

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROCHIP TECHNOLOGY INCORPORATED AND MICROSEMI
CORPORATION
Petitioners

v.

BELL SEMICONDUCTOR LLC
Patent Owner

Case IPR2021-00191
Patent 7,221,173

JOINT MOTION TO TERMINATE PROCEEDING

Petitioners Microchip Technology Incorporated and Microsemi Corporation and Patent Owner Bell Semiconductor LLC (collectively “Parties”) hereby jointly move for an order terminating the petition for inter partes review filed November 16, 2020, directed to Patent No. 7,221,173 (“the ’173 patent”) and assigned case number IPR2021-00191.

Patent Owner filed its preliminary response on March 22, 2021. The PTAB has yet to issue an institution decision.

The Parties have settled their dispute, and have reached agreement to terminate this proceeding. Pursuant to 37 C.F.R. § 42.74, the parties and their counsel confirm that any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of the instant proceeding is in writing and a true copy is being filed with the Board. Specifically, the Parties’ Settlement Agreement has been made in writing, and a true copy of the same is attached as Exhibit 2033.

In addition, the Parties desire the Settlement Agreement be maintained as business confidential under 37 C.F.R. §42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

1. Reasons Why Termination Is Appropriate

Termination is proper because the Parties are jointly requesting termination, the review is still in its early stages, and the Office has not yet “decided the merits

of the proceeding before the request for termination is filed.” As noted in the Patent Office Trial Practice Guidelines, “there are strong public policy reasons to favor settlement between the parties to a proceeding The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”¹ Accordingly, termination is appropriate here.

The Parties understand that if the Board terminates this petition for inter partes review, no estoppel under 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d)(1) will attach to Petitioners. The Parties understand that if the Board terminates this petition for inter partes review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

As authorized by email on May 21, 2021, a true copy of the agreement made in connection with, or in contemplation of, the termination of this petition for inter partes review is being contemporaneously filed herewith as Exhibit 2033.

2. Status of Related District Court Litigation

The ’173 patent is the subject of the following pending litigation:

- *Bell Semiconductor, LLC v. Microchip Technology Incorporated et al.*, No. 6:20-cv-00296 (W.D. Tex.).

¹ See Federal Register Vol. 77, No. 157 at 48768.

On May 20, 2021, Patent Owner and Petitioners filed a joint motion to dismiss their respective claims and counterclaims in the *Bell Semiconductor, LLC v. Microchip Technology Incorporated*, No. 6:20-cv-00296 proceeding. There are no other pending proceedings between the Petitioners and Patent Owner relating to the '173 patent.

For the foregoing reasons, the Parties jointly request termination of IPR2021-00191.

Respectfully submitted,

Date: May 24, 2021

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1), the undersigned certifies that on May 24, 2021, a copy of Joint Motion to Terminate Proceeding, Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 37 C.F.R. § 42.74(c) and accompanying exhibit were provided via email, to Petitioners by serving the email correspondence addresses of record as follows:

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