

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP. and
TCL INDUSTRIES HOLDINGS CO., LTD.
Petitioners,

v.

ATI TECHNOLOGIES ULC,
Patent Owner.

IPR2023-00922¹
Patent No. 8,760,454 B2

**JOINT MOTION TO TERMINATE PROCEEDING WITH RESPECT TO
TCL PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

¹ Joinder with IPR2024-00366

I. INTRODUCTION

TCL Industries Holding Co., Ltd. (“TCL”) and ATI Technologies ULC (“Patent Owner” or “ATI”) jointly request termination of the *inter partes* review of U.S. Patent No. 8,760,454 (“the ’454 patent”) with respect to TCL pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board’s authorization via email given on June 12, 2024. This motion does not otherwise affect petitioner Realtek Semiconductor Corp. (“Realtek”).

Terminating this proceeding with respect to TCL is within the Board’s discretion. Exercising that discretion here would conserve judicial resources and promote the strong policy reasons that favor settlement.

II. PUBLIC POLICY FAVORS TERMINATING THIS PROCEEDING

The Board has discretion to terminate *inter partes* review proceedings after the parties file a settlement agreement. 35 U.S.C. § 317(a); *see also* 37 C.F.R. § 42.72. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” PTAB Consolidated Trial Practice Guide, at 86 (Nov. 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. The Board therefore terminates proceedings “after the filing of a settlement agreement, unless the Board already has decided the merits of the proceeding.” *Id.*

Termination of this proceeding as to TCL is proper for at least the following reasons. This proceeding is at an early stage, and the Board has not decided the

merits of the proceeding. 35 U.S.C. § 317(a); PTAB Consolidated Trial Practice Guide, at 86. The Board issued its institution decision and grant of joinder for TCL on March 29, 2024 Order (Paper 19), which is preliminary. *See St. Jude Med., Cardiology Div., Inc. v. Volcano Corp.*, 749 F.3d 1373, 1375–76 (Fed. Cir. 2014) (“the Director’s decision whether to institute a proceeding” differs from a “decision with respect to patentability”). Patent Owner filed Patent Owner’s response on February 23, 2024 (Paper 14), and TCL joined in the proceeding just three months ago. No motions are outstanding in this proceeding. Each of these facts supports terminating this proceeding.

TCL and Patent Owner jointly request termination. TCL and Patent Owner reached the mutual decision to settle this proceeding and their related district court litigation regarding the ’454 patent. They agree that settlement of their disputes promotes efficiency and will minimize unnecessary costs. Terminating this proceeding as to TCL will consequently preserve judicial resources and enables the parties to minimize the cost of litigation. No public interest or other factors weigh against termination of this proceeding.

TCL and Patent Owner executed a confidential settlement agreement to terminate this proceeding. The settlement agreement and related agreements are being submitted concurrently herewith. (*See* Ex. 2148, Ex. 2149, and Ex. 2150.)

TCL and Patent Owner certify that there are no collateral agreements or

understandings made in connection with, or in contemplation of, the termination of the proceeding. In accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a joint request that the settlement agreement and the related agreements be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c).

For all of the above reasons, the Board should terminate this proceeding with respect to TCL to promote settlement and minimize unneeded expenditure of the Board's resources.

III. CONCLUSION

For at least the foregoing reasons, the parties jointly request immediate and complete termination of this proceeding.

Respectfully submitted,

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