

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC. and TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

BELL SEMICONDUCTOR, LLC,
Patent Owner.

IPR2024-00168¹
Patent 7,345,245 B2

Before JEFFREY W. ABRAHAM, JOHN D. HAMANN, and
BRIAN D. RANGE, *Administrative Patent Judges*.

RANGE, *Administrative Patent Judge*.

TERMINATION AS TO TEXAS INSTRUMENTS INCORPORATED
Due to Settlement After Institution of Trial
35 U.S.C. § 317, 37 C.F.R. § 42.74

¹ Texas Instruments Incorporated filed a motion for joinder and a petition in IPR2024-01010 and have been joined as a petitioner in this proceeding.

On January 7, 2024, Petitioner Texas Instruments Incorporated and Patent Owner (collectively, “the parties”) filed a Joint Motion to Terminate as to Petitioner Texas Instruments Incorporation due to settlement of their dispute concerning the challenged patent, U.S. Patent No. 7,345,245 B2 (“the ’245 patent”). Paper 24. The parties also filed a copy of a settlement agreement between Bell Semiconductor, LLC and Texas Instruments Incorporated (Ex. 2007) and a Joint Request to Treat Settlement Agreement as Business Confidential Information. Paper 25.

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.” Accordingly, 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. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide² (November 2019) 86.

According to the Motion, the parties have reached a settlement that resolves all disputes between them with respect to this proceeding and the parties’ related district court litigation. Mot. 1. The parties state that the lawsuit would proceed if neither IPR proceeding is terminated. *Id.* The parties also state that “[t]he settlement agreement is the only agreement or understanding between the parties made in connection with, or in contemplation of, termination of this inter partes review with respect to Petitioner TI.” *Id.*

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

This IPR proceeding is in its mid to early stage. A hearing, if requested, is currently scheduled for February 12, 2024. Paper 11 (Scheduling Order). We note that this IPR proceeding will move forward with other petitioners³ even if the proceeding is terminated with respect to Texas Instruments Incorporated. Because this IPR proceeding is in its mid to early stage, because we have not yet decided the merits of this proceeding, and because the proceeding will move forward even if terminated with respect to Texas Instruments Incorporated, we determine that it is appropriate to terminate this proceeding as to Texas Instruments Incorporated. *See* 37 C.F.R. §§ 42.5(a), 42.72.

The parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the public files of the '245 patent. Paper 25, 1. We determine that good cause exists to treat the Settlement Agreement as business confidential pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motion to terminate the case only with respect to Texas Instruments Incorporated is granted;

FURTHER ORDERED that IPR2024-0168 is hereby terminated with respect to petitioner Texas Instruments Incorporated only; and

³ NXP USA, Inc. is the named petitioner for the original petition. Paper 1, 2. NXP USA, Inc. identifies itself as a real party in interest as well as NXP Semiconductors N.V., NXP B.V., and Freescale Semiconductor Holdings V, Inc. *Id.* The Joint Motion to Terminate as to Petitioner Texas Instruments Incorporated refers to “NXP USA, Inc., NXP Semiconductors N.V., NXP B.V., and Freescale Semiconductor Holdings V, Inc.” as “the other Petitioners.” Paper 24 at 1.

FURTHER ORDERED that the Joint Request is granted and the settlement agreement shall be kept separate from the files of the '245 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).

IPR2023-00213
Patent 7,345,245 B2

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