

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

GODO KAISHA IP BRIDGE 1,
Patent Owner.

Case IPR2018-01487
U.S. Patent No. 7,800,165

JOINT MOTION TO DISMISS AND TERMINATE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R §§ 42.72, 42.74

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72, 42.74, Petitioner Intel Corporation (“Intel”) and Patent Owner Godo Kaisha IP Bridge 1 (“IP Bridge”) jointly move that the Board dismiss and terminate the above captioned *inter partes* review in its entirety as a result of a settlement between Intel and IP Bridge.

The parties are filing concurrently herewith a request that the settlement agreement between the parties, submitted as Exhibit 1010, be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

II. STATEMENT OF FACTS

On September 29, 2017, Patent Owner brought a suit against Intel in the United States District Court for the Eastern District of Texas (Civ. No. 2:17-cv-0067), asserting infringement of nine patents, including claims 1, 3, 5, 6, 10, 11, 13, 14, 16, 18, and 19 of U.S. Patent No. 7,800,165 (the “’165 patent”). Intel filed its petition for *inter partes* review of claims 13-19 of the ’165 patent on July 31, 2018. Patent Owner filed its preliminary response on November 27, 2018. The Board has not yet issued its institution decision.

Intel and Patent Owner have entered into a settlement agreement. *See* Ex. 1010 (Confidential). Pursuant to the terms of the settlement agreement, the parties

agree, among other things, to dismiss with prejudice the pending district court action and this proceeding.

III. ARGUMENT

A. Legal Standard

35 U.S.C. § 317(a) provides that “[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.” That section also provides that “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(e).” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that 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. 48,756, 48,768 (Aug. 14, 2012).

B. The Board Should Terminate This IPR Proceeding in Its Entirety

As noted in the Statement of Facts, the parties have settled their dispute. The Board has also not yet decided the merits of this proceeding. Indeed, because the Board has not yet decided whether to institute *inter partes* review in this

proceeding, due dates for Patent Owner's response, Intel's reply, and oral argument have not been set. Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding with respect to Intel. Because no petitioners remain after termination with respect to Intel, the Board should exercise its discretion and terminate this proceeding in its entirety.

“Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). Terminating this proceeding promotes the Congressional goal to establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* “Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents,” Final Rule, 77 Fed. Reg. 48680 (Aug. 14, 2012).

Accepting these principles, the Board has terminated proceedings based upon joint motions to terminate, even after the merits had been fully briefed and the matter was ready for oral argument, or even after oral argument. *See Toyota Motor Corp. v. Blitzsafe Tex. LLC*, IPR2016-00421, Paper 28 (Feb. 21, 2017) (granting motion to terminate even after all substantive papers were filed, “particularly in light of the fact that a final written decision is not due until more

than four months from now”); *Plaid Techs., Inc. v. Yodlee, Inc.*, IPR2016-00273, Paper 29 (Feb. 8, 2017) (granting motion to terminate because “the parties’ joint motions to terminate were filed prior to the oral hearings in these cases”); *Apex v. Resmed*, IPR2013-00512, Paper 39 (Sept. 12, 2014) (granting joint motion to terminate after the parties had fully briefed the matter); *Rackspace Hosting, Inc. v. Clouding IP, LLC*, CBM2014-00034, Paper 28 (Dec. 9, 2014) (granting motion to terminate after close of evidentiary record and less than 10 days before trial); *Volusion v. Versata Software, Inc.*, CBM2013-00018, Paper 52 (June 17, 2014) (granting motion to terminate after oral argument).

C. Status of Related Matters

Pursuant to 37 C.F.R. § 42.74(c), the parties are filing herewith as Exhibit 1010 a true copy of settlement agreement entered between the parties. The settlement agreement was entered into in contemplation of terminating this proceeding and *Godo Kaisha IP Bridge 1 v. Intel Corp.*, Case No. 2:17-cv-676 (E.D. Tex.).

IV. CONCLUSION

Intel and Patent Owner respectfully request that the Board grant the parties’ Joint Motion and terminate this proceeding in its entirety. The parties also request that the Board grant the parties’ joint request to treat the settlement agreement

between the parties as business confidential information and keep it separate from the file of the '165 patent.

Date: February 3, 2019

Respectfully Submitted,

/s/ Jon Carter

Jon Carter (Reg. No. 75,145)
Gregory S. Arovas, P.C. (Reg. No.
38,818)
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10022
Telephone: (212) 446-4800
Facsimile: (212) 446-4900
jon.carter@kirkland.com
greg.arovas@kirkland.com

Eugene Goryunov (Reg. No. 61,579)
KIRKLAND & ELLIS LLP
300 North LaSalle
Chicago, IL 60654
Telephone: (312) 862-2000
Facsimile: (312) 862-2200
eugene.goryunov@kirkland.com

Attorneys for Petitioner

Respectfully Submitted,

/s/ James L. Davis, Jr.

James L. Davis, Jr. (Reg. No. 57,325)
ROPES & GRAY LLP
1900 University Avenue, 6th Floor
East Palo Alto, CA 94303-2284
Telephone: (650) 617-4794
Facsimile: (617) 235-9492
James.l.Davis@ropesgray.com

Scott McKeown (Reg. No. 42,866)
ROPES & GRAY LLP
2099 Pennsylvania Avenue, N.W.
Washington, DC 20006-6807
Telephone: (202) 508-4740
Facsimile: (617) 235-9492
Scott.McKeown@ropesgray.com

Attorneys for Patent Owner

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit	Description	Previously Submitted
1001	Declaration of Stanley Shanfield	X
1002	Curriculum Vitae of Stanley Shanfield	X
1003	U.S. Patent No. 7,800,165	X
1004	U.S. Patent No. 7,800,165 File History	X
1005	U.S. Patent No. 7,494,862 (“Doyle ’862”)	X
1006	U.S. Patent No. 7,323,389 (“Goktepli”)	X
1007	U.S. Patent No. 7,449,373 (“Doyle ’373”)	X
1008	U.S. Patent Publication No. 2004/0036126 (“Chau”)	X
1009	Schroder, Dieter K., Semiconductor Material and Device Characterization (3d Ed. 2006) (“Schroder”)	X
1010	Patent License Agreement (CONFIDENTIAL)	

CERTIFICATE OF SERVICE

I hereby certify that on February 3, 2019, I caused a true and correct copy of the foregoing documents, Joint Motion to Dismiss and Terminate Proceedings and Exhibit 1010, were served upon the following, by electronic mail:

james.l.davis@ropesgray.com
scott.mckeown@ropesgray.com
IPBridgevIntelIPRService@ropesgray.com

/s/ Jon Carter
Jon Carter (Reg. No. 75,145)