

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMIC, AMERICAS,
Petitioner,

v.

INNOVATIVE FOUNDRY TECHNOLOGIES, LLC,
Patent Owner.

IPR2020-00786
Patent No. 7,009,226 B1

IPR2020-01003
Patent No. 6,580,122 B1

Before JON B. TORNQUIST, CHRISTOPHER M. KAISER,
JULIA HEANEY, and SCOTT E. BAIN, *Administrative Patent Judges*.

BAIN, *Administrative Patent Judge*.

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

On April 27, 2021, pursuant to our authorization, the parties filed Joint Motions to Terminate proceedings in the above-captioned cases. Paper 23 (“Motion”)¹; IPR2020-01003, Paper 18. Accompanying the motions, the parties filed copies of a settlement and license agreement (“Settlement Agreement”), along with a Joint Request To File Settlement Agreement As Business Confidential Information, to be kept separate from the files of the involved patent and inter partes review pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Ex. 1037; Paper 24.

The parties state that the Settlement Agreement “resolves all underlying disputes” between Petitioner and Patent Owner regarding the patents in the above-captioned cases. Paper 24, 1. The parties further state that termination is justified “[i]n view of the dismissal, with prejudice, of the subject patent[s] from the litigation between the Parties, the absence of any other pending litigation involving [the] patent[s], or any public interest or other factors militating against termination.” Paper 23, 3. Finally, the parties state that they are unaware of any other pending proceedings relating to the subject patents before the Board, or any other matter before the USPTO that would be affected by the requested termination of these proceedings. *Id.* at 4, 7.

We granted institution of *inter partes* review in these proceedings, but have not yet made a determination on the merits. Under the present circumstances, we determine that it is appropriate to terminate the proceedings. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

¹ Our Decision refers to the paper numbers associated with IPR2020-00786. The filings in IPR2020-01003 are essentially identical.

IPR2020-00786 (Patent 7,009,226 B1)

IPR2020-01003 (Patent 6,580,122 B1)

As requested by the parties, the Settlement Agreement will be treated as business confidential information and kept separate from the patent files. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the Joint Motions to Terminate IPR2020-00786 and IPR2020-01003 are *granted*;

FURTHER ORDERED that the parties' Joint Requests to have their Settlement Agreement treated as business confidential information, to be kept separate from the patent files, are *granted*; and

FURTHER ORDERED that the proceedings in IPR2020-00786 and IPR2020-01003 are *terminated*.

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