

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

**BROADCOM LIMITED**  
Petitioner,

v.

**TESSERA ADVANCED TECHNOLOGIES, INC.**  
Patent Owner

Case No. IPR2017-00736  
Patent No. 7,809,393

**JOINT MOTION TO TERMINATE PURSUANT TO  
35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72 AND 42.74**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board's authorization of December 20, 2017, Petitioner Broadcom Limited ("Broadcom") and Patent Owner Tessera Advanced Technologies, Inc. ("Tessera") jointly move to terminate the present *inter partes* review proceeding in light of the parties' settlement of their dispute insofar as it relates to U.S. Patent No. 7,809,393 ("the '393 patent"). The parties are filing, concurrently herewith, true copies of their written Settlement Agreement (Confidential Exhibit 2005), License Agreement (Confidential Exhibit 2006), and collateral agreements (Confidential Exhibits 2007-2010) (collectively, the "Agreements") in connection with this matter as required by the statute. The Agreements completely resolve all controversies between the Patent Owner and Petitioner, including their dispute relating to the '393 patent by resolving each of the following actions:

- a) *Certain Semiconductor Devices, Semiconductor Device Packages, and Products Containing Same*, Inv. No. 337-TA-1010 (U.S. Int'l Trade Comm'n);
- b) *Certain Wireless Audio Systems and Components Thereof*, Inv. No. 337-TA-1071 (U.S. Int'l Trade Comm'n);
- c) *Tessera, Inc., et al. v. Broadcom Corp.*, Civil Action No. 16-cv-00379 (D. Del.);
- d) *Tessera, Inc., et al. v. Broadcom Corp.*, Civil Action No. 16-cv-00380 (D. Del.)
- e) *Invensas Corp. v. Avago Technologies U.S. Inc., et al.*, Civil Action No. 16-cv-1033 (D. Del.);

- f) *Tessera Inc., et al. v. Avago Technologies U.S. Inc., et al.*, Civil Action No. 16-cv-1034 (D. Del);
- g) *Broadcom Ltd., et al. v. DTS, Inc., et al.*, Case No. 2:17-cv-05935-AB-JEM (C.D. Cal.);
- h) *Invensas Corp. v. Mouser Electronics Inc., et al.*, Case No. 7 O 97/16 (District Court Mannheim, Germany) / 6 U 46/17 (Appellate Court Karlsruhe, Germany), including all corresponding enforcement proceedings;
- i) *Invensas Corp. v. Broadcom Ltd., et al.*, Case No. 7 O 98/16 (District Court Mannheim, Germany) / 6 U 34/17 (Appellate Court Karlsruhe, Germany), including all corresponding enforcement proceedings;
- j) *Avago Technologies GmbH v. Invensas Corp.*, Case No. 2 Ni 43/16 (EP) (Federal Patent Court, Germany);
- k) *Invensas Corp. v. Broadcom Ltd., et al.*, Case No. C/09/517267 (District Court of The Hague, Netherlands); and
- l) IPR2017-00170, -00171, -00736, -01470, -01486, -01645, -01646, -01649, -02201; and
- m) IPR2018-00021, -00135, -00172.

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Tessera and Broadcom, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Agreements (Confidential Exhibits 2005-2010) be treated as business confidential information and kept separate from the file of the '393 patent. This confidentiality request extends to the title of the Agreements,

which are therefore identified as “Agreement 1,” “Agreement 2,” “Agreement 3,” “Agreement 4,” “Agreement 5,” and “Agreement 6” on Patent Owner’s Updated Exhibit List, filed herewith. A joint request to treat the Agreements as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently herewith.

Termination with Respect to Petitioner

Under 35 U.S.C. § 317(a), “[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.” This case was instituted on July 27, 2017, and, as such, the Reply to Patent Owner’s Response is not due until February 1, 2018, and the Office has not decided the merits of the proceeding. Therefore, the requirement for terminating review is met. *See Oracle Corp. v. Clouding IP, LLC*, IPR2013-00073, Paper No. 21, at \*2 (P.T.A.B. July 22, 2013).

Termination with Respect to *Inter Partes* Review Proceeding

Moreover, in the circumstances of this case, the Board should exercise its discretion to terminate the proceedings as to patent owner Tessera, without rendering a final written decision. The Patent Owner’s Response to the petition has been filed, but the Office has made no decision on the merits. As recognized by the rules of practice before the Board:

*There are strong public policy reasons to favor settlement* between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the 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.

Patent Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (emphasis added).

The public interest favors terminating this proceeding now, given the parties' definitive settlement. As noted above, the Reply to Patent Owner's Response is not due until February 1, 2018, and, consequently, the Office has not issued any decision on the merits. The parties have worked diligently to reach a private resolution of all of their disputes relating to the '393 patent. There will be no ongoing litigation between the parties concerning the '393 patent. A termination will further allow the Board to conserve its resources here and in other IPR proceedings between the parties, and focus the Board's efforts on ongoing active disputes.

A joint motion to terminate generally "must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding."

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