

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

Title: METHOD FOR FORMING A CONDUCTIVE PLUG BETWEEN LAYERS
OF AN INTEGRATED CIRCUIT

**JOINT MOTION TO TERMINATE PROCEEDING IN VIEW OF
SETTLEMENT PURSUANT TO 35 U.S.C. §317(a),**

**JOINT NOTICE OF SETTLEMENT PURSUANT TO 35 U.S.C.
§317(b) AND 37 C.F.R. § 42.74, AND**

**JOINT REQUEST TO KEEP SEPARATE PURSUANT TO 35 U.S.C. §317(b)
AND 37 C.F.R. § 42.74(c)**

Patent Owner North Star Innovations Inc. ("NSI" or "Patent Owner") and Petitioner Nanya Technology Corp. ("Nanya" or "Petitioner") (collectively "the Parties") have reached a settlement and jointly request that the Board terminate this *Inter Partes* Review ("IPR") of U.S. Patent 6,372,638 ("the '638 Patent") and cancel all pending due dates set forth in the Amended Scheduling Order (Paper No. 10), as Ordered by the Board (Paper No. 11). The Parties also jointly request that the Board treat the Settlement Agreement as business confidential information and keep it separate from the file of the involved patent.

Statement of Precise Relief Requested

Respectfully, the Parties jointly request that the Board terminate this IPR and cancel all pending due dates set forth in the Amended Scheduling Order (Paper No. 10), as Ordered (Paper No. 11), with the due date of the Order having been modified to February 21, 2017 by virtue of the Board's February 2, 2017 email; in particular, Due Dates 1 - 5, including Due Date 4 of June 9, 2017, with respect to Request for Oral Argument, are to be cancelled.

The Parties jointly request that the Board treat the Settlement Agreement, Ex. 2001, as business confidential information and keep it separate from the file of the involved patent, and made available only to Federal Government agencies on written request or to any person only on a showing of good cause.

Statement of Reasons for the Relief Requested

The Parties have reached a settlement agreement regarding their disputes relating to the '638 Patent and all other matters pending between them. In particular, the parties have dismissed all actions as between them, namely: (1) *North Star Innovations Inc. v. Nanya Technology Corp. U.S.A. et al.*, C.A. No. 1:15-cv-01027-LPS-CJB (D. Del. Nov. 5, 2015); and (2) *North Star Innovations Inc. v. Nanya Technology Corp. U.S.A. et al.*, C.A. No. 8:16-cv-01591-JVS-AJW (C.D. Cal. Aug. 29, 2016). Furthermore, concurrently with this Joint Motion, the parties are filing another Joint Motion to Terminate Proceedings for IPR2016-01022 of U.S. Patent 6,492,686 (“the '686 Patent”), which bears identical language to the present Motion. Because the Board has not decided this IPR on its merits, and moreover that the IPR is in an early part of the proceedings following the decision for Institution, the Parties jointly request that the Board terminate this IPR pursuant to 35 U.S.C. §317(a). The Parties also jointly request that the Board cancel Due Dates 1 - 7, which includes Due Date 4 with respect to Request for Oral Argument.

The Parties file a copy of the settlement agreement (Ex. 2001) with the PTAB, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

The Parties jointly request that this Settlement Agreement be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.70(c). Ex.

2001 is being submitted concurrently herewith having “availability” in the PRPS system of “Parties and Board Only.” The Parties jointly request that this settlement agreement (Ex. 2001) be made available only to Federal Government agencies on written request or to any person only on a showing of good cause.

If any fees are due in connection with this matter, the Commissioner is hereby authorized to charge them to Attorney Deposit Account 50-5998.

Concluding Remarks

If the Board has any questions or concerns for the parties, the parties respectfully request an opportunity to be notified of and address such concerns.

Respectfully submitted,
IP LAW LEADERS PLLC

/Cameron H. Tousi/
Cameron H. Tousi, Esq.
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Lead Counsel for Patent Owner

Date: February 15, 2017

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EXHIBIT APPENDIX

Exhibit	Description
2001	Settlement Agreement (Business Confidential)

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing JOINT MOTION TO TERMINATE PROCEEDING IN VIEW OF SETTLEMENT PURSUANT TO 35 U.S.C. §317(a); JOINT NOTICE OF SETTLEMENT PURSUANT TO 35 U.S.C. §317(b) AND 37 C.F.R. § 42.74; AND JOINT REQUEST TO KEEP SEPARATE PURSUANT TO 35 U.S.C. §317(b) AND 37 C.F.R. § 42.74(c) and EXHIBIT 2001 were served electronically via e-mail on February 1, 2017, on the following Petitioner's counsel of record:

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Respectfully submitted,
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