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*Attorneys for Defendant/Counterclaimant*  
**INTERTRUST TECHNOLOGIES  
 CORPORATION**

**UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 SAN FRANCISCO DIVISION**

DOLBY LABORATORIES, INC.,  
 Plaintiff and Counterclaim-Defendant,  
 v.  
 INTERTRUST TECHNOLOGIES  
 CORPORATION,  
 Defendant and Counterclaim-Plaintiff.

Case No. 3:19-cv-03371-EMC

Assigned to: Hon. Edward M. Chen

**JOINT STIPULATION AND  
~~PROPOSED~~ ORDER TO NARROW  
 AND STAY CASE PENDING *INTER  
 PARTES* REVIEW**

1 WHEREAS, on November 27, 2019, Dolby Laboratories, Inc. ("Dolby") filed a second  
 2 amended complaint in this case against Intertrust Technologies Corporation ("Intertrust"), asserting  
 3 claims for declaratory judgment of non-infringement of U.S. Patent Nos. 6,157,721 (the "'721  
 4 Patent"); 6,640,304 (the "'304 Patent"); 6,785,815 (the "'815 Patent"); 7,340,602 (the "'602 Patent");  
 5 7,406,603 (the "'603 Patent"); 7,694,342 (the "'342 Patent"); 8,191,157 (the "'157 Patent"); 8,191,158  
 6 (the "'158 Patent"); 8,931,106 (the "'106 Patent"); and 9,569,627 (the "'627 Patent") (collectively, the  
 7 "Patents-in-Suit");

8 WHEREAS, on December 11, 2019, Intertrust filed an answer and counterclaims in this case,  
 9 asserting counterclaims against Dolby for infringement of the Patents-in-Suit;

10 WHEREAS, on January 8, 2020, Dolby filed an answer to Intertrust's counterclaims in this  
 11 case, including an affirmative defense asserting that the asserted claims of the Patents-in-Suit are  
 12 invalid in view of the prior art under 35 U.S.C. §§ 102 and 103;

13 WHEREAS, the Patent Trial and Appeal Board ("PTAB") has instituted *Inter Partes* Review  
 14 proceedings based on the following petitions filed by Dolby: IPR2020-00660 (challenging asserted  
 15 claims of the '815 Patent); IPR2020-00661 (challenging asserted claims of the '158 Patent); IPR2020-  
 16 00662 (challenging asserted claims of the '304 Patent); IPR2020-00664 (challenging asserted claims  
 17 of the '627 Patent); IPR2020-00665 (challenging asserted claims of the '106 Patent); IPR2020-01105  
 18 (challenging asserted claims of the '157 Patent); IPR2020-01106 (challenging asserted claims of the  
 19 '157 Patent); IPR2020-01123 (challenging asserted claims of the '721 Patent); and IPR2020-01209  
 20 (challenging asserted claims of the '342 Patent);

21 WHEREAS, Dolby and Intertrust (collectively, "the parties") wish to conserve the resources  
 22 of the Court and the parties by narrowing the scope of the case and otherwise staying the case pending  
 23 resolution of the *Inter Partes* Review proceedings;

24 **NOW, THEREFORE, IT IS HEREBY STIPULATED AND AGREED** by the parties,  
 25 subject to the approval of the Court, as follows:

26 1. Upon entry of this stipulation, Intertrust's Counterclaim Count Three (infringement  
 27 of the '815 Patent), Counterclaim Count Six (infringement of the '342 Patent), and Counterclaim  
 28 Count Seven (infringement of the '157 Patent) against Dolby are dismissed with prejudice.

2. Upon entry of this stipulation, Intertrust waives its rights to reassert the '815 Patent, the '342 Patent, or the '157 Patent (collectively, "the dismissed patents") in any currently pending district court case against any party, or to assert the dismissed patents against any party in any future case that implicates Dolby's products or services. The parties agree that Intertrust's waiver of rights does not extend in any way to any patents or intellectual property rights other than the dismissed patents. The parties agree that Intertrust's waiver of rights shall not: (i) operate as an implied or express waiver of any claim asserted in the future by Intertrust relating to any patents or intellectual property rights other than the dismissed patents; (ii) operate as an implied or express license to any patents or intellectual property rights other than the dismissed patents; or (iii) be used as the basis of any equitable or legal estoppel claim or defense relating to any patents or intellectual property rights other than the dismissed patents.

3. Upon entry of this stipulation, and in view of the dismissal and waiver above, Dolby's Third Claim for Relief (declaratory judgment of non-infringement of the '815 Patent), Sixth Claim for Relief (declaratory judgment of non-infringement of the '342 Patent), and Seventh Claim for Relief (declaratory judgment of non-infringement of the '157 Patent) against Intertrust are dismissed without prejudice.

4. Following entry of this stipulation, and upon receipt of the PTAB's authorization to do so, Dolby and Intertrust shall file with the Board joint motions to terminate the following pending *Inter Partes* Review proceedings: IPR2020-00660 ('815 Patent); IPR2020-01105 ('157 Patent); IPR2020-01106 ('157 Patent); and IPR2020-01209 ('342 Patent).

5. Upon entry of this stipulation, Intertrust limits its asserted patent claims in this case to the following claims: claims 9 and 29 of the '721 Patent; claim 24 of the '304 Patent; claims 25 and 26 of the '602 Patent; claims 1 and 2 of the '603 Patent; claim 4 of the '158 Patent; claim 17 of the '106 Patent; and claims 1, 5, 6, 7, and 8 of the '627 Patent.

6. Within fourteen days of entry of this stipulation, Dolby shall limit its asserted prior art in this case to no more than six asserted prior art references per patent, and no more than a total of 28 prior art references. For purposes of these limitations, a prior art instrumentality (such as a device or process) and associated references that describe that instrumentality shall count as one prior

1 art reference, as shall the closely related work of a single prior artist; in addition, each obviousness  
 2 combination shall count as a separate prior art reference. Dolby will serve Intertrust with notice  
 3 identifying the prior art asserted against each patent.

4 7. Upon entry of this stipulation, this case is stayed until the PTAB issues a final written  
 5 decision in each of the following pending *Inter Partes* Review proceedings: IPR2020-00661 ('158  
 6 Patent); IPR2020-00662 ('304 Patent); IPR2020-00664 ('627 Patent); IPR2020-00665 ('106 Patent);  
 7 and IPR2020-01123 ('721 Patent). The stay shall extend until the last of the final written decisions  
 8 has issued in these PTAB proceedings (anticipated to be in February 2022), and will expire  
 9 automatically at that time unless previously lifted or extended by the Court.

10 8. Notwithstanding paragraph 7, each party reserves the right to seek to lift, extend, or  
 11 otherwise modify the stay. During the pendency of the stay, each party further reserves the right to  
 12 seek leave to file motions for summary judgment (or judgment on the pleadings) with respect to any  
 13 issue not addressed in any of the pending *Inter Partes* Review proceedings, subject to the Court's  
 14 Civil Standing Order (General). Dolby intends to seek leave to file one or more motions for summary  
 15 judgment (or judgment on the pleadings) during the pendency of the stay. Each party reserves the  
 16 right to oppose any such request for leave.

17 9. All discovery shall be immediately stayed pending entry of this stipulation. The  
 18 parties agree to take reasonable measures to preserve fact discovery up to and including lifting or  
 19 expiration of the stay of litigation.

20 10. The parties shall file a status report with the Court within one month of lifting or  
 21 expiration of the stay, whichever occurs first.

22  
 23 **IT IS SO STIPULATED**, through counsel of record.

24  
 25 Respectfully submitted,

26 Date: April 13, 2021

By: /s/ Mark Rowland

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 28 Stepan Starchenko  
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Date: April 13, 2021


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INTERTRUST TECHNOLOGIES CORPORATION

1 PURSUANT TO STIPULATION, IT IS SO ORDERED.

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3  
4 Dated: April 14, 2021

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9 HON. EDWARD M. CHEN  
10 UNITED STATES DISTRICT JUDGE  
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