IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TAIWAN SEMICONDUCTOR MANUFACTURING COMPANY LIMITED,

Petitioner,

v.

ALIDOUBLE, INC.

Patent Owner

IPR2023-00374

U.S. Patent No. 6,168,965

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S. PATENT 6,168,965 UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.72

INTRODUCTION

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner Taiwan Semiconductor Manufacturing Company Ltd. ("TSMC" or "Petitioner") and Patent Owner Alidouble, Inc. ("Alidouble" or "Patent Owner") jointly move to terminate the *Inter Partes* Review of U.S. Patent No. 6,168,965 ("Joint Motion to Terminate").

Petitioner and Patent Owner have entered into a Settlement and Patent License Agreement fully resolving this matter, including both this proceeding and Patent Owner's assertion of the '169 patent in the related district court litigation, *Alidouble, Inc. v. Taiwan Semiconductor Manufacturing Company Limited*, No. 2:22-cv-00298-JRG (E.D. Tex.). A copy of the Settlement and Patent License Agreement is submitted herewith as Ex. 1054.

Concurrently, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties are filing Joint Motion to Keep Confidential and Separate (Motion to Keep Confidential) the Settlement and Patent License Agreement. The parties have agreed to waive service of the agreement.

The undersigned represent and 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. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b).

The undersigned further represent and certify that Ex. 1054 is a true and accurate copy of the Settlement and Patent License Agreement between the parties resolving the present proceeding, and that the Agreement filed as Ex. 1054 supersedes any other agreements or term sheets between the parties that may relate to the termination of this proceeding.

On January 12, 2024, the parties informed the Board of the settlement via e-mail and requested authorization to file the Joint Motion to Terminate and Motion to Keep Confidential. In an email dated January 16, 2024, the Board authorized the filing of this Joint Motion to Terminate and the Motion to Keep Confidential.

Per 35 U.S.C. § 317(a), "[a]n 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." Likewise, 37 C.F.R. § 42.74 states, "The Board may terminate a trial without rendering a final written decision, where appropriate, including … pursuant to a joint request under 35 U.S.C. 317(a)". "There are strong public policy reasons to favor settlement between the parties to a proceeding…. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Patent Trial and Appeal Board Consolidate Trial Practice Guide, November 2019,* page 86.

STATUS OF PROCEEDINGS

The following are the only proceedings either between the parties in the United States or that involve the subject patent:

Case	Number	Venue	Status
Alidouble Inc. v. Taiwan Semiconductor Manufacturing Company Ltd.	2-22-cv-00298	EDTX	Case dismissed pursuant to the parties' joint stipulation to dismiss under Fed. R. Civ. P. 41(a).
Alidouble Inc. v. Taiwan Semiconductor Manufacturing Company Ltd.	2-21-cv-00452	EDTX	Previously voluntarily dismissed by Patent Owner in March 2022.

Taiwan Semiconductor Manufacturing Company Ltd. v. Alidouble Inc.	IPR2023-00374	PTAB	Join motion to terminate filed or in the process of being filed.

The Board has not rendered a final decision deciding the merits of this or any other IPR proceeding. There are no other pending USPTO proceedings regarding U.S. Patent No. 6,168,965.

RELIEF REQUESTED

Petitioner and Patent Owner respectfully jointly request that the Board terminate this proceeding in its entirety in view of the agreement the parties are filing. That agreement ends all patent disputes between the parties, including this proceeding.

Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g.*, *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The U.S. Court of Appeals for the Federal Circuit also places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Moreover, the Board generally expects that a proceeding will terminate after the filing of a settlement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Maintaining this proceeding after settlement between Patent Owner and Petitioner would discourage future settlements by removing a primary motivation for settlement, which is eliminating litigation risk by resolving the parties' disputes and ending the pending proceedings between them. For patent owners, litigation risks include the

potential for an invalidity ruling against their patents. If a patent owner knows that an *inter partes* review will likely continue regardless of settlement, it creates a strong disincentive for the patent owner to settle.

CONCLUSION

In view of the foregoing, Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety.

Dated: January 18, 2024

Respectfully Submitted,

/s/ James M. Glass
James M. Glass
Reg. No. 46,729
Lead Counsel for Petitioner

/s/ Eric Cohen
Eric Cohen
Reg. No. 27,429
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a copy of the foregoing JOINT MOTION TO TERMINATE was served electronically via e-mail on January 18, 2024 to the following:

/s/ James M. Glass
James M. Glass
Reg. No. 46,729
Lead Counsel for Petitioner