

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SMIC, AMERICAS,

Petitioner,

v.

INNOVATIVE FOUNDRY TECHNOLOGIES LLC,

Patent Owner

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Case No. IPR2020-01003

U.S. Patent No. 6,580,122

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**JOINT MOTION TO TERMINATE PURSUANT TO  
35 U.S.C. § 317, AND 37 C.F.R. §§ 42.72 AND 42.74**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization on April 27, 2021, Petitioner SMIC, Americas ("SMIC") and Patent Owner Innovative Foundry Technologies LLC ("IFT") (collectively, the "Parties") jointly move to terminate the present proceeding in light of the Parties' agreement to terminate this proceeding.

The Parties have reached an agreement to file a motion to terminate this proceeding. The Parties are concurrently filing a true and correct copy of their written Settlement Agreement in connection with this matter as required by statute as Confidential Exhibit 1028. The parties jointly certify that, aside from the Settlement Agreement, there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements or understandings, made in connection with, or in contemplation of, the termination of the present proceeding. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

## **I. Legal Standard**

An AIA trial proceeding "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." 35 U.S.C. § 317(a); § 327(a). A joint motion to terminate generally "must (1) include

a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at \*2 (P.T.A.B. July 28, 2014).

## **II. Dismissal of District Court Matter and Issuance of Settlement Agreement Warrants Termination**

Termination of the present proceeding is appropriate as the Board has not yet decided the merits of the proceeding, the subject patent has been dismissed, with prejudice, from the litigation between the Parties, and the parties have agreed that it is appropriate to terminate this proceeding. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *DTN LLC v. Farms Technology, LLC*, IPR2018-01412, Paper No. 21 (P.T.A.B. June 14, 2019) (precedential). Terminating this proceeding promotes the Congressional goal to establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* Patent Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). In view of the dismissal, with prejudice, of the subject patent from the litigation between the Parties, the absence of any other pending litigation involving this patent, or any public interest or other factors militating against termination, termination of this proceeding is justified.

### III. Related Proceedings

With respect to the second, third, and fourth *Heartland Tanning* requirements, the Parties identify below any related litigation and proceedings before the Office involving the patent-at-issue, U.S. Patent No. 6,580,122, as well as the current status of each such litigation and proceeding.

Case Name	Parties	Status
<i>SMIC, Americas et al. v. Innovative Foundry Technologies LLC</i> , Case No. 3:20-cv-02256 (N.D. Cal. April 2, 2020)	SMIC, Americas; Semiconductor Manufacturing International (Shanghai) Corporation; Semiconductor Manufacturing International (Beijing) Corporation; Semiconductor Manufacturing International (Tianjin) Corporation; Semiconductor Manufacturing International (BVI) Corporation; Semiconductor Manufacturing North China (Beijing) Corporation; Semiconductor Manufacturing South China Corporation; and Innovative Foundry Technologies LLC.	Dismissed
<i>Innovative Foundry Technologies LLC v. Semiconductor Manufacturing International Corp. et al.</i> , Case No. 6:19-cv-00719 (W.D. Tex. Dec. 20, 2019)	Innovative Foundry Technologies LLC; Semiconductor Manufacturing International Corporation; Semiconductor Manufacturing International (Shanghai) Corporation; Semiconductor Manufacturing International (Beijing) Corporation; Semiconductor Manufacturing International (Tianjin) Corporation; Semiconductor Manufacturing	Dismissed as to the SMIC, Broadcom, and Cypress defendants;  Pending dismissal as to DISH Network. <sup>1</sup>

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<sup>1</sup> On April 22, 2021, IFT and DISH Network filed a Stipulation of Dismissal to dismiss IFT's claims against DISH with prejudice.

	International (BVI) Corporation; Semiconductor Manufacturing North China (Beijing) Corporation; Semiconductor Manufacturing South China Corporation; Broadcom Incorporated; Broadcom Corporation; Cypress Semiconductor Corporation; and DISH Network Corporation.	
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The '122 patent has not been asserted in any action other than those listed above.

The Parties also provide the following list of other PTAB proceedings  
between the Parties:

<b>Case</b>	<b>Patent-at-Issue</b>	<b>Filing Date</b>	<b>Status</b>
IPR2020-00786	7,009,226	April 9, 2020	Pending
IPR2020-00837	6,806,126	April 14, 2020	Institution Denied
IPR2020-00839	6,933,620	April 14, 2020	Institution Denied
IPR2020-01003	6,580,122	June 9, 2020	Pending

The '122 patent is only at issue in the present matter. The other proceedings listed above are on unrelated patents. The Parties intend to file joint motions to terminate in each of the other PTAB proceedings pending between the Parties identified in the table above.

Respectfully submitted by:

Date: April 27, 2021

/ Yufeng Ma /

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the foregoing was served by electronic mail on counsel of record for the Patent Owner as follows:

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Respectfully submitted by:

Date: April 27, 2021

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