

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON WEB SERVICES, INC.,
Petitioner,

v.

BROADCOM CORPORATION,
Patent Owner.

Cases¹

IPR2017-00811 (Patent 7,296,295 B2)
IPR2017-01991 (Patent 6,501,480 B1)

Before JAMES B. ARPIN, BARBARA A. PARVIS, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

ARPIN, *Administrative Patent Judge*.

ORDER

Authorization to File Motions to Terminate and to Dismiss
35 U.S.C. §§ 314 and 317 and 37 C.F.R. §§ 42.71(a) and 42.74

¹ This Order applies to each of the listed cases. The parties are not authorized to use a multiple case caption.

IPR2017-00811 (Patent 7,296,295 B2)
IPR2017-01991 (Patent 6,501,480 B1)

I. BACKGROUND

Broadcom Corporation (“Patent Owner”) filed a copy of a stipulation signed by counsel for the parties indicating that the counts of the complaint in the co-pending litigation regarding the patents at issue in the above-captioned proceedings have been dismissed with prejudice from that litigation. IPR2017-00811, Ex. 2001, 2 (filed Sept. 18, 2017); IPR2017-01991, Ex. 2001, 2 (filed Sept. 14, 2017); *see* IPR2017-00811, Paper 6, 1 (identifying the co-pending litigation); IPR2017-01991, Paper 5, 1 (identifying the co-pending litigation). Further, in the stipulations, the parties state that:

7. Defendants shall take all actions necessary to withdraw the petition for *inter partes* review in IPR2017-00811, and *the parties shall cooperate to effect the termination of IPR2017-00811* in light of the parties’ agreement to resolve the claims in respect of United States Patent No. 7,296,295.

8. Defendants shall take all actions necessary to withdraw the petition for *inter partes* review in IPR2017-01991, and *the parties shall cooperate to effect the termination of IPR2017-01991* in light of the parties’ agreement to resolve the claims in respect of United States Patent No. 6,501,480.

E.g., IPR2017-00811, Ex. 2001, 2–3 (emphases added).

On September 21, 2017, Amazon.com, Inc. and Amazon Web Services, Inc. (collectively “Petitioner”) contacted the Board via e-mail and indicated that “Petitioners and Patent Owner respectfully request authorization to file a Joint Motion to Terminate in each of the IPR2017-00811 and IPR2017-01991 proceedings. The parties have agreed to terminate these two proceedings and executed a stipulation, which the parties intend to file with the Joint Motions to Terminate.” On September 27, 2017, the panel and the parties’ counsel held a conference call to discuss the parties’ request and the status of each case before the Board.

IPR2017-00811 (Patent 7,296,295 B2)

IPR2017-01991 (Patent 6,501,480 B1)

A. IPR2017-00811

Unlike IPR2017-01991, we instituted *inter partes* review of challenged claims of the patent at issue in IPR2017-00811. Although the parties' counsel indicated during the conference call that they had not yet prepared an agreement documenting the settlement of their dispute in the *inter partes* review, they indicated they would prepare such an agreement for execution by the parties and would file a true copy of the agreement (as an separate Exhibit) with a Joint Motion to Terminate IPR2017-00811, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. The Joint Motion to Terminate should update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint Motion to Terminate also must include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. *See* 35 U.S.C. §317(b); 37 C.F.R. § 42.74(b). The parties are permitted to request that a settlement agreement be kept separate pursuant to 35 U.S.C. §317(b) and 37 C.F.R. § 42.74(c).

B. IPR2017-01991

IPR2017-01991 is at the preliminary proceeding stage. Petitioner filed its Petition on August 21, 2017, and the deadline has not yet arrived for Patent Owner to file any Preliminary Response. Hence, we have not yet considered Petitioner's Petition or reached any conclusions regarding its merits. Therefore, we *grant* the parties' request to file a Joint Motion to Dismiss IPR2017-01991, pursuant to 35 U.S.C. § 314(b) and 37 C.F.R. § 42.71(a).

IPR2017-00811 (Patent 7,296,295 B2)
IPR2017-01991 (Patent 6,501,480 B1)

II. ORDER

It is therefore

ORDERED that the parties are authorized to file a Joint Motion to Terminate IPR2017-00811, a true copy of any agreement settling their dispute regarding the patent at issue in IPR2017-00811, and a Joint Request that the Settlement Agreement be Treated as Business Confidential Information, pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74; and

FURTHER ORDERED the parties are authorized to file a Joint Motion to Dismiss IPR2017-01991, pursuant to 35 U.S.C. § 314(b) and 37 C.F.R. § 42.71(a).

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