

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AAC TECHNOLOGIES PTE. LTD.,
Petitioner,

v.

MEMSMART SEMICONDUCTOR CORPORATION,
Patent Owner.

Case IPR2014-01246
Patent 7,829,364 B2

Before JENNIFER S. BISK, BRIAN P. MURPHY, and
MICHELLE N. ANKENBRAND, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
35 U.S.C. 317(a)

On December 29, 2015, Petitioner, AAC Technologies, and Patent Owner, MemSmart Semiconductor Corporation, filed a joint motion to terminate this proceeding under 35 U.S.C. § 317(a) (Paper 25, “Mot.”) and to keep the simultaneously filed settlement agreement, Exhibit 1018 (designated as “Parties and Board Only”), as business confidential information under 37 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 26).

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” In their joint motion, the parties request termination of the instant proceeding because they have settled their disputes with regard to U.S. Patent No. 7,829,364 (“the ’364 patent”). Mot. 2.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties to the proceeding. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties filed such a settlement agreement. Ex. 1018. The joint motion represents that the settlement resolves the disputes between the parties, with respect to the ’364 patent, in the related district court action as well. Mot. 1. Although an Institution Decision was entered in February, 2015 (Paper 8), the parties notified the panel of their settlement prior to oral hearing and before the panel decided the merits of the proceeding.

Under these circumstances, we determine that it is appropriate to enter judgment and terminate the proceeding without rendering a final written decision. 37 C.F.R. § 42.72.

ORDER

It is

ORDERED that the joint motion to terminate this proceeding is *granted*; and

FURTHER ORDERED that the joint request that the settlement agreement (Ex. 1018) be treated as business confidential information and be kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

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