

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASUSTEK COMPUTER, INC. and
ASUS COMPUTER INTERNATIONAL,
Petitioners,

v.

AVAGO TECHNOLOGIES GENERAL IP (SINGAPORE) PTE. LTD.,
Patent Owner.

Case IPR2016-00648
Patent 6,188,835 B1

Before GLENN J. PERRY, PATRICK R. SCANLON, and J. JOHN LEE,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION
Motion to Terminate
35 U.S.C. § 317 and 37 C.F.R. § 42.74

On December 15, 2016, Petitioners ASUSTeK Computer, Inc. and ASUS Computer International (collectively, “ASUS”), and Patent Owner Avago Technologies General IP Pte. Ltd. (“Avago”), filed a Joint Motion to Terminate the present proceeding concerning U.S. Patent No. 6,188,835 B1 (“the ’835 Patent”). Paper 19 (“Motion” or “Mot.”). Under 35 U.S.C. § 317(a), 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.”

As provided in 35 U.S.C. § 317(b), however, “[a]ny agreement or understanding . . . made in connection with, or in contemplation of, the termination” of the *inter partes* review “shall be in writing and a true copy of such agreement or understanding shall be filed in the Office.” *See also* 37 C.F.R. § 42.74(b) (regulation implementing the above portion of § 317(b)). This requirement extends as well to “any collateral agreements referred to in such agreement or understanding.” 35 U.S.C. § 317(b).

The Motion refers to an “agreement” between the parties, and the parties submit a series of e-mails exchanged between counsel for ASUS and counsel for Avago. Mot. 3 (citing Ex. 1011). The parties do not, however, represent or otherwise indicate that the submitted e-mail exchange is the *only* agreement or understanding made in connection with, or in contemplation of, the termination of the present proceeding. In other words, the parties have not addressed whether any *other* such agreement may exist that has not been filed, as required under § 317(b).

The e-mail exchange submitted by the parties also does not provide the necessary information. In an e-mail dated November 8, 2016, counsel for Avago made a “formal proposal” in which Avago agreed to “withdraw

all claims of infringement of the '835 Patent" from a pending district court case in exchange for ASUS's agreement to "withdraw all claims of invalidity of the '835 Patent from [the same district court case]," and to "terminate the [*inter partes* review] of the '835 Patent." Ex. 1011, 1–2. The parties also would "reserve all rights to seek costs" under the proposal. *Id.* at 2. The e-mail then indicates that, should ASUS agree to the proposal, counsel for Avago would "prepare the paperwork." *Id.* After discussing additional terms in subsequent e-mails (i.e., dismissal of infringement allegations "with prejudice" and stipulating to extend deadlines in the present proceeding), counsel for ASUS states, "Yes that works and yes we can extend." *Id.* at 1.

It is unclear what the "paperwork" mentioned by Avago's counsel entailed. For example, it is unclear if Avago's counsel was referring to a more formal document memorializing the terms discussed in the e-mail exchange, perhaps signed by the parties themselves (as opposed to their respective trial counsel*), and possibly including other terms not discussed in the e-mail exchange. The reference to "paperwork" at least raises the possibility that a collateral agreement could exist. In either case, such documents must be filed with the Board as required by § 317(b) and 37 C.F.R. § 42.74(b). By failing to file all such documents, or at least

* The e-mail exchange involved the parties' counsel of record in the present proceeding. ASUS's counsel appears also to be counsel for ASUS in the related district court case implicated in the parties' agreement. *See* Ex. 1010 ¶ 11. The parties do not indicate whether Avago's counsel in the e-mail exchange also represents Avago in the district court case. It is unclear whether the e-mails alone present sufficient information of an effective agreement between the parties, and no written agreement signed by the parties themselves was submitted.

representing that no such agreements exist (e.g., because the e-mails constitute the only agreement between the parties), the parties' Motion fails to comply with the requirements set forth in the statute and our rules.

For the above reasons, we must deny the Motion. Nonetheless, we authorize the parties to file a second motion to terminate the present proceeding to afford the parties an opportunity to correct the deficiencies in the Motion, including filing *all* agreements made in connection with, or in contemplation of, the termination of this proceeding. We further remind the parties that any settlement agreement may be requested to be kept separate from the public record to protect confidential business information, as provided under 37 C.F.R. § 42.74(c).

ORDER

It is

ORDERED that the Joint Motion to Terminate Proceeding (Paper 19) is *denied* without prejudice; and

FURTHER ORDERED that the parties are authorized to file another joint motion to terminate the present proceeding under 35 U.S.C. § 317 and 37 C.F.R. § 42.74, consistent with the requirements discussed in this decision.

IPR2016-00648
Patent 6,188,835 B1

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