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Paper No. 34
Date: June 26, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADVANCED MICRO DEVICES, INC.,
Petitioner,

v.

REALTEK SEMICONDUCTOR CORPORATION,
Patent Owner.

IPR2023-00789
Patent 7,936,245 B2

Before KEVIN F. TURNER, KIMBERLY McGRAW, and BRIAN D. RANGE, *Administrative Patent Judges.*

McGRAW, *Administrative Patent Judge*.

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

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate Proceeding (Paper 32, "Joint Motion") due to settlement. The parties also filed a copy of a confidential settlement agreement (Ex. 1040, "Settlement Agreement") as well as a Joint Agreement to Treat Settlement Agreement as Business Confidential Information (Paper 33, "Joint Request") pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In the Joint Motion, the Parties represent that they have settled their dispute regarding U.S. Patent 7,936,245 B2 ("the '245 patent), which is the patent challenged in this proceeding and asserted in the International Trade Commission in *Certain Integrated Circuits, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-1350 (U.S.I.T.C.); and the Northern District of California in *Realtek Semiconductor Corp. v. Advanced Micro Devices, Inc.,* Case No. 4:22-cv-04769-JSW (N.D. Cal.). Joint Motion 1. The Parties state they do not anticipate further litigation between them concerning the '245 patent. *Id.* The parties also represent that Exhibit 1040 is a true and correct copy of the parties' settlement agreement. *Id.* at 2. The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the settlement agreement in Exhibit 1040. *Id*.

The parties also request that the Settlement Agreement (Ex. 1040) be treated as business confidential information, be maintained separate from the publicly available file of the involved patent, and be made available only to Federal Government agencies on written request, or to any person on a

showing of good cause. Joint Request (Paper 33), 5–6 (citing 35 U.S.C. §317(b); 37 C.F.R. § 42.74(c)).

The parties also request that they be notified if the Board receives and/or considers a request for access to the settlement agreement and be offered an opportunity to respond to any such request. Paper 33, 6.

II. ANALYSIS

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." In this case, the Board has instituted review, but has not yet issued a final written decision deciding the merits of the proceeding. Under the circumstances presented here, we are persuaded it is appropriate to terminate this proceeding as to both Petitioner and Patent Owner.

We have also reviewed the Settlement Agreement (Ex. 1040), which contains confidential business information regarding the terms of the settlement, and we determine that it is appropriate to treat the Settlement Agreement as business confidential information and to keep that document separate from the file the patent in the above-identified proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

We deny the parties' request that they each be notified if the Board receives and/or considers a request for access to the Settlement Agreement and be offered an opportunity to respond to any such request. *See* Joint Request (Paper 33), 6 (citing *Arisita Networks, Inc. v. Castlemorton Wireless, LLC*, IPR2020-00986, Paper 7 (PTAB Oct. 28, 2020)). The Board does not have a procedure to serve upon the Parties a request for access to

the Settlement Agreement, and our regulations do not require us to do so. We note that *Arista* involved a settlement agreement between the patent owner and only one of three petitioners involved in the case. *Arista*, Paper 7 at 2. The agreement precluded the non-settling petitioners from accessing the settlement agreement. *Id.* The special circumstances that led to the decision in *Arista* are not presented here and the Parties do not argue otherwise. *See* Joint Request (Paper 38), 2; *see also Samsung Electronics Co. v. Hardin*, IPR2022-01333, Paper 23 at 2–3 (PTAB July 26, 2023) (denying parties' request for notification and opportunity to respond); *Seimens Gamesa Renewable Energy Inc. v. General Electric Co*., IPR2022-01279, Paper 19 at 3 (PTAB Apr. 10, 2023) (denying parties' request for notification and opportunity to respond); *OnePlus Technology (Shenzhen) Co. v. Bell Northern Research, LLC,* IPR2022-00048, Paper 28, 2022, Paper 10 at 4 (PTAB Jan. 28, 2022) (denying parties' request for notification and opportunity to respond); *Dell Inc. v. 3G Licensing S.A.*, IPR2020-01157, IPR2020-01158, –01159, –01160, –01161, –01162, Paper 49 at 4 (Dec. 14, 2021) (denying parties' request for notification); *VMware Inc. and Dell Technologies Inc. v. Proven Networks, LLC.*, IPR2021-00194, Paper 10 at 3 (Aug. 10, 2021) (denying request for notification and opportunity to respond). Therefore, we decline to issue an order regarding requests to access the Settlement Agreement.

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 the proceeding is granted, and IPR2023-00789 is *terminated*; and

FURTHER ORDERED that the Settlement Agreement (Exhibit 1040) be maintained as confidential business information and kept separate from the files of U.S. Patent No. 7,936,245 B2 and made available only in accordance with the provisions of 35 U.S.C. §317(b) and 37 C.F.R. § 42.74(c).

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