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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC., TOSHIBA CORPORATION, TOSHIBA MEMORY CORPORATION, AND STMICROELECTRONICS, INC.,
Petitioner,

v.

LONE STAR SILICON INNOVATIONS, LLC,
Patent Owner.

Case IPR2017-01560[1]
Patent 5,912,188

Before GRACE KARAFFA OBERMANN, KRISTINA M. KALAN, and ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION
Granting Joint Motion to Terminate as to STMicroelectronics, Inc.
35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74

[1] The motions for joinder filed by Petitioners in Cases IPR2018-00081, and IPR2018-00435 were granted, and Toshiba Corporation, Toshiba Memory Corporation, and STMicroelectronics, Inc. have been joined as parties to Case IPR2017-01560.

On December 15, 2017, we instituted an *inter partes* review of certain claims of U.S. Patent No. 5,912,188 ("the '188 Patent"). Paper 10, 2. On April 27, 2018, we modified the scope of review in view of *SAS*.[2] Paper 17. On May 4, 2018, STMicroelectronics, Inc. ("STMicro") was joined as a party. Paper 18.[3]

On June 25, 2018, with the prior authorization of the Board, Petitioner STMicro and Patent Owner Lone Star Silicon Innovations, LLC (collectively, "the parties") filed a joint motion to terminate the *inter partes* review with respect to STMicro pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74. Paper 24. The parties represent that "STMicro and Patent Owner have resolved their dispute regarding the '188 patent and have agreed to terminate this proceeding." *Id.* at 2.

With the motion, the parties filed Exhibit 2021, which they represent is "a true and complete copy" of their written agreement resolving their dispute regarding the '188 patent. Paper 24, 1. The parties certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding. *Id.*

The parties request that their written agreement (Ex. 2021) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 25.

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[2] *SAS Institute Inc. v. Iancu*, 138 S.Ct. 1348 (2018).

[3] Our decision granting STMicro's motion for joinder was entered on May 4, 2018 in Case IPR2018-00435 and was entered as Paper 18 on May 9, 2018 in Case IPR2017-01560.

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 this case, Petitioner's discovery period is still open, and Petitioner has not yet filed a Reply. The Board has not yet held an oral hearing and has not yet decided the merits of the *inter partes* review. Under these circumstances, and in view of the parties' representations in their joint motion, we determine that it is appropriate to terminate this proceeding as to STMicro. The grant of the motion to terminate will not result in the termination of the *inter partes* review, however, because Micron Technology, Inc., Toshiba Corporation, and Toshiba Memory Corporation remain as Petitioners.

We also determine that it is appropriate that the parties' written agreement (Ex. 2021) be treated as business confidential information and be kept separate from the patent files pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding with respect to STMicro is *granted*, and this proceeding is terminated only as to STMicro; and

FURTHER ORDERED that the parties' joint request that their written agreement (Ex. 2021) be treated as business confidential information and kept separate from the patent files, is *granted*.

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