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IPR2016-00863, Paper 44
IPR2016-00865, Paper 45
Entered: May 5, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNAPTICS INCORPORATED,
Petitioner,

v.

AMKOR TECHNOLOGY, INC.,
Patent Owner.

Cases

IPR2016-00863 (Patent 7,358,174 B2)
IPR2016-00865 (Patent 7,358,174 B2)

Before RAMA G. ELLURU, ROBERT J. WEINSCHENK,
and JASON J. CHUNG, *Administrative Patent Judges*.

ELLURU, *Administrative Patent Judge*.

ORDER

Termination of the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

Case IPR2016-00863 (Patent 7,358,174 B2)

Case IPR2016-00865 (Patent 7,358,174 B2)

On April 28, 2017, the parties filed joint motions to terminate IPR2016-00863 and IPR2016-00865 (Paper 42, “Mot.”),¹ along with what they indicate is a true copy of their settlement agreement (Ex. 1070). The parties indicate in their joint motions that “Petitioner, named real party in interest Validity Sensors, LLC, and Patent Owner entered into a settlement agreement.” Mot. 2. The motion further states that “[p]ursuant to the terms of the settlement agreement, Patent Owner agrees to dismiss with prejudice the pending district court action, including its patent infringement claims.” *Id.* On the same day, the parties also filed joint requests that the settlement agreement be treated as business confidential information and kept separate from the patent files. Paper 43.

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” We instituted trials in these proceedings (Paper 27), but we have not yet decided the merits of these proceedings.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.” The parties have filed what they indicate is a true copy of their written settlement agreement, which they represent “is the only agreement or

¹ The parties filed similar papers in each of the instant proceedings. We refer to those filed in Case IPR2016-00863 for convenience.

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understanding between Petitioner and Patent Owner that was made in connection with, or in contemplation of termination of this proceeding.”

Mot. 5. In view of the foregoing reasons, we determine that it is appropriate to terminate these proceedings without rendering final written decisions as to the patentability of the challenged claims in each of the proceedings. *See* 37 C.F.R. §§ 42.72, 42.74.

As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent files. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding (Paper 42) is *granted*;

FURTHER ORDERED that the parties’ joint request that the settlement agreement (Ex. 1070) be treated as business confidential information (Paper 43) is *granted*; and

FURTHER ORDERED that these proceedings are hereby *terminated*.

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