Trials@uspto.gov
Tel: 571–272–7822

Paper 42
Entered: December 5, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TPK AMERICA, LLC,
Petitioner,

v.

WINTEK CORPORATION,
Patent Owner.

IPR2013-00433 (U.S. Patent No. 8,294,677 B2)
IPR2013-00436 (U.S. Patent No. 8,330,738 B2)
IPR2014-00927 (U.S. Patent No. 8,482,542 B2)
IPR2014-00928 (U.S. Patent No. 8,477,113 B2)

Before KEVIN F. TURNER, WILLIAM V. SAINDON, and THOMAS L. GIANNETTI, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

ORDER
Termination of the Proceedings
37 C.F.R. § 42.73

I. DISCUSSION

On November 29, 2014, Petitioner and Patent Owner filed a Joint Motion to Terminate and a Motion to File Settlement Agreement Confidentially in each of IPR2013-00433, IPR2013-00436, IPR2014-00927, and IPR2014-00928 ("the Proceedings"). We authorized the parties to file these motions during a conference call held November 25, 2014. For the reasons below, in each of the Proceedings, we grant both motions and terminate the proceeding.

Petitioner asserts that it has filed, in total, four petitions requesting review of Patent Owner's patents. IPR2014-00927 and IPR2014-00928 are both in the pre-trial stage; decisions on whether to institute *inter partes* review are due December 18, 2014. IPR2014-00433 and IPR2014-00436 have had their oral arguments. No final written decisions have been entered in any of the Proceedings.

The Joint Motion to Terminate asserts that TPK Holding Co., Ltd. (Petitioner's parent company) and Patent Owner entered into a settlement agreement that resolved all litigation relating to the patents challenged in the Proceedings.[1] A copy of the settlement agreement has been filed in each of the Proceedings. In the settlement agreement, TPK Holding Co., Ltd. and Patent Owner agreed to request termination of the Proceedings, and to assign the patents challenged in the Proceedings to TPK Holding Co., Ltd. Thus, all of the relevant parties in the Proceedings have expressed their desire to terminate the Proceedings.

Based on the facts presented, we determine that it is appropriate to terminate the Proceedings. Thus, the Joint Motions to Terminate are granted. In addition,

[1] *TPK America, LLC v. Wintek Corp.*, No. 1:13-CV-01221 (D. Del).

we determine there is good cause and, therefore, grant the Joint Motions to treat the settlement as business confidential information.

II. ORDER

In view of the foregoing, it is hereby:

ORDERED that the settlement agreement filed in the Proceedings (IPR2013-00433—Exhibit 1016, IPR2013-00436—Exhibit 1015, IPR2014-00927—Exhibit 1019, and IPR2014-00928—Exhibit 1019) is to be treated as business confidential information and to be kept separate from the patent file;

FURTHER ORDERED that the Joint Motions to Terminate IPR2013-00433, IPR2013-00436, IPR2014-00927, and IPR2014-00928 are granted;

FURTHER ORDERED that IPR2013-00433, IPR2013-00436, IPR2014-00927, and IPR2014-00928 are terminated.

IPR2013-00433 (U.S. Patent No. 8,294,677 B2)
IPR2013-00436 (U.S. Patent No. 8,330,738 B2)
IPR2014-00927 (U.S. Patent No. 8,482,542 B2)
IPR2014-00928 (U.S. Patent No. 8,477,113 B2)

For PETITIONER:

Davin Stockwell
Don Daybell
Mark Shean
ORRICK, HERRINGTON, & SUTCLIFFE LLP
dstockwell@orrick.com
ddaybell@orrick.com
mshean@orrick.com
D2SPTABDocket@orrick.com
M2SPTABDocket@orrick.com

For PATENT OWNER:

Joseph Palys
Naveen Modi
Abhay Watwe
PAUL HASTINGS LLP
Joseph.palys@finnegan.com
Naveen.modi@finnegan.com
Abhay.watwe@finnegan.com