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Paper 62
Date: April 6, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROHM SEMICONDUCTOR USA, LLC,
Petitioner,

v.

MAXPOWER SEMICONDUCTOR INC.,
Patent Owner.

IPR2020-01676
Patent 8,466,025 B2

Before GARTH D. BAER, AARON W. MOORE, and MICHAEL T. CYGAN, *Administrative Patent Judges.*

BAER, *Administrative Patent Judge*.

TERMINATION
After Institution of Trial
35 U.S.C. § 317; C.F.R. §§ 42.72, 42.74

On February 28, 2022, ROHM Semiconductor USA, LLC ("Petitioner") filed an Unopposed Motion to Terminate *Inter Partes* Review. Paper 59 ("Motion"). Petitioner indicates that MaxPower Semiconductor, Inc. ("Patent Owner") does not oppose this Motion. *Id.* at 1. Petitioner also indicates that the Board authorized the filing of this Motion via an e-mail on February 24, 2022. *Id.* As Petitioner observes, we granted a stay in this proceeding for Arbitrator Brainerd to determine if this IPR was subject to arbitration and "[o]n February 10, 2022, Arbitrator Brainerd determined that the parties' dispute over the validity of the instant patent at issue in this proceeding was subject to arbitration and directed Petitioner to request termination of this IPR." *Id.* The Arbitration Order has been filed as Exhibit 1032.

As we have instituted trial in this proceeding (Paper 14), it is a trial subject to termination under 37 C.F.R. § 42.72.

35 U.S.C. § 317(a) provides in pertinent part:

> An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. . . . If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

Although the heading of Section 317(a) is "Settlement," the text of the statute is not so limited. The statute requires that an *inter partes* review "shall" be terminated with respect to a petitioner (1) upon the joint request of that petitioner and the patent owner, (2) unless the merits have been decided. Here, we deem the "joint request" requirement to be satisfied by Petitioner's unopposed request for termination. With respect to the merits, we have issued preliminary guidance on Patent Owner's contingent motion to amend,

but have not decided the merits of the proceeding. Thus, § 317(c) requires termination of the proceeding with respect to the Petitioner.

Because no other petitioner would remain in the proceeding, § 317(a) provides for the Office to either terminate the review or proceed to a final written decision. We acknowledge that validity is a distinct issue that both Petitioner and the general public have an interest in resolving. *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2139–2140, 2144 (2016) (holding that *inter partes* review serves the "important congressional objective of giving the agency significant power to revisit and revise earlier patent grants" and helps "protect the public's paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope") (internal citations omitted). A decision to terminate the proceeding with respect to the Petitioner, and to proceed to a final written decision in the absence of the Petitioner, would satisfy the public interest, the Petitioner's contractual obligations (as represented by the district court), and those advantages to alternative dispute resolution not otherwise captured by *inter partes* review.

However, we recognize that in the context of a settlement, which also implicates such validity concerns, the Board generally expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Patent Trial and Appeal Board Consolidated Trial Practice Guide, 86 (2019). We discern no meaningful difference between the factors at issue for settlement and those presented here in the context of arbitration. Nor has Petitioner presented reasons why this proceeding should continue in its absence. Thus, we find it reasonable to extend our general expectation that a proceeding will terminate due to a settlement to the arbitration context at issue here. Accordingly, we terminate the *inter partes* review as set forth in § 317(a).

When a proceeding is terminated under § 317, any agreement or understanding between the parties connected with the termination shall be filed in the Office before the *inter partes* review may be terminated. 35 U.S.C. § 317(b). In this case, the parties are engaged in an arbitration proceeding and Petitioner represents that the arbitrator has determined that the dispute raised by the petition for *inter partes* review is "subject to arbitration and directed Petitioner to request termination of this IPR." Motion, 1. The parties request termination of the *inter partes* review in order to comply with the arbitrator's determination. *Id.* Consequently, the arbitrator's determination is an agreement or understanding between the parties connected with the termination, and must be filed before the *inter partes* review may be terminated. As noted above, the arbitrator's determination has been filed. *See* Ex. 1032.

Importantly, we have not considered the merits of the petition for this proceeding. Based on the facts of the case, and in view of the Unopposed Motion to Terminate, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner without rendering any further decisions. *See* 37 C.F.R. §§ 42.5(a), 42.72. Therefore, the Motion to Terminate 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 Motion to Terminate is *granted*; and

FURTHER ORDERED that this proceeding is terminated with respect to both Petitioner and Patent Owner.

PETITIONER:

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