

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

REALTEK SEMICONDUCTOR CORP.,
Petitioner,

v.

ATI TECHNOLOGIES ULC,
Patent Owner.

IPR2023-00687
Patent 8,854,381 B2

Before JAMES P. CALVE, BRIAN J. McNAMARA, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

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

I. INTRODUCTION

In an email dated June 20, 2024, we authorized Petitioner and Patent Owner (collectively, “the Parties”) to file a joint motion to terminate the above-referenced proceeding and to file a copy of their settlement agreement and related agreements and a joint request that the agreements be treated as business confidential information and be kept separate from the files of the ’381 patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Ex. 1017.

On June 24, 2024, pursuant to our authorization, the Parties filed a Joint Motion to Terminate Proceedings (“Joint Motion,” Paper 28), a copy of a Dismissal Agreement (Ex. 1016), and a Joint Request to File Dismissal Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (“Joint Request,” Paper 27).

II. DISCUSSION

Under 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.”

In the Joint Motion, the Parties represent that they have reached agreement to terminate this proceeding regarding U.S. Patent No. 8,854,381 (“the ’381 patent”) and that the filed copy of the Dismissal Agreement is a true copy that represents their entire agreement. Joint Motion 2 (“The parties certify that no other agreements or understandings, oral or written, exist between the parties in connection with, or in contemplation of, the termination of the proceeding.”). The Parties also represent that the Dismissal Agreement resolves all corresponding actions between them

regarding the '381 patent including actions pending with the International Trade Commission and the federal district court for the Eastern District of Texas. *Id.*

Although we have instituted trial in this proceeding, we have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceeding is appropriate. In these circumstances, we determine that good cause exists to terminate the proceeding.

The Parties also filed a Joint Request that their Dismissal Agreement be treated as business confidential information and be kept separate from the files of the '381 patent in this proceeding and be made available only to Federal Government agencies on written request or to persons showing good cause. Joint Request 2. After reviewing the Dismissal Agreement, we find that it contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Dismissal Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate Proceedings is *granted*, and IPR2023-00687 is *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Request to File Dismissal Agreement as Business Confidential Information is *granted*, and the Dismissal Agreement shall be kept separate from the file of the above-referenced patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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