

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR
MANUFACTURING COMPANY LIMITED,
Petitioner,

v.

ALIDDOUBLE, INC.,
Patent Owner.

IPR2023-00369 (Patent 9,356,169 B2)
IPR2023-00372 (Patent 6,169,319 B1)
IPR2023-00373 (Patent 9,431,455 B2)
IPR2023-00374 (Patent 6,168,965 B1)¹

Before KRISTINA M. KALAN, CHRISTOPHER M. KAISER, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

PER CURIAM.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order applies to all four cases. We exercise our discretion to issue one order to be entered in each case. The parties may not use this caption for any subsequent papers without prior Board authorization.

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Petitioner (Taiwan Semiconductor Manufacturing Company Limited) and Patent Owner (Alidouble, Inc.) have indicated that they have reached an agreement to settle each of the above-identified *inter partes* review proceedings. The Board authorized Petitioner and Patent Owner (collectively referred to as “the parties”) to file joint motions to terminate the proceedings on January 16, 2024.

On January 18, 2024, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed joint motions to terminate each of the above-identified proceedings (collectively “Joint Motions”) (Paper 14²), along with a copy of a confidential Settlement and Patent License Agreement (Ex. 1060³ (“Agreement”)) and joint requests (collectively “Joint Requests”) (Paper 15⁴) to treat the confidential Agreement as business confidential information and keep it separate from the files of the involved patents. The parties describe the filed copy of the confidential Agreement as comprising “a true and accurate copy of the Settlement and Patent License Agreement between the parties resolving the present proceeding[s].” Paper 14, 2. The parties represent that their Agreement “fully resolv[es]” each of the above-identified proceedings as well as “Patent Owner’s assertion of the

² For purposes of expediency, we cite to papers filed in IPR2023-00369. The parties submitted similar Joint Motions in IPR2023-00372 (Paper 14), IPR2023-00373 (Paper 14), and IPR2023-00374 (Paper 14).

³ The parties also submitted copies of the confidential Agreement in IPR2023-00372 (Ex. 1056), IPR2023-00373 (Exhibit 1022), and IPR2023-00374 (Exhibit 1054).

⁴ The parties submitted similar Joint Requests regarding the Agreement in IPR2023-00372 (Paper 15), IPR2023-00373 (Paper 15), and IPR2023-00374 (Paper 15).

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'169[, '319, '455, and '965] patent[s] in the related district court litigation, *Alidouble, Inc. v. Taiwan Semiconductor Manufacturing Company Limited*, No. 2:22-cv-00298-JRG (E.D. Tex.).” Paper 14, 2–4. The parties further “certify that there are no other agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding[s].” Paper 14, 2.

Under 35 U.S.C. § 317(a), 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.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. The above-identified proceedings are at an intermediate stage. We have not yet decided the merits of these proceedings, and final written decisions have not been entered in these proceedings. Terminating these proceedings will save the Board administrative and judicial resources, e.g., in conducting an oral argument and issuing a final written decision to decide the patentability issues raised in the respective Petitions. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Patent Trial and Appeal Board Consolidated Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the parties’ settlement and representations, we determine that good cause exists to terminate these proceedings. Accordingly, we *grant* the Joint Motions.

The parties also “request to file . . . the Settlement and Patent License Agreement between the parties . . . as business confidential information, and

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to have it be kept separate from the files of the aforementioned patent[s].”
Paper 15, 2. We have reviewed the Agreement, which contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Agreement as business confidential information and to keep it separate from the files of the respective patents involved in the above-identified proceedings pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* the Joint Requests.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Requests (IPR2023-00369, Paper 15; IPR2023-00372, Paper 15; IPR2023-00373, Paper 15; and IPR2023-00374, Paper 15) are *granted*, and the Agreements (IPR2023-00369, Ex. 1060; IPR2023-00372, Ex. 1056; IPR2023-00373, Ex. 1022; and IPR2023-00374, Ex. 1054) shall be treated as business confidential information, shall be kept separate from the files of the involved patents (U.S. Patent 9,356,169, U.S. Patent 6,169,319, U.S. Patent 9,431,455, and U.S. Patent 6,168,965), and shall 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);

FURTHER ORDERED that Exhibit 1060 in IPR2023-00369, Exhibit 1056 in IPR2023-00372, Exhibit 1022 in IPR2023-00373, and Exhibit 1054 in IPR2023-00374 shall remain designated as “Parties and Board Only” in the Board’s P-TACTS system; and

FURTHER ORDERED that the Joint Motions (IPR2023-00369,

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Paper 14; IPR2023-00372, Paper 14; IPR2023-00373, Paper 14; and
IPR2023-00374, Paper 14) to terminate the above-identified proceedings are
granted, and that IPR2023-00369, IPR2023-00372, IPR2023-00373, and
IPR2023-00374 are *terminated*.

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PETITIONER:

James Glass
John McKee
Jonathan S. Tse
Andrew M. Holmes
QUINN EMANUEL URQUHART & SULLIVAN, LLP
jimglass@quinnemanuel.com
johnmckee@quinnemanuel.com
jonathantse@quinnemanuel.com
drewholmes@quinnemanuel.com

PATENT OWNER:

Eric Cohen
RIMON PC
eric.cohn@rimonlaw.com