

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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MICRON TECHNOLOGY, INC.  
Petitioner

v.

PRESIDENT & FELLOWS OF HARVARD COLLEGE  
Patent Owner

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Case No. IPR2017-00664  
U.S. Patent 8,334,016

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**JOINT MOTION TO TERMINATE AND NOTICE OF SETTLEMENT  
UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

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UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board's e-mail authorization of March 5, 2018, Patent Owner (President and Fellows of Harvard College) and Petitioner (Micron Technology, Inc.) (collectively, "the Parties") hereby jointly request termination of *Inter Partes* Review No. IPR2017-00664 involving U.S. Patent 8,334,016 ("the '016 Patent"). The basis for this joint motion is the settlement of the present dispute between the Parties that relates to the '016 Patent. Following termination of the instant proceeding involving the '016 Patent and IPR2017-00662 and IPR2017-00063 involving U.S. Patent 6,969,539 and the '016 Patent, respectively<sup>1</sup> and dismissal of the related district court action (*President & Fellows of Harvard College v. Micron Technology, Inc.*, D. Del., Civil Action No. DED-1-17-cv-01729),<sup>2</sup> no other disputes between the Parties remain.

As required by statute, the Parties file concurrently herewith a copy of the Parties' agreements (Exhibit 2138) along with a request to treat the agreements as

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<sup>1</sup> A motion to terminate is also being filed in IPR2017-00662 and IPR2017-00663.

<sup>2</sup> The district court action captioned *President & Fellows of Harvard College v. Micron Technology, Inc.*, D. Mass., Civil Action No. MAD-1-16-cv-11249 was transferred to the Delaware district court on November 30, 2017.

business confidential information and to keep the exhibit separate from the file of the '016 Patent. The Parties jointly certify that there is no other written or oral collateral agreement or understanding made in connection with, or in contemplation of, the termination of the instant proceeding.

**I. STATEMENT OF PRECISE RELIEF REQUESTED**

The Parties jointly request that the Board terminate this IPR *as to both parties*, without rendering a final written decision.

**II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED**

Termination of this IPR without rendering a final written decision is appropriate because (i) the trial is at a sufficiently early stage and the record is incomplete; (ii) the Parties have settled their disputes in this proceeding and the related litigation, and the Parties to this IPR agree that it should be terminated; and (iii) public policy strongly favors settlement.

**A. Termination With Respect to Petitioner**

“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.” 35 U.S.C. § 317(a). Because the Parties jointly request termination and the Office has not yet decided the merits, termination of

this IPR with respect to Petitioner is proper. As set forth in 35 U.S.C. § 317(a), no estoppel under 35 U.S.C. § 315(e) should attach to Petitioner.

**B. Termination With Respect to Patent Owner**

Upon termination of this proceeding with respect to Petitioner, no petitioner shall remain. Termination of this IPR with respect to Patent Owner is supported by the Petitioner and is appropriate for at least the following reasons.

**1. Incomplete Record**

The record is incomplete as the Board has not yet decided the merits of this proceeding. Patent Owner has not yet deposed the reply witness and has not yet filed observations on cross-examination (DUE DATE 4), neither party has filed (or responded to) a motion to exclude (DUE DATES 4-6), and no oral hearing has yet been requested or held (DUE DATE 7). There are no outstanding motions before the Board.

The Board has terminated, without final written decision, other IPRs in which a joint motion for termination was filed following a petitioner's reply and prior to oral argument. *See e.g., Sony Corp. v. Tessera, Inc.*, IPR2012-00033, Paper 39 at 2 (PTAB Nov. 15, 2013) (terminated 10 days before oral argument).

**2. No Further Participation by Petitioner**

Upon termination with respect to Petitioner, Petitioner hereby informs the Board that Petitioner will not attend any oral hearing in this IPR and will not

participate further in this IPR in any respect before the Board. Moreover, Petitioner supports the termination with respect to Patent Owner.

Because the record is currently incomplete and will not be further developed, termination as to all parties is favored. Patent Owner notes that in the absence of Petitioner, it is unclear how these proceedings could properly proceed. Under these circumstances, there is every reason to honor the Parties' wishes to terminate *as to both parties* without final written decision.

**3. Maintaining this *Inter Partes* Review Would Discourage Settlements and Waste Judicial Resources**

Congress and federal courts have expressed a strong interest in encouraging settlement of disputes. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir.), *cert denied*, 479 U.S. 950 (1986); and 35 U.S.C. § 317(a). Public policy favors allowing parties to settle in all respects. Further, the USPTO's *Office Patent Trial Practice Guide* expressly states:

N. Settlement. *There are strong public policy reasons to favor settlement between the parties to a proceeding.* The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the 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.*

77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (emphasis added).

Maintaining this IPR in any respect after the Parties' settlement would be contrary to public policy and would discourage future settlements by removing a significant motivation for settlement: eliminating litigation risk by resolving the parties' disputes and ending the pending proceedings between them.

Moreover, one reason that courts and administrative tribunals endorse settlement is preservation of judicial resources. Maintaining this IPR after the Parties have settled their disputes would waste, rather than conserve, judicial resources of the USPTO and the Federal Circuit. In addition, Patent Owner will be prejudiced if this proceeding is not terminated as requested, with respect to additional attorneys' fees and costs that would need to be incurred in connection with the proceedings.

#### **4. Status of Proceedings Related to '016 Patent**

Pursuant to the Parties' agreement, the related district court action was dismissed via the Order of Dismissal dated March 5, 2018, submitted herewith as Exhibit 2139. Accordingly, following dismissal of the related district court action, the instant proceeding, and IPR2017-00662 and -00663, there would be no pending litigation or proceeding between the Parties or involving the '016 Patent in any forum. The Parties note that the district court action identified in the Parties' mandatory notices involving the '016 Patent and captioned *President & Fellows of*

*Harvard College v. GlobalFoundries, Inc.*, Civil Action No. MAD-1-16-cv-11252

(D. Mass.) was terminated on March 27, 2017 following settlement.

#### **IV. CONCLUSION**

Any reasonable weighing of the issues/factors discussed herein heavily favors termination of the proceeding as to all Parties. Accordingly, the Parties respectfully request termination of this proceeding in its entirety.

Respectfully submitted,

Dated: March 6, 2018

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**CERTIFICATE OF SERVICE**

I hereby certify that on March 6, 2018, a true and accurate copy of this paper, JOINT MOTION TO TERMINATE AND NOTICE OF SETTLEMENT UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.74, was served on the following counsel for Patent Owner via email:

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