

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Dolby Laboratories, Inc.

Petitioner,

v.

Intertrust Technologies Corporation,

Patent Owner.

Case IPR2020-00660

Patent No. 6,785,815

JOINT MOTION TO TERMINATE PROCEEDINGS

Case No. IPR2020-00660
JOINT MOTION TO TERMINATE THE
PROCEEDINGS PURSUANT TO 35 U.S.C. § 317

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EXHIBIT TABLE

Exhibit #	Description
2001	[INTENTIONALLY LEFT BLANK]
2002	[INTENTIONALLY LEFT BLANK]
2003	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC, Dkt. No. 61-3 (N.D. Cal. Nov. 27, 2019): Second Amended Complaint (Public Version)
2004	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case), Dkt. No. 95 (E.D. Tex. May 5, 2020): First Amended Docket Control Order
2005	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case), Dkt. No. 8 (E.D. Tex. Oct. 21, 2019): Consolidation Order
2006	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case), Dkt. No. 22 (E.D. Tex. Nov. 7, 2019): Consolidation Order
2007	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case), Dkt. No. 112 (E.D. Tex. July 7, 2020): Claim Construction Order
2008	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC, Dkt. No. 73 (Feb. 13, 2020): Case Management and Pretrial Order For Claims Construction
2009	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC, Dkt. No. 71 (Feb. 6, 2020): Joint Case Management Conference Statement
2010	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case) (E.D. Tex. January 30, 2020): Defendants' Invalidity and Subject Matter Eligibility Contentions
2011	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case), Dkt. No. 78 (E.D. Tex. April 17, 2020): Order Appointing Technical Advisor
2012	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC (April 13, 2020): Dolby's Invalidity Contentions Pursuant to Patent Local Rule 3-3 and 3-4

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2013	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case) (E.D. Tex. January 30, 2020): Defendants’ Invalidity Claim Charts For The ’815 Patent - Appendices C-03 (Hanna), C-04 (Gennaro), C-07 (Stefik), and C-Combination (showing Section 103 combinations for the ’815 patent)
2014	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC (April 13, 2020): Exhibit C-03 - Dolby’s Invalidity Contentions For The ’815 Patent Based on Hanna
2015	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC (April 13, 2020): Exhibit C-04 - Dolby’s Invalidity Contentions For The ’815 Patent Based on Gennaro
2016	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC (April 13, 2020): Exhibit C-07 - Dolby’s Invalidity Contentions For The ’815 Patent Based on Stefik
2017	[INTENTIONALLY LEFT BLANK]
2018	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case) (E.D. Tex. November 6, 2019): Intertrust’s Patent Rule 3-1 Disclosures - Infringement Contentions For The ’815 Patent
2019	<i>Intertrust Technologies Corporation v. Cinemark Holdings, Inc.</i> , Case No. 2:19-cv-00266-JRG (lead case), Dkt. No. 28, (E.D. Tex. November 6, 2019): Defendants’ Motion to Transfer Venue to N.D. Cal.
2020	[INTENTIONALLY LEFT BLANK]
2021	[INTENTIONALLY LEFT BLANK]
2022	[INTENTIONALLY LEFT BLANK]
2023	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC, Dkt. No. 101 (August 12, 2020): Order on Joint Stipulation Regarding Claim Terms and Claim Construction Schedule
2024	Declaration of Dr. Vijay K. Madisetti, IPR 2020-00663 (May 27, 2020)
2025	U.S. Patent No. 5,892,900

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2026	Deposition Transcript of Dr. Vijay K. Madiseti (January 5, 2021)
2027	Declaration of Dr. Markus Jakobsson
2028	“On the Security of Public Key Protocols,” <i>IEEE Transactions on Information Theory</i> , vol. 29, no. 2, pp. 198-208 (1983)
2029	“Tamper Resistant Software: An Implementation”, <i>Proceedings of the First International Workshop on Information Hiding</i> , p. 317–333 (May 1996)
2030	“Discouraging Software Piracy Using Software Aging”, <i>ACM Workshop on Digital Rights Management</i> (February 2002)
2031	<i>Dolby Laboratories, Inc. v. Intertrust Corporation</i> , Case No. 3:19-cv-03371-EMC, Dkt. No. 143 (April 14, 2021): Joint Stipulation and Order To Narrow and Stay Case Pending <i>Inter Partes</i> Review

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I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner Dolby Laboratories, Inc. (“Petitioner”) and Patent Owner Intertrust Technologies Corporation (“Patent Owner”) (collectively, “the Parties”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 6,785,815 (the “’815 patent”), Case No. IPR2020-00660.

On April 14, 2021, the Parties notified the Board that the Parties reached an agreement to terminate this proceeding related to the ’815 patent. On that basis, the Parties requested permission to file a Joint Motion to Terminate IPR2020-00660. On April 15, 2021, the Board authorized the Parties, via email, to file a Joint Motion to Terminate.

The Parties have reached agreement to narrow disputes between them, including termination of IPR2020-00660, pursuant to the terms and conditions of a Joint Stipulation made in writing (the “Stipulation”). On April 13, 2021, the Parties filed the Stipulation with the United States District Court for the Northern District of California in a co-pending action between the parties, *Dolby Laboratories, Inc. v. Intertrust Corporation*, Case No. 3:19-cv-03371 (N.D. Cal.), and on April 14, 2021, the Court entered the terms of the Stipulation as an order of the Court. Ex. 2031. Pursuant to the Stipulation, the Parties agreed to jointly move to terminate four pending *Inter Partes* proceedings, including the present one. Ex. 2031, ¶4.

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The Parties certify that there are no other collateral agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

II. RELATED PROCEEDINGS

The '815 patent was previously involved in these matters:

- *Dolby Laboratories, Inc. v. Intertrust Corporation*, Case No. 3:19-cv-03371 (N.D. Cal.)
- *Intertrust Technologies Corporation v. AMC Entertainment Holdings, Inc.*, Case No. 2:19-cv-00265 (E.D. Tex.)
- *Intertrust Technologies Corporation v. Cinemark Holdings, Inc.*, Case No. 2:19-cv-00266 (E.D. Tex.)
- *Intertrust Technologies Corporation v. Regal Entertainment Group*, Case No. 2:19-cv-00267 (E.D. Tex.)

Cases subject to the Stipulation referenced above:

- IPR2020-00660 for U.S. Patent No. 6,785,815
- IPR2020-01105 for U.S. Patent No. 8,191,157
- IPR2020-01106 for U.S. Patent No. 8,191,157
- IPR2020-01209 for U.S. Patent No. 7,694,342

III. BRIEF EXPLANATION AS TO WHY TERMINATION IS APPROPRIATE

Termination of this IPR is appropriate because the Board has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Pursuant to the Board’s Scheduling Order in this proceeding, the Parties’ briefing on the merits will conclude on June 10, 2021 (Paper No. 23), and oral argument is not scheduled to take place until July 12, 2021

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(Paper No. 7); thus, the merits have not been decided because this proceeding is in a preliminary stage. *See, e.g., AM General LLC v. Uusi, LLC*, IPR2016-01050, Paper 44 (Nov. 7, 2017) (terminating an IPR after the oral hearing); *Lam Research Corp. v. Daniel L. Flamm*, IPR2015-01764, IPR2015-01767, IPR2015-01768, Paper 27 (Dec. 15, 2016) (same); *Hydrite Chemical Co. v. Solenis Technologies, L.P.*, IPR2015-01586, Paper 38, IPR2015-01592, Paper 39 (Nov. 25, 2016) (same); *Clio USA, Inc. v. The Procter & Gamble Company*, IPR2013-00438, Paper 57 (Oct. 31, 2014) (same).

The Parties have reached an agreement to terminate this proceeding pursuant to the terms and conditions in the Stipulation. Maintaining this proceeding in the absence of Petitioner would contradict the Board’s policy of favoring agreements between parties to a proceeding, and would contradict the Congressional goal to establish a more efficient and streamlined patent system that limits unnecessary and counterproductive litigation costs, *see, e.g., AM General LLC*, IPR2016-01050, Paper 44 (terminating an IPR after the oral hearing: “These proceedings are at a late stage of the trial. However, the Board has not yet entered final written decisions on the merits . . . Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.”). In this proceeding, where the Parties have not completed their responsive filings, and an oral hearing will not occur for nearly 3 months, termination is appropriate.

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Therefore, Petitioner and Patent Owner respectfully and jointly request termination of *Inter Partes* Review No. IPR2020-00660. This paper is being filed by Quinn Emanuel Urquhart & Sullivan, LLP with the approval of counsel for Petitioner.

Date: April 15, 2021

Respectfully submitted,

By: /s/ Christopher Mathews
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that this Joint Stipulation to Terminate Proceedings was served on April 15, 2021 by e-mailing copies to:

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