

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

VLSI TECHNOLOGY LLC,
Patent Owner.

IPR2019-01198
IPR2019-01199
IPR2019-01200¹
Patent 7,247,552 B2

Before THU A. DANG, BARBARA A. BENOIT, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

TERMINATION
Due to Settlement on Remand
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ We issue a single decision to be entered in each proceeding. The parties are not authorized to use a multi-case caption.

I. INTRODUCTION

Petitioner, Intel Corporation, challenged claims 1, 2, 11, and 20 of U.S. Patent No. 7,247,552 B2 (Ex. 1001,² “the ’552 patent”) in three *inter partes* reviews: IPR2019-01198 (challenging claims 1 and 2), IPR2019-01199 (challenging claim 20), and IPR2019-01200 (challenging claim 11). IPR2019-01198, Paper 3; IPR2019-01199, Paper 3; IPR2019-01200, Paper 3. On February 3, 2021, we issued a single Final Written Decision that was entered in each of these proceedings. IPR2019-01198, Paper 49 (“Final Dec.”); IPR2019-01199, Paper 49; IPR2019-01200, Paper 49. In the Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1, 2, 11, and 20 of the ’552 patent are unpatentable. Final Dec. 70–71.

Patent Owner, VLSI Technology LLC, appealed to the U.S. Court of Appeals for the Federal Circuit. Paper 50. On appeal, the Federal Circuit affirmed our determination that claims 1, 2, and 11 are unpatentable, reversed our construction of a claim term recited in claim 20, and remanded for further proceedings regarding claim 20. *VLSI Tech. LLC v. Intel Corp.*, 53 F.4th 646, 656 (Fed. Cir. 2022); *see* Paper 51 (Federal Circuit mandate).

On February 3, 2023, the parties filed a Joint Motion to Terminate these remanded proceedings. Paper 53 (“Motion” or “Mot.”).³ The parties also filed what they indicate are true copies of a written agreement between

² We cite to the record in IPR2019-01198, unless otherwise noted.

³ The parties filed substantially the same motion in IPR2019-01199 (Paper 53) and IPR2019-01200 (Paper 53).

the parties (Exs. 1026, 1027,⁴ “Agreement”) and a Joint Request to treat the Agreement as business confidential information. Paper 54 (“Joint Request” or “Req.”).⁵

II. DISCUSSION

The parties indicate they “have reached a settlement regarding this matter.” Mot. 2. The Motion states that “[a]s required by 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the written agreement that contemplates the termination of [these] proceeding[s] has been filed with this motion.” *Id.* at 3. Accordingly, “Patent Owner and Petitioner jointly request that the Board terminate [these] proceeding[s] for *inter partes* review, without further proceedings, adverse judgment, or a remand decision.” *Id.* at 2.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board already has decided the merits of the proceeding. PTAB Consolidated Trial Practice Guide, 86 (Nov. 2019).⁶ Here, although the Board already has issued a Final Written Decision, the Federal Circuit reversed the part of that decision addressing claim 20 of the ’552 patent and remanded to the Board for further proceedings regarding claim 20. The Board has not issued a decision on remand and, thus, has not decided the merits of the issues that were remanded to the Board. Under these circumstances, we determine it is appropriate to grant the Motion and terminate the proceedings.

⁴ The parties signed separate copies of the same agreement (Exs. 1026, 1027). *See* Mot. 3 n.1. The separately signed copies of the same agreement were filed in IPR2019-01199 as Exhibits 1130 and 1131 and in IPR2019-01200 as Exhibits 1231 and 1232.

⁵ The parties filed similar requests in IPR2019-01199 (Paper 54) and IPR2019-01200 (Paper 54).

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

The parties also jointly request that the Agreement be treated as business confidential information and be kept separate from the files of the '552 patent and these proceedings. Req. 2. We have reviewed the Agreement, which contains confidential business information regarding the settlement terms, and we determine that good cause exists to treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and keep it separate from the files of the '552 patent and these proceedings. Accordingly, we grant this aspect of the parties' Joint Request.

The parties also "request that the Board order that in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the settlement agreement, that any such written request be served upon Patent Owner and Petitioner on the day the written request is provided to the Board." Req. 2. However, neither the statute nor the regulation provides for any such notification, and the parties have not provided any reason or special circumstance that would justify issuing an order that purports to impose an additional requirement. Accordingly, we deny that portion of the parties' Joint Request.

III. ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate (Paper 53) is *granted* in each of IPR2019-01198, IPR2019-01199, and IPR2019-1200;

FURTHER ORDERED that the Joint Request (Paper 54) is *granted-in-part*;

FURTHER ORDERED that the Agreement (IPR2019-01198, Exs. 1026, 1027; IPR2019-01199, Exs. 1130, 1131; IPR2019-01200,

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Exs. 1231, 1232) shall remain designated as “Parties and Board Only” in the Board’s electronic filing system, be treated as business confidential information, be kept separate from the file of U.S. Patent No. 7,247,552 B2, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that IPR2019-01198, IPR2019-01199, and IPR2019-01200 are terminated.

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