

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.
Petitioner,

v.

NXP B.V.
Patent Owner

Case No. IPR2015-01082 (Patent No. 6,590,365)
Case No. IPR2015-01083 (Patent No. 6,590,365)
Case No. IPR2015-01271 (Patent No. 8,412,185)
Case No. IPR2015-01306 (Patent No. 8,065,389)
Case No. IPR2015-01308 (Patent No. 8,204,959)
Case No. IPR2015-01349 (Patent No. 8,280,304)¹

**JOINT MOTION TO TERMINATE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317**

¹ Combined heading used with Board authorization provided on October 20, 2015.

IPR2015-01082, IPR2015-01083, IPR2015-01271,
IPR2015-01306, IPR2015-01308, and IPR2015-01349

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IPR2015-01306, IPR2015-01308, and IPR2015-01349

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Dell Inc.

(“Petitioner”) and Patent Owner NXP B.V. (“Patent Owner”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate the following *Inter Partes* Review Proceedings in their entirety:

IPR Case No.	Patent No.²
IPR2015-01082	6,590,365
IPR2015-01083	6,590,365
IPR2015-01271	8,412,185
IPR2015-01306	8,065,389
IPR2015-01308	8,204,959
IPR2015-01349	8,280,304

Following an October 15, 2015 request, the Board held a conference call with the parties on October 20, 2015. During that call, Petitioner and Patent Owner confirmed to the Board that the parties had reached a settlement agreement resolving all disputes between them involving the patents-at-issue noted above, and sought guidance and permission to file a motion to terminate these proceedings. As stated during the call, the Board authorized the parties to file a common joint

² U.S. Patent Nos. 6,590,365, 8,412,185, 8,065,389, 8,204,959, and 8,280,304 are collectively referred to herein as the “patents-at-issue.”

IPR2015-01082, IPR2015-01083, IPR2015-01271,
IPR2015-01306, IPR2015-01308, and IPR2015-01349

motion to terminate across all six proceedings.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner have filed herewith a true copy (including counterparts) of the confidential settlement agreement. There are no collateral agreements. Because the settlement agreement is confidential, the parties respectfully request that it be treated as business confidential information and kept separate from the underlying patent file, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties are concurrently filing a separate joint request to this effect.

As stated in 35 U.S.C. § 317(a), because Petitioner and Patent Owner are jointly requesting this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

I. TERMINATION OF THE *INTER PARTES* REVIEW PROCEEDINGS IS APPROPRIATE

The statutory provision on a settlement relating to *inter partes* reviews provides that an *inter partes* review “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. It 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(a).” *Id.*

Here, termination is proper under 35 U.S.C. § 317(a) because the parties

IPR2015-01082, IPR2015-01083, IPR2015-01271, IPR2015-01306, IPR2015-01308, and IPR2015-01349 have resolved their dispute regarding the patents-at-issue and the Board has not decided the merits of the proceedings. In fact, the Board has yet to issue a determination on whether to institute any of the six *Inter Partes* Reviews. Moreover, because Dell is the only petitioner in any of the *Inter Partes* Review Proceedings, once each proceeding is terminated with respect to Dell, no petitioner will remain, and the Office may terminate the *inter partes* review in its entirety under Section 317. Furthermore, termination will save significant further expenditure of resources by the Board, and will further the purpose of IPR proceedings to provide an efficient and less costly alternative forum for patent disputes (including by encouraging settlement).

Indeed, the Board has stated an *expectation* that proceedings such as these will be terminated after the filing of a settlement agreement: “[t]here are strong public policy reasons to favor settlement between the parties to a 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. 35 U.S.C. 317(a), as amended....” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (emphasis added). The Board’s expectation that such proceedings should be terminated is proper and well justified here.

First, applying the Board’s expectation that these proceedings should be terminated promotes the Congressional goal of “establish[ing] a more efficient and

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