

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

OPTICURRENT, LLC,
Patent Owner.

IPR2021-01460
Patent 6,958,623 B2

Before GREGG I. ANDERSON, KRISTINA M. KALAN, and
JON B. TORNQUIST, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Joint Motion to Terminate
37 C.F.R. §§ 42.5(a), 42.71(a)

On March 1, 2022, Petitioner Semiconductor Components Industries, LLC d/b/a onsemi (“Petitioner” or “onsemi”) and Opticurrent, LLC (“Patent Owner” or “Opticurrent”) filed a Joint Motion to Terminate Proceeding (“Mot.” or “Motion to Terminate,” Paper 16) based on a *Cross License Agreement* that resolves the parties’ disputes related to the challenged patent, US Patent No. 6,958,623 B2 (“’623 patent”). Paper 16, 3. On that same date, the parties filed a copy of the *Cross License Agreement* as Exhibit 2003 along with a Joint Request to File Cross License Agreement as Confidential Business Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (“Request to Keep Confidential”). Paper 15.

Paper 14 is the same request as Paper 15 but mistakenly refers to the *Cross License Agreement* as Exhibit 1061. Paper 14, 2. Unless the parties object within five (5) days of the mailing of this Decision, Paper 14 will be expunged.

Under 35 U.S.C. § 317(a), “[i]f 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).” Petitioner is the sole petitioner in this proceeding. The Board has discretion to terminate these reviews with respect to the Patent Owner. No institution decision has been issued, and, apart from the instant motions, there are no outstanding motions in these proceedings. *See* Mot. 1. We determine that there is a strong public policy favoring settlement and find no public interest factors that mitigate against termination of the proceeding.

The Board acknowledges that the *Cross License Agreement* appears to be a true copy. There are no pending related district court actions between the parties relating to the challenged patent. *See* Paper 16, 4.

The Board determines that, in the circumstances of this case, it is appropriate to terminate the proceeding. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The Board further determines the parties have sufficiently shown reasons for granting the Request to Keep Confidential under 37 C.F.R. § 42.74(c).

ORDER

Accordingly, it is

ORDERED that the Motion to Terminate is *granted* and the proceeding is terminated;

FURTHER ORDERED that the Request to Keep Confidential is *granted* and the *Cross License Agreement* (Exhibit 2003) shall be treated as business confidential information and be kept separate from the files of the involved U.S. Patent No. 6,958,623 B2; and

FURTHER ORDERED that if neither party objects within five (5) days of the mailing of this Decision, Paper 14 will be expunged.

IPR2020-01460
Patent 6,958,623 B2

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