

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANYA TECHNOLOGY CORP.,
Petitioner,

v.

NORTH STAR INNOVATIONS INC.,
Patent Owner.

Case IPR2016-00965 (Patent 6,372,638 B1)
Case IPR2016-01022 (Patent 6,492,686 B1)¹

Before J. JOHN LEE, CHARLES J. BOUDREAU, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

WORMMEESTER, *Administrative Patent Judge*.

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

¹ This order addresses issues that are the same in all identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

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Case IPR2016-01022 (Patent 6,492,686 B1)

On January 24, 2017, the parties filed a Joint Motion to Amend Due Dates 1–5 of the Scheduling Order in each of the above-identified cases. Paper 10.² A motion is not required to alter those dates, which may be accomplished by filing a joint stipulation. We understand the Joint Motions, however, as seeking authorization to file joint motions to terminate these proceedings with respect to both Petitioner and Patent Owner on the basis that the parties have settled. *See id.* at 2 (“The parties have reached settlement and are striving in good faith to take actions required by such settlement, whereupon they shall request the Board to terminate this case.”). Parties typically should not file a motion to seek authorization to file another motion, including a motion to terminate, and may request authorization by contacting the Board, for example, by electronic mail. In this instance, however, we accept the Joint Motions as a request for authorization.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Any 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 of the agreement shall be filed with the Board prior to termination. *See* 37 C.F.R. § 42.74(b).

Each joint motion to terminate must include a brief explanation as to why termination of the proceeding is appropriate. Information should be provided on the status of related district court actions in which U.S. Patent

² Paper numbers refer to Case IPR2016-00965. A corresponding joint motion was filed in Case IPR2016-01022.

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Nos. 6,372,638 B1 or 6,492,686 B1 has been asserted, particularly regarding the status of all defendants.

Each joint motion to terminate must be accompanied by **a true copy** of the settlement agreement, as well as any collateral agreements (including any licensing agreements) referred to in the settlement agreement, as required by 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement. For each joint motion to terminate, the parties should also include a statement that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding, assuming such statement is correct. If the parties cannot make such statement, the other agreement(s) also should be filed under 37 C.F.R. § 42.74.

With regard to having the settlement agreement treated as business confidential information and kept separate from the patent file(s) under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement in accordance with the instructions provided on the Board's website (uploading as "Board Only"). The parties also are directed to FAQ G2 on the Board's website page at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/ptab-e2e-frequently-asked-questions> for instructions on how to file a settlement agreement as confidential.

Accordingly, it is

ORDERED that Petitioner and Patent Owner are authorized to file a joint motion to terminate the *inter partes* review proceeding for each of the above-identified cases;

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FURTHER ORDERED that each joint motion to terminate must be accompanied by a true copy of the settlement agreement, labeled as an exhibit, as required by 37 C.F.R. § 42.74(b);

FURTHER ORDERED that, in a separate motion for each case, Petitioner and Patent Owner may request that the settlement agreement be treated as business confidential information and kept separate from the underlying patent file, as provided in 37 C.F.R. § 42.74(c);

FURTHER ORDERED that any confidential settlement agreement must be filed in accordance with the instructions provided on the Board's website (uploading as "Board Only"); and

FURTHER ORDERED that each motion shall be filed on or before February 2, 2017.

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