

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SAMSUNG ELECTRONICS CO., LTD.,  
Petitioner,

v.

PROMOS TECHNOLOGIES, INC.,  
Patent Owner.

---

IPR2019-00779 (Patent 6,163,492)  
IPR2019-00780 (Patent 6,163,492)  
IPR2019-00781 (Patent 6,163,492)  
IPR2019-00782 (Patent 5,934,974)  
IPR2019-00783 (Patent 6,099,386)  
IPR2019-00784 (Patent 6,469,559)  
IPR2019-00785 (Patent 6,597,201)<sup>1</sup>

---

Before KEVIN F. TURNER, JO-ANNE M. KOKOSKI,  
JOHN A. HUDALLA, JULIA HEANEY, and MATTHEW J. McNEILL,  
*Administrative Patent Judges.*<sup>2</sup>

KOKOSKI, *Administrative Patent Judge.*

---

<sup>1</sup> This Order addresses issues that are identical in all seven cases. We, therefore, exercise our discretion to issue one Order to be entered in each case.

<sup>2</sup> This is not an Order from an expanded panel of the Board. Rather, the five judges are paneled in various groups of three in the subject cases.

TERMINATION  
Due to Settlement After Institution of Trial  
35 U.S.C. § 317; 37 C.F.R. § 42.74

On June 16, 2020, with Board authorization, Petitioner (Samsung Electronics Co., Ltd.) and Patent Owner (ProMOS Technologies, Inc.) filed a Joint Motion to Terminate (Paper 25, “Joint Motion”)<sup>3</sup> and a Joint Request that the settlement agreement be treated as business confidential information and be kept separate from the patent file (Paper 26, “Joint Request”), along with a copy of the written settlement agreement (Ex. 2005, “Settlement Agreement”), in each of the above-referenced proceedings.

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.” Section 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motions, the parties represent that they have reached an agreement resolving their disputes, and that Exhibit 2005 is a true and correct copy of their Settlement Agreement. Paper 25, 2.<sup>4</sup> The parties further represent that there are no other agreements between them made in connection with the termination of the instant proceedings. *Id.*

---

<sup>3</sup> The parties filed similar papers in each of the instant proceedings. We refer to those filed in IPR2019-00779 for convenience.

<sup>4</sup> The Joint Motion does not have numbered pages. We count the pages of the Joint Motion starting from the first (title) page.

IPR2019-00779 through -00785  
Patents 5,934,974; 6,099,386; 6,163,492; 6,469,559; 6,597,201

We instituted trial in these proceedings in September and October, 2019. Paper 7. We have not yet decided the merits of these proceedings, and final written decisions have not yet been entered in these proceedings. Under these circumstances, we determine it is appropriate to terminate the proceedings with respect to both parties. Further, after reviewing the Settlement Agreement between Petitioner and Patent Owner, we determine it is appropriate to treat the Settlement Agreement as business confidential information and keep it separate from the files of the patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

Accordingly, it is

ORDERED that the Joint Motions to Terminate IPR2019-00779, IPR2019-00780, IPR2019-00781, IPR2019-00782, IPR2019-00783, IPR2019-00784, and IPR2019-00785 are *granted*, and these proceedings are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests to treat the Settlement Agreement as business confidential information are *granted*, and the Settlement Agreement shall be kept separate from the files of the patents under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2019-00779 through -00785

Patents 5,934,974; 6,099,386; 6,163,492; 6,469,559; 6,597,201

PETITIONER:

Naveen Modi

Joseph E. Palys

Paul M. Anderson

Chetan R. Bansal

PAUL HASTINGS LLP

naveenmodi@paulhastings.com

josephpalys@paulhastings.com

paulanderson@paulhastings.com

chetanbansal@paulhastings.com

PATENT OWNER:

Craig R. Kauffman

Kevin C. Jones

TECHKNOWLEDGE LAW GROUP LLP

ckaufman@tklg-llp.com

kjones@tklg-llp.com