

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC. and MEDIATEK USA, INC.,
Petitioner,

v.

BANDSPEED, INC.,
Patent Owner.

Case IPR2015-00314 (Patent 7,477,624 B2)
Case IPR2015-00315 (Patent 7,477,624 B2)
Case IPR2015-00316 (Patent 7,477,624 B2)
Case IPR2015-00531 (Patent 8,542,643 B2)¹

Before BART A. GERSTENBLITH, DAVID C. McKONE, and
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Joint Motions to Terminate
37 C.F.R. § 42.74

¹ This Order addresses the same issue in four captioned *inter partes* reviews. The parties are not authorized to use this style of filing in subsequent papers without prior authorization.

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On August 5, 2015, the parties filed Joint Motions to Terminate each of the captioned proceedings. Paper 17.² For each proceeding, the parties represent that “the dispute between the parties has been resolved, and further, the parties have agreed to terminate this *inter partes* review.” *Id.* at 2. With each of their Motions to Terminate, the parties filed what they represent is “a true copy of their written agreement as Exhibit 1018.” *Id.* In concurrently filed Joint Motions to Seal, the parties request that the agreement be treated as business confidential information and be kept separate from the file of the involved patent. Paper 18.

These proceedings are related to IPR2015-1577, IPR2015-01580, IPR2015-01581, and IPR2015-01582 (“the related proceedings”). In each of the related proceedings, a petition was filed by Qualcomm Incorporated on July 12, 2015, with a motion to join a respective one of these proceedings. Papers 1, 2 in each of the related proceedings. We note that the joinder motions in the related proceedings were filed before the instant motions to terminate were filed in these proceedings. Patent Owner opposes the joinder motions in the related proceedings. Paper 8 in each of the related proceedings. If the joinder motions are not granted, the related proceedings are barred under 35 U.S.C. § 315(b). *See* 35 U.S.C. § 315(c). Patent Owner has not yet filed a preliminary response in any of the related proceedings, the deadline for which is October 28, 2015, nor sought to expedite the related proceedings by filing a waiver under 37 C.F.R. § 42.107(b). It is thus

² Citations are to IPR2015-00314.

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premature to decide the joinder motions in the related proceedings. *See* 35 U.S.C. § 315(c).

Nevertheless, we discern no compelling interest to be served by delaying termination of these proceedings with respect to MediaTek Inc. and MediaTek USA, Inc., both of which have settled with Patent Owner. *See* 35 U.S.C. § 317 (“An *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” (emphasis added)). These proceedings are at an early stage, and no motions are pending in any of these proceedings. Under these circumstances, we determine that it is appropriate to terminate these proceedings with respect to MediaTek Inc. and MediaTek USA, Inc. We exercise the discretion afforded under 35 U.S.C. § 317(a) to decline, at this time, to terminate these proceedings with respect to Patent Owner. Because no petitioner remains in these proceedings, we vacate the Scheduling Order in each proceeding (Paper 13 in IPR2015-00314, IPR2015-00316, and IPR2015-00531; and Paper 15 in IPR2015-00315). If necessary, we will revisit scheduling for these proceedings after decisions on the joinder motions are made in the related proceedings. If appropriate, we will also revisit the Motions to Terminate as to Patent Owner after ruling on the motions for joinder in the related proceedings.

The Joint Motions to Seal are granted to the extent that they request that the agreement be treated as business confidential information and be kept separate from the patent files under 37 C.F.R. § 42.74(c) but otherwise

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denied. The requests should not have been filed as “Motions to Seal,” which has other meaning, under 37 C.F.R. § 42.14, with respect to the underlying document in the context of the proceeding, e.g., expungement or made public under certain circumstances.

Accordingly, it is

ORDERED that the Joint Motions to Terminate the captioned proceedings are *granted* with respect to MediaTek Inc. and MediaTek USA, Inc.;

FURTHER ORDERED that the agreement (Ex. 1018) be treated as business confidential information and be kept separate from the file of the involved patent, under 37 C.F.R. § 42.74(c);

FURTHER ORDERED that the Scheduling Order in each proceeding (Paper 13 in IPR2015-00314, IPR2015-00316, and IPR2015-00531; and Paper 15 in IPR2015-00315) is *vacated*; and

FURTHER ORDERED that each of the captioned proceedings will continue with respect to Bandspeed, Inc.

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