

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BROADCOM CORPORATION
Petitioner,

v.

TESSERA, INC.
Patent Owner

Case No. IPR2017-01645
Patent No. 6,046,076

**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 Corporation ("Broadcom") and Patent Owner Tessera, 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. 6,046,076 ("the '076 patent"). The parties are filing, concurrently herewith, true copies of their written Settlement Agreement (Confidential Exhibit 2009), License Agreement (Confidential Exhibit 2010), and collateral agreements (Confidential Exhibits 2011-2014) (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 '076 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 2009-2014) be treated as business confidential information and kept separate from the file of the '076 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 Inter Partes Review Proceeding

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.”

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). Each element is addressed below:

As for requirement (1), termination is appropriate in this proceeding because the parties have settled their dispute with respect to the ’076 patent, and have agreed to terminate this *inter partes* review. The applicable statute, 35 U.S.C. § 317(a), provides that an instituted *inter partes* review proceeding “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.” In this case, the Patent Owner’s Preliminary Response to the

petition was filed on October 25, 2017, and, consequently, the Office has not instituted the petition and has made no decision on the merits. Moreover, 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). Moreover, no public interest or other factors militate against termination of this proceeding.

As for requirement (2), as discussed above, the only parties to any related litigations involving the '076 patent are Patent Owner Tessera, Inc.; Petitioner Broadcom Corporation; and Invensas Corporation, Tessera Advanced Technologies, Inc., Avago Technologies U.S. Inc. and Avago Technologies Wireless (U.S.A.) Manufacturing Inc. Broadcom Corporation, Avago Technologies U.S. Inc. and Avago Technologies Wireless (U.S.A.) Manufacturing Inc. are all subsidiaries of Broadcom Limited. Tessera, Inc., Invensas Corporation, and Tessera Advanced Technologies, Inc. are all subsidiaries of Xperi Corporation. Those litigations are now terminated or in the process of termination.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.