

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SILICON MITUS, INC. and SILICON MITUS TECHNOLOGY, INC.,  
Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.,  
Patent Owner.

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Case IPR2018-01290 (Patent 8,643,331 B1)  
Case IPR2018-01292 (Patent 8,203,305 B1)<sup>1</sup>

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Before MIRIAM L. QUINN, JESSICA C. KAISER, and  
SHARON FENICK, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

TERMINATION  
Dismissing the Proceedings  
*37 C.F.R. § 42.5(a); 37 C.F.R. § 42.71(a)*

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<sup>1</sup> This Order will be entered in each case. The parties are not authorized to use this caption style.

IPR2018-01290 (Patent 8,643,331 B1)

IPR2018-01292 (Patent 8,203,305 B1)

Pursuant to the parties' joint request, the Board authorized the parties to file joint motions to terminate the above-captioned proceedings. On September 4, 2018, Petitioner filed, on behalf of the parties, a "Joint Motion to Terminate Proceeding" (Paper 7)<sup>2</sup> and a "Joint Request to File Settlement Agreement as Business Confidential Information" (Paper 6), along with a copy of the settlement agreement (Ex. 1015) and a copy of the district court dismissal order (Ex. 1016).

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. 48756, 48768 (Aug. 14, 2012). These cases are in the preliminary proceeding stage, which begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted. *See* 37 C.F.R. § 42.2. Petitioner filed a Petition in each proceeding on June 20, 2018. Paper 1. Patent Owner has not yet filed a Preliminary Response, and no decision whether to institute a trial has been rendered in either proceeding.

The parties represent that Exhibit 1015 is a true and correct copy of the settlement agreement between the parties. Paper 7, 2. The parties also represent that the pending district court litigation between the parties has been settled and dismissed in an order dated August 22, 2018 (Ex. 1016). Paper 7, 3–4.

Based on the facts of the case, and in view of the parties' joint motion, we determine that it is appropriate to dismiss the Petition in each proceeding as to both Petitioner and Patent Owner without rendering either a decision to

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<sup>2</sup> We refer to the paper and exhibit numbers in IPR2018-01290. The parties filed similar papers and exhibits in IPR2018-01292.

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institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a), 42.71(a).

Therefore, the Joint Motion to Terminate Proceeding and Joint Request to File Settlement Agreement as Business Confidential Information are *granted*. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information, to be kept separate from the patent file, in each proceeding is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate Proceeding in each proceeding is *granted*; and

FURTHER ORDERED that the Petition for *Inter Partes* Review in each proceeding is *dismissed*.

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FOR PETITIONER:

David A. Jakopin

Patrick A. Doody

PILLSBURY WINTHROP SHAW PITTMAN LLP

David.jakopin@pillsburylaw.com

Patrick.doody@pillsburylaw.com

FOR PATENT OWNER:

David M. Hoffman

FISH & RICHARDSON P.C.

hoffman@fr.com