

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SK HYNIX INC. and SK HYNIX AMERICA INC.,
Petitioner,

v.

BITMICRO, LLC,
Patent Owner.

IPR2018-01410 and IPR2018-01411 (Patent 6,529,416 B2)
IPR2018-01545 (Patent 8,093,103 B2)
IPR2018-01720 (Patent 7,826,243 B2)¹

Before KEN B. BARRETT, KRISTINA M. KALAN, and
KEVIN C. TROCK, *Administrative Patent Judges*.

PER CURIAM.

ORDER

Termination of the Proceedings
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

¹ This Order addresses issues that are the same in each of the above-identified proceedings. We exercise our discretion to issue one Order to be entered in each proceeding. The Parties are not authorized to use this joint heading and filing style in their papers.

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Petitioner and Patent Owner (collectively, “the parties”) have requested that the above-identified proceedings be terminated pursuant to a settlement. The Board authorized the parties to file a joint motion to terminate the above-identified proceedings on May 21, 2019.

On June 13, 2019, and pursuant to 35 U.S.C. § 317(a), the parties filed Joint Motions to Terminate each of these proceedings (collectively “Joint Motions to Terminate”) (Paper 30²) and Joint Requests to file the settlement agreement as business confidential information and to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (collectively “Joint Requests”) (Paper 31³), along with a copy of the written settlement agreement in each proceeding (Ex. 1014⁴).

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

Additionally, the Board expects that a proceeding will terminate after

² For purposes of expediency, we cite to Papers filed in IPR2018-01410. Petitioner filed a similar Joint Motion to Terminate in IPR2018-01411 (Paper 30), IPR2018-01545 (Paper 20), and IPR2018-01720 (Paper 20).

³ Petitioner filed similar Joint Requests in IPR2018-01411 (Paper 31), IPR2018-01545 (Paper 21), and IPR2018-01720 (Paper 21).

⁴ For purposes of expediency, we cite to the copy of the written settlement agreement filed in IPR2018-01410. Petitioner also filed a copy of the written settlement agreement in each of IPR2018-01411 (Ex. 1108), IPR2018-01545 (Ex. 1034), and IPR2018-01720 (Ex. 1035).

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the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). We instituted trial in each of the above-identified proceedings (IPR2018-01410, Paper 14 (dated January 23, 2019); IPR2018-01411, Paper 14 (dated January 23, 2019); IPR2018-01545, Paper 14 (dated March 7, 2019); and IPR2018-01720, Paper 14 (dated March 29, 2019)). Thus, each of the above-identified proceedings is a trial subject to termination under 37 C.F.R. § 42.72. *See* 37 C.F.R. § 42.72. We have not yet decided the merits of the above-identified proceedings, and final written decisions have not been entered in these proceedings. Notwithstanding that these proceedings have moved beyond the preliminary stage, the parties have shown adequately that the termination of these proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate these proceedings with respect to the parties.

The parties represent that Exhibit 1014 is a true copy of the settlement agreement between the parties. Paper 30, 3. The parties state “[t]his settlement agreement is the only agreement or understanding between SK Hynix [i.e., SK Hynix Inc. and SK Hynix America Inc.] and Patent Owner made in connection with, or in contemplation of dismissing SK Hynix.” *Id.* at 1, 3. The parties represent that, pursuant to the settlement agreement, they have agreed to terminate not only the above-identified proceedings but also the underlying district court litigation between them (18-CV-03505 (N.D. Cal.)) and the underlying International Trade Commission investigation (ITC Inv. No. 337-TA-1097). *Id.* at 2–3.

Based on the facts of these proceedings, and in view of the parties’

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Joint Motions to Terminate, we are persuaded that it is appropriate to terminate these proceedings with respect to both Petitioner and Patent Owner without rendering any further decisions. *See* 37 C.F.R. §§ 42.5(a), 42.72. Therefore, the Joint Motions to Terminate and the Joint Requests to treat the settlement agreement as business confidential information are *granted*.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the Joint Requests that the settlement agreements (IPR2018-01410, Ex. 1014; IPR2018-01411, Ex. 1108; IPR2018-01545, Ex. 1034; and IPR2018-01720, Ex. 1035) be treated as business confidential information and be kept separate from the files of the above-identified proceedings and from the files of the involved patents under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are *granted*;

FURTHER ORDERED that the Joint Motions to Terminate the above-identified proceedings are *granted*; and

FURTHER ORDERED that the above-identified proceedings are *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

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