

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SEMICONDUCTOR COMPONENTS INDUSTRIES, LLC d/b/a
ON SEMICONDUCTOR,
Petitioner,

v.

TESSERA ADVANCED TECHNOLOGIES, INC.,
Patent Owner.

IPR2020-01732
Patent 6,317,333 B1

Before MICHAEL R. ZECHER, TREVOR M. JEFFERSON, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

I. DISCUSSION

On November 9, 2020, the parties filed the following documents: (1) a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72 (Paper 7, “Mot.”); (2) a true copy of the parties’ settlement agreement (Ex. 1025); and (3) a Joint Request to File Settlement Agreement as Business Confidential Information and to Maintain Agreement Separate From the Public File Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 8). For the following reasons, we *grant* both the parties’ Joint Motion to Terminate and their request to treat the settlement agreement as business confidential information.

This proceeding is still in its preliminary stage. Petitioner, Semiconductor Components Industries, LLC d/b/a ON Semiconductor (“ON”), filed a Petition requesting an *inter partes* review of claims 1 and 2 of U.S. Patent No. 6,317,333 B1 (Ex. 1001, “the ’333 patent”) (Paper 1), along with a Motion for Joinder to IPR2020-00708 (Paper 3). Since ON filed the Petition, Patent Owner, Tessera Advanced Technologies, Inc. (“Tessera”), has not filed a Preliminary Response, Tessera has not filed an Opposition to the Motion for Joinder, and we have not entered a decision whether to institute an *inter partes* review nor have we entered a decision addressing the Motion for Joinder.

In the Joint Motion to Terminate, the parties indicate that they “have resolved their dispute with respect to the ’333 patent, and [they] have agreed to terminate this [proceeding].” Mot. 2. The parties represent that Exhibit 1025 is “a true and complete copy” of an “Agreement and Covenant Not to Sue,” and that “there are no other agreements or understandings, oral or written, between [Tessera] and [ON], including any collateral agreements, made in connection with, or in contemplation of, the termination of [this] proceeding.” *Id.* at 1.

The parties further represent that the '333 patent is involved in the following two matters: (1) *Invensas Corp. and Tessera Advanced Techs., Inc. v. NVIDIA Corp.*, No. 19-cv-861-RGA (D. Del.) (“district court case”); and (2) IPR2020-00708 currently pending before the Board. Mot. 2. According to the parties, the district court case has been dismissed with prejudice and the parties in IPR2020-00708 have filed a Joint Motion to Terminate. *Id.* at 2–3 (citing *NVIDIA Corp. v. Tessera Advanced Techs., Inc.*, IPR2020-00708, Paper 13 (PTAB Oct. 23, 2020) (Joint Motion to Terminate)). We will be entering a decision granting the Joint Motion to Terminate filed in IPR2020-00708 concurrently.

Under these particular circumstances, we determine that it is appropriate to dismiss the Petition without rendering any further decisions, thereby terminating this proceeding. *See* 37 C.F.R. § 42.71(a). We also have reviewed the true copy of the parties’ settlement agreement, and we determine that good cause exists to treat this settlement agreement as business confidential information, and keep it separate from the file of the '333 patent, pursuant to 37 C.F.R. § 42.74(c).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ request to treat the true copy of their settlement agreement filed in this proceeding (Ex. 1025) as business confidential information, and keep it separate from the file of the '333 patent, pursuant to 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the parties’ Joint Motion to Terminate is *granted*, and the Petition is dismissed resulting in termination of this proceeding.

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Patent 6,317,333 B1

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