

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*.

JUDGMENT
Termination of Proceedings
37 C.F.R. § 42.72

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

On March 1, 2017, the parties filed joint motions to terminate the instant proceedings pursuant to a Settlement and Patent License Agreement (“Settlement Agreement”). Paper 12; Ex. 2001.² The parties also filed a copy of their Settlement Agreement (Ex. 2001), made in connection with the termination of the instant proceedings, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Paper 12, 3. In their joint motions, the parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the involved patents. *Id.*

The instant proceedings are in their early stages. The Board instituted trial in each case on November 9, 2016. In an e-mail to the Board on March 6, 2017, the parties represented that each copy of the Settlement Agreement that they filed in the cases is a “true copy” of the Settlement Agreement and that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceedings.” The parties also represent that they “have dismissed all actions as between them” regarding the above-identified patents. Paper 12, 3. Under these circumstances, we determine that it is appropriate to terminate the instant proceedings under 37 C.F.R. § 42.72, without rendering a final written decision.

² The parties filed similar papers in each of the instant proceedings. We refer to those filed in IPR2016-00965 for convenience. *See* Paper 12, 3 (“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.”).

Accordingly, it is

ORDERED that the joint motions to terminate the instant proceedings are *granted*;

FURTHER ORDERED that the instant proceedings are hereby *terminated*;

FURTHER ORDERED that the parties' joint request that the Settlement Agreement filed in each of the instant proceedings be treated as business confidential information and be kept separate from the file of the involved patent is *granted*;

FURTHER ORDERED that the Settlement Agreement filed in each of the instant proceedings be treated as business confidential information and be kept separate from the file of the involved patent, under 37 C.F.R. § 42.74(c), and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that a copy of this Judgment be filed in each of the instant cases.

Case IPR2016-00965 (Patent 6,372,638 B1)

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

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