

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MARVELL SEMICONDUCTOR, INC.,  
MEDIATEK INC., and MEDIATEK USA, INC.  
Petitioners

v.

BANDSPEED, INC.  
Patent Owner

---

Case IPR2015-00315  
Patent No. 7,477,624

---

**JOINT MOTION TO TERMINATE WITH RESPECT TO ONE  
PETITIONER, MARVELL SEMICONDUCTOR, INC.,  
PURSUANT TO 35 U.S.C § 317 AND 37 C.F.R. § 42.74**

***Mail Stop “PATENT BOARD”***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Marvell Semiconductor, Inc. (“Marvell”) and Patent Owner Bandspeed, Inc. (“Bandspeed”) jointly move to terminate the present *inter partes* review proceeding only with respect to Petitioner Marvell, in light of the parties’ resolution of their dispute relating to U.S. Patent No. 7,477,624 (“the ’624 patent”). Petitioner MediaTek does not oppose termination of the instant proceeding with respect to Petitioner Marvell.

Termination with respect to Petitioner Marvell is appropriate in the instant proceeding because the dispute between the parties has been resolved, and further, the parties have agreed to terminate this *inter partes* review.

As required by 35 U.S.C. § 317(b), the parties are filing, concurrently herewith, a true copy of their written agreement as Exhibit 1013. The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the agreement be treated as confidential business information and kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a motion to seal pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

The applicable statute, provides that an *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.” 35 U.S.C. § 317(a) (emphasis added).

The proceeding is still in its early stages. In fact, an institution decision has not issued. Termination with respect to Marvell will not adversely affect any of the other parties or impair the Board in proceeding to a decision on the merits.

Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding. See Office Trial Practice Guide, Fed. Reg., Vol. 77, No. 157 at 48768 (Aug. 14, 2012). No public interest or other factors militate against termination of this proceeding with respect to Marvell.

The status of all district court cases involving U.S. Patent No. 7,477,624 is presented below.

| Judicial Matter                                   | Court     | Filed:   | Ended    | Docket No.    |
|---|-----------|----------|----------|---------------|
| Bandspeed, Inc. v. Broadcom Corporation           | W.D. Tex. | 05/09/14 | 08/29/14 | 1:14-CV-00433 |
| Bandspeed, Inc. v. Marvell Semiconductor, Inc.    | W.D. Tex  | 05/09/14 | 05/07/15 | 1:14-CV-00434 |
| Bandspeed, Inc. v. MediaTek USA, Inc.             | W.D. Tex  | 05/09/14 | Pending  | 1:14-CV-00435 |
| Bandspeed, Inc. v. Qualcomm Incorporated et al.   | W.D. Tex  | 05/09/14 | Pending  | 1:14-CV-00436 |
| Bandspeed, Inc. v. STMicroelectronics N.V. et al. | W.D. Tex  | 05/09/14 | 04/06/15 | 1:14-CV-00437 |
| Bandspeed, Inc. v. Texas Instruments Incorporated | W.D. Tex  | 05/09/14 | Pending  | 1:14-CV-00438 |

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated with respect to Petitioner Marvell.

Respectfully submitted,

/s/ Gregory S. Donahue

Gregory S. Donahue, Registration No. 47,531  
DiNOVO PRICE ELLWANGER & HARDY LLP  
7000 North MoPac Expressway  
Suite 350  
Austin, Texas 78731  
(512) 539-2626

**Attorney for Patent Owner**

/s/ Robert E. Sokohl

Lori A. Gordon, Registration No. 50,633  
Robert E. Sokohl, Registration No. 36,013  
STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C.

1100 New York Ave NW  
Washington, D.C. 20005  
(202) 371-2600

**Attorneys for Petitioners**

Date: June 2, 2015

### Appendix A - Exhibit List

| Exhibit No. | Description   |
|-------------|---|
| 1001        | U.S. Patent No. 7,477,624 to Gan et al., issued January 13, 2009 (“The ’624 Patent”)  |
| 1002        | Declaration of Dr. Zhi Ding in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,477,624 November 24, 2014 (“Ding Decl.”) |
| 1003        | U.S. Patent No. 6,760,319 to Gerten et al., issued July 6, 2004 (“Gerten”)  |
| 1004        | U.S. Patent No. 6,418,317 to Cuffaro et al., issued July 9, 2002 (“Cuffaro”)  |
| 1005        | U.S. Patent No. 6,115,407 to Gendel et al., issued September 5, 2000 (“Gendel”)   |
| 1006        | U.S. Patent No. 7,280,580 to Haartsen, issued October 9, 2007 (“Haartsen”)  |
| 1007        | U.S. Patent No. 5,781,582 to Sage et al., issued July 14, 1998 (“Sage”)   |
| 1008        | Definition of “vote,” The American Heritage Dictionary, Second College Edition, Boston: Houghton Mifflin Company, 1985; p. 1356                 |
| 1009        | Definition of “while,” The American Heritage Dictionary, Second College Edition, Boston: Houghton Mifflin Company, 1985; p. 1376                |
| 1010        | Definition of “Register,”– Microsoft Press Computer Dictionary, 3 <sup>rd</sup> Edition, Redmond, WA: Microsoft, 1997; p. 402                   |
| 1011        | <i>Curriculum Vitae</i> of Zhi Ding, Ph.D.  |
| 1012        | Specification of the Bluetooth System, Version 1.0B, December 1, 1999   |
| 1013        | Release Agreement   |

# 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.