

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.
Petitioner,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case IPR2016-01135¹
Patent 5,812,789

Before JAMES B. ARPIN and MATTHEW R. CLEMENTS, *Administrative
Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
35 .S.C. § 317; 37 C.F.R. §§ 42.72 and 42.74

¹ Case IPR2017-00512 has been joined to this proceeding.

I. DISCUSSION

Apple Inc. filed a Petition requesting *inter partes* review of claim 1–8 and 11–14 of U.S. Patent 5,812,789 (“the ’789 patent”). Paper 2. In December 2016, we instituted *inter partes* reviews of claims 1–8 and 11–14 (“the instituted claims”) of U.S. Patent No. 5,812,789. Paper 7 (“Decision to Institute”).

In January 2017, HTC Corporation and HTC America, Inc. (collectively, “HTC”), filed an identical petition and motion for joinder requesting that we join HTC as a party to this proceeding, which we granted in June 2017. Paper 27.

In August 2017, we issued a Final Written Decision in an earlier-filed proceeding in which HTC was a party that held unpatentable claims 1, 3–6, 11, and 13 of the ’789 patent. *Apple Inc., HTC Corporation, and HTC America, Inc., v. Parthenon Unified Memory Architecture LLC*, Case IPR2016-00923 (PTAB Aug. 4, 2017) (Paper 39) (“923 FWD”).

On September 20, 2017, we granted a Motion to Terminate only as to Apple Inc., leaving HTC as the only remaining Petitioner. Paper 41.

On September 22, 2017, in light of the 923 FWD, we vacated our Decision to Institute with respect to all but claims 2, 7, 8, 12, and 14 of the ’789 patent. Paper 43.

On October 6, 2017, the parties filed, with authorization, a Joint Motion to Terminate Proceeding (Paper 45), a true copy of the parties’ settlement agreement (Ex. 1026), and a request to treat the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 46). In the Joint Motion to Terminate Proceeding, the parties represent that they have settled all of their disputes regarding claims 2, 7, 8, 12, and 14 of the ’789 patent. Paper 45, 1–2. The parties continue to dispute, in an appeal recently docketed at the Court of Appeals for the Federal Circuit, the patentability of claims 1, 3–6, 11, and

13 of the '789 patent. *Id.* at 2. Under these circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decision. *See* 35 U.S.C. § 317; 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' request to treat the settlement agreement (Ex. 1026) as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the Joint Motion to Terminate Proceeding is *granted*, and this proceeding is hereby terminated.

IPR2016-01135
Patent 5,812,789

For PETITIONER:

Joseph A. Micallef
Stephen M. Everett
David O' OBrien
jmicallef@sidley.com
samuel.dillon@sidley.com
david.obrien.ipr@haynesboone.com

For PATENT OWNER:

Massod Anjom
Scott Clark
AHMAD, ZAVITSANOS, ANAIPAKOS, ALAVI &
MENSING P.C.
manjom@azalaw.com
sclark@azalaw.com