

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS, INC.

Petitioner,

v.

SEMCON IP INC.,

Patent Owner.

Case IPR2017-01425

Patent 5,978,876

Before BRYAN MOORE, STACEY G. WHITE, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate
37 C.F.R. §§ 42.5(a), 42.72

On January 11, 2018, Texas Instruments, Inc. (“Petitioner”) and Semcon IP, Inc. (“Patent Owner”) filed a Joint Motion to Terminate Proceeding (“Motion to Terminate”) stating the parties have settled their dispute over U.S. Patent No. 5,978,876 (“the ’876 patent”). Paper 11, 1. The parties also state that they “have settled their related district court litigation, and the case has been dismissed with prejudice. *Semcon IP Inc. v. Huawei Device USA Inc. et al.*, No 4:16-cv-01729, Order Granting Agreed Motion to Dismiss With Prejudice Texas Instruments Incorporated, (E.D. Tex. January 11, 2018) (D.I. 502)”. *Id.*¹

The parties represent their settlement agreement has been made in writing, a true and correct copy of which is filed separately as Exhibit 2003 (“Settlement Agreement”), and that the Settlement Agreement represents all agreements made in connection with, or in contemplation of, the termination of this proceeding. *Id.* The parties also filed a joint motion requesting that the Settlement Agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 12.

This matter is at a stage prior to its final hearing and no decision on the merits has been made. The motion for joinder filed in Case IPR2017-01432, seeking joinder with the present proceeding, has been denied.

Based on the facts of this case, it is appropriate to terminate the proceedings with respect to both parties without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R §§ 42.72, 42.74. Therefore, the

¹ It appears that the case number listed above is a typographical error and the correct case number is 2:16-cv-00437. *See* Ex. 3001 (*Semcon IP Inc. v. Huawei Device USA Inc. et al.*, No 2:16-cv-00437, Order Granting Agreed Motion to Dismiss With Prejudice, (E.D. Tex. January 11, 2018) (D.I. 502)).

joint motion to terminate the proceeding is granted. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the joint motion to terminate the proceeding is GRANTED and the proceeding is terminated with respect to both the Petitioner and the Patent Owner; and

FURTHER ORDERED that the confidential settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and be kept separate from the file of the patent.

IPR2017-01425
Patent 5,978,876

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