

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMISSARIAT À L'ENERGIE ATOMIQUE ET AUX ENERGIES
ALTERNATIVES,
Petitioner,

v.

SILICON GENESIS CORPORATION,
Patent Owner.

Case IPR2016-00831 (Patent 6,162,705)
Case IPR2016-00832 (Patent 6,013,563)
Case IPR2016-00833 (Patent 6,103,599)

Before JONI Y. CHANG, J. JOHN LEE, and SHEILA F. McSHANE,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

IPR2016-00831 (Patent 6,162,705)

IPR2016-00832 (Patent 6,013,563)

IPR2016-00833 (Patent 6,103,599)

A conference was held with the parties on April 6, 2017, regarding the above-captioned cases (“CEA-SiGen IPRs”). At the conference, the parties indicated that a settlement agreement (“SiGen-Soitec Agreement”) has been reached between Patent Owner, Silicon Genesis Corporation (“SiGen”), and a third party, Soitec S.A., in which Soitec agreed to request that Petitioner, Commissariat à L’Energie Atomique et aux Energies Alternatives (“CEA”), seek to terminate the CEA-SiGen IPRs. CEA also reported that CEA and Soitec have reached an oral agreement (“CEA-Soitec Agreement”) wherein CEA agreed to seek termination as requested by Soitec. As a result of these two agreements, CEA and SiGen jointly requested authorization to file a motion to terminate each of the CEA-SiGen IPRs.

An instituted *inter partes* review “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.” 35 U.S.C. § 317(a). Based on the present circumstances, we authorize the parties to file a joint motion to terminate trial in each of the CEA-SiGen IPRs. *See* 37 C.F.R. § 42.72.

In conjunction with the motions to terminate trial, the parties are required to file in each proceeding a true copy of any agreement or understanding by the parties, “including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination” of these *inter partes* reviews. 35 U.S.C. § 317(b). Each such agreement must be in writing. *Id.*; 37 C.F.R. § 42.74(b). Specifically, the parties must comply with these requirements as to both the SiGen-Soitec Agreement and the CEA-Soitec Agreement. Additionally, the parties’ joint motions to terminate trial must include the

IPR2016-00831 (Patent 6,162,705)

IPR2016-00832 (Patent 6,013,563)

IPR2016-00833 (Patent 6,103,599)

parties' certification that no other agreements exist, beyond those filed in these proceedings, that are encompassed by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

We understand, however, that the nature of the agreements in question here involve unusual issues regarding confidentiality due to the involvement of a third party. Specifically, the parties indicated that the SiGen-Soitec Agreement constitutes business confidential information of SiGen and Soitec to which CEA should not receive access. Similarly, the CEA-Soitec Agreement constitutes business confidential information of CEA and Soitec to which SiGen should not receive access. Thus, both agreements should be filed as "Board Only." In addition, we authorize SiGen to file, in conjunction with its filing of the SiGen-Soitec Agreement, a motion to treat as business confidential information and keep separate from the file, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in each of the CEA-SiGen IPRs. CEA is authorized to file a similar motion, in conjunction with its filing of the written CEA-Soitec Agreement, in each proceeding.

ORDER

Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate trial in each of the CEA-SiGen IPRs;

FURTHER ORDERED that SiGen shall file a true copy of the SiGen-Soitec Agreement as "Board Only" in each of the CEA-SiGen IPRs, and is authorized to file in each proceeding an accompanying motion to treat as business confidential information and keep separate from the file;

IPR2016-00831 (Patent 6,162,705)

IPR2016-00832 (Patent 6,013,563)

IPR2016-00833 (Patent 6,103,599)

FURTHER ORDERED that CEA shall file a true copy of the CEA-Soitec Agreement in writing as “Board Only” in each of the CEA-SiGen IPRs, and is authorized to file in each proceeding an accompanying motion to treat as business confidential information and keep separate from the file.

IPR2016-00831 (Patent 6,162,705)

IPR2016-00832 (Patent 6,013,563)

IPR2016-00833 (Patent 6,103,599)

PETITIONER:

Paul McGowan

Parker Hancock

Marcus T. Hall

Douglas D. Salyers

TROUTMAN SANDERS LLP

paul.mcgowan@troutmansanders.com

parker.hancock@troutmansanders.com

marcus.hall@troutmansanders.com

doug.salyers@troutmansanders.com

PATENT OWNER:

Margaux Nair

George C. Summerfield

K&L GATES LLP

Margaux.Nair@klgates.com

George.Summerfield@klgates.com