

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIODES INCORPORATED
Petitioner

v.

NORTH PLATE SEMICONDUCTOR, LLC
Patent Owner.

Case No. IPR2018-01196
U.S. Patent No. 7,564,097

**JOINT MOTION TO TERMINATE
UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. §§ 42.72 AND 42.74**

AND

**JOINT REQUEST TO KEEP PAPERS SEPARATE AS
BUSINESS CONFIDENTIAL INFORMATION
UNDER 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, and the Board’s authorization of August 16, 2018, Petitioner Diodes Incorporated (“Petitioner”) and Patent Owner North Plate Semiconductor, LLC (“Patent Owner”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 7,564,097 in IPR2018-01196.

The Parties have settled all of their disputes involving U.S. Patent No. 7,564,097. More specifically, the Parties have settled and dismissed their related district court litigation (*North Plate Semiconductor, LLC v. Diodes Incorporated*, Case No. 4:17-cv-00816 (E.D. Tex.)).

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ settlement agreement made in contemplation of termination of the proceeding is in writing, and a true and correct copy of such agreement is being filed herewith as Exhibit 2007. No other such agreements, written or oral, exist between the Parties.

The Parties hereby jointly request that the settlement agreement be treated as business confidential information and be kept separate from the files of the above-captioned IPR, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

I. Background

On June 5, 2018, Petitioner filed a request for *Inter Partes* Review of claims 1-5 of U.S. Patent No. 7,564,097 (“the ‘097 Patent”). *See* IPR2018-01196, Paper 1.

On July 23, 2018, the Parties agreed to settle all of their disputes involving the '097 Patent. On August 14, 2018, the Parties informed the Board of the settlement and requested authorization to file a joint motion to terminate this proceeding with respect to both the Patent Owner and Petitioner. On August 16, 2018, the Board authorized the filing of the requested motion to terminate this proceeding as to both Parties. The Board additionally authorized the Parties to include with the joint motion to terminate a request to treat the settlement as business confidential information.

The '097 Patent is not currently the subject of any additional pending *Inter Partes* Review or district court proceedings.

II. Legal Standard

An *inter partes* review proceeding “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). A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the

litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014).

III. Termination Is Appropriate

Termination of this IPR is appropriate under 37 C.F.R. § 42.71(a) as (1) Petitioner and Patent Owner have settled their dispute regarding the '097 patent and have agreed to terminate the IPR; and (2) the Board has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Importantly, the Board has yet to make a determination with respect to institution of the Petition.

No dispute remains between the Patent Owner and Petitioner involving the '097 Patent. The Parties have agreed to jointly request termination of this *Inter Partes* Review, IPR2018-01196. The related litigation between the Parties involving the '097 Patent has been dismissed.

IV. Status of Related Litigation

As noted above, the related district court action between Patent Owner and Petitioner has been settled and dismissed. Patent Owner certifies that there are no other related district court actions or *Inter Partes* Review proceedings involving the '097 Patent, either currently pending or previously dismissed.

V. Request To Treat Settlement Agreement As Business Confidential

Patent Owner and Petitioner hereby request that the settlement agreement (including all attachments and schedules) filed herewith as Ex. 2007 be treated as business confidential information, be kept separate from the file of the above-captioned IPR, and be 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). In view of that request, the settlement agreement (Ex. 2007) has been filed for access by the “Parties and Board Only.” The Parties have complied with the requirements of 37 C.F.R. § 42.74.

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