet been entered. Under these circumstances and in view of the Parties’ settlement, we determine that good cause exists to terminate the proceedings.

The Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of Patent 9,793,299, Patent 9,310,654, Patent 7,385,665, Patent 7,636,142, and Patent 10,423,034. Joint Request 3. After reviewing the Settlement Agreement, we determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

### III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motions are *granted*, and IPR2021-01028, IPR2021-01029, IPR2021-01057, IPR2021-01058, and IPR2021-01061 are *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

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IPR2021-01061 (Patent 10,423,034 B2)

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the file of Patent 9,793,299, Patent 9,310,654, Patent 7,385,665, Patent 7,636,142, and Patent 10,423,034, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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