

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SK HYNIX INC. and SK HYNIX AMERICA INC.,
Petitioner,

v.

NETLIST, INC.,
Patent Owner.

IPR2020-01042 (Patent 10,474,595 B2)
IPR2020-01044 (Patent 9,858,218 B1)
IPR2020-01421 (Patent 10,217,523 B1)¹

Before BRYAN F. MOORE, JON M. JURGOVAN, SHEILA F. McSHANE
and KARA L. SZPONDOWSKI, *Administrative Patent Judges*.²

PER CURIAM.

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

¹ We exercise our discretion to issue one order for all of the above captioned proceedings. The proceedings have not been consolidated, and the parties are not authorized to use this caption format.

² This is not an expanded panel of the Board. It is a listing of all Judges on the panels of the above-listed proceedings.

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I. INTRODUCTION

With the Board’s authorization, Petitioner SK hynix Inc. and SK hynix America Inc. (“Petitioner”) and Netlist, Inc. (“Patent Owner”) (collectively “the Parties”) filed in each of the above proceedings a Joint Motion to Withdraw Petition for *Inter Partes* Review in each of the above-identified proceedings (“Joint Motion”). Paper 22.³ In support of the Joint Motion, the Parties filed in each proceeding a corresponding Confidential Agreement, Ex. 2035 (“Settlement Agreement”),⁴ as well as a corresponding Joint Request to Keep Agreement Confidential and Separate pursuant to 37 C.F.R. § 42.74(c), Paper 23 (“Joint Request”).⁵

II. DISCUSSION

In each Joint Motion, the Parties represent that Petitioner and Patent Owner have resolved their disputes and request that “the Board terminate this proceeding in its entirety.” Joint Motion 1–2. The Parties represent that the Agreement is “a true copy of any agreement [and] understanding . . . made in connection with, or in contemplation of, the withdrawal of the Petition for the proceeding under 37 CFR 42.74(b).” *Id.* at 1. The Parties

³ For purposes of expediency, we cite to Papers filed in IPR2020-01044, unless otherwise noted. The Parties filed a similar Motion in IPR2020-01042 (Paper 23) and IPR2020-01421 (Paper 14). Although the Parties were authorized to file a Joint Motion to Terminate the Proceedings under 37 C.F.R. § 42.72, the Parties stylize their Motion as a Motion to Withdraw Petition for *Inter Partes* Review. We treat the Motion as a Joint Motion to Terminate the proceedings under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

⁴ For purposes of expediency, we cite to Exhibits filed in IPR2020-01044. The Settlement Agreement was filed in IPR2020-01042 as Exhibit 2035 and in IPR2020-01421 as Exhibit 2022.

⁵ The Parties filed a similar Request in IPR2020-01042 (Paper 24) and IPR2020-01421 (Paper 15).

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further represent that they have “filed a joint motion to dismiss with prejudice” the concurrent district court litigation regarding the patents at issue, and “do not anticipate further litigation between them concerning the . . . patent[s].” *Id.* Accordingly, the Parties jointly request termination of these proceedings. *Id.* at 2.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Consolidated Trial Practice guide, 86 (Nov. 2019) (Consolidate TPG”); *see* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Here, although the Board has instituted *inter partes* review in each of the above-identified proceedings, the Board has not decided the merits of these proceedings. Under these circumstances, therefore, we determine that it is appropriate to terminate these proceedings as to the Parties, without rendering a final written decision.

In each Joint Request, the Parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patent involved in these *inter partes* proceedings. Joint Request 1. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

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III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Joint Motion to Terminate each proceeding is *granted*, and the above-identified proceedings are *terminated*; and

FURTHER ORDERED that the Joint Request to Keep Agreement Confidential and Separate in each proceeding is *granted*, and the Settlement Agreement shall be kept separate from the file of Patents; 10,474,595 B2, 9,858,218 B1, and 10,217,523 B1 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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