

Entered: December 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., AND SAMSUNG SEMICONDUCTOR, INC.,
Petitioner,

v.

TESSERA ADVANCED TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2018-00798
U.S. Patent No. 6,954,001

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 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 December 11, 2018 correspondence, Petitioner Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Semiconductor, Inc. (“Petitioner”) and Patent Owner Tessera Advanced Technologies, Inc. (“Patent Owner”) (collectively, “the Parties”) jointly request termination of the *inter partes* review of U.S. Patent No. 6,954,001 (“’001 patent”), Case No. IPR2018-00798.

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, 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) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018).

The Board issued an institution decision on October 1, 2018, but the parties have not completed their submissions of briefs and supporting evidence (for example, a Patent Owner’s Response has not yet been filed). Oral Argument is not scheduled to occur until July 1, 2019. The Parties have settled their dispute and respectfully submit that termination is proper here.

The ’001 patent was the subject of three separate matters: (1) the Matter of *Certain Wafer-Level Packaging Semiconductor Devices And Products Containing Same (Including Cellular Phones, Tablets, Laptops, And Notebooks) And Components Thereof*, Inv. No. 337-TA-1080, USITC (2017), which was terminated on May 21, 2018; (2) a District Court action in the District of New Jersey, Civil

Action No. 2:17-cv-07621-JLL-JAD, entitled *Tessera Advanced Technologies, Inc. v. Samsung Electronics America, Inc., and Samsung Electronics Co., Ltd.*, which the parties stipulated to dismiss with prejudice; and (3) an International Court of Arbitration proceedings, entitled *Samsung Electronics Co., Ltd. v. Panasonic Corporation (F/K/A Matsushita Electric Industrial Co., Ltd.), Pannova Semic, LLC, and Tessera Advanced Technologies, Inc.*, Case No. 23649/MK, which the parties also stipulated to dismiss with prejudice. The '001 patent is also the subject of a Petition for *inter partes* Review, IPR2018-00799, entitled *Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Semiconductor, Inc. v. Tessera Advanced Technologies, Inc.*, in which the Parties are simultaneously filing a Joint Motion to Terminate Proceedings. A dismissal of the Petition here would promote efficiency and minimize unnecessary costs.

Samsung and Patent Owner's parent Xperi Corporation executed a Confidential Settlement Agreement to terminate this proceeding effective December 7, 2018. This agreement was made binding on Patent Owner Tessera Advanced Technologies, Inc. by Consent Letter of the same date. Both the Settlement Agreement and a Consent Letter are submitted concurrently herewith. In accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a Joint Request that the Confidential Settlement Agreement and Consent Letter be treated as business confidential information, be kept separate from the file of the

involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). True and correct copies of the Settlement Agreement and Consent Letter are submitted with that Request as Confidential Exhibits 1021 and 1022.

Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Both Petitioner and Patent Owner support termination of the proceeding.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board dismiss this proceeding in its entirety.

Respectfully submitted,

Dated: December 13, 2018

By: /s/ John Kappos

John Kappos (Reg. No. 37,861)
jkappos@omm.com
O'Melveny & Myers LLP
610 Newport Center Drive, 17th Floor
Newport Beach, CA 92660
Telephone: 949.823.6900
Fax: 949.823.6994

Brian M. Berliner (Reg. No. 34,549)
bberliner@omm.com
Ryan Yagura (Reg. No. 47,191)

ryagura@omm.com
Nicholas Whilt (Reg. No. 72,081)
nwhilt@omm.com
Xin-Yi Zhou (Reg No. 63,366)
vzhou@omm.com
O'Melveny & Myers LLP
400 South Hope Street, 18th Floor
Los Angeles, CA 90071
Telephone: 213.430.6000
Fax: 213.430.6407
Counsel for Petitioner

By: /s/ Robert Steinberg

Matthew J. Moore (Reg. No. 42,012)
matthew.moore@lw.com
Robert Steinberg (Reg. No. 33,144)
bob.steinberg@lw.com
Jonathan M. Strang (Reg. No. 61,724)
jonathan.strang@lw.com
Latham & Watkins LLP
555 Eleventh Street, NW, Ste. 1000
Washington, DC 20004-1304
Telephone: 202.637.2200
Fax: 202.637.2201

Charles H. Sanders (Reg. No. 47,053)
Charles.sanders@lw.com
Latham & Watkins LLP
200 Clarendon Street
Boston, MA 02116
Telephone: 617.948.6000
Fax: 617.948.6001
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 13th day of December 2018, a copy of **Joint Motion to Terminate** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

Matthew J. Moore
Latham & Watkins LLP
555 Eleventh St., N.W., Ste. 1000
Washington, DC 20004-1304
Tel.: (202) 637-2200
matthew.moore@lw.com

Charles H. Sanders
Latham & Watkins LLP
200 Clarendon Street
Boston, MA 02116
Tel.: (617) 948-6000
charles.sanders@lw.com

Robert Steinberg
Latham & Watkins LLP
555 Eleventh Street, NW, Ste. 1000
Washington, DC 20004-1304
bob.steinberg@lw.com

Jonathan M. Strang
Latham & Watkins LLP
555 Eleventh St., N.W., Ste. 1000
Washington, DC 20004-1304
Tel.: (202) 637-2200
jonathan.strang@lw.com

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/s/ John Kappos
John Kappos (Reg. No. 37,861)