

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

BANDSPEED, INC.,
Patent Owner.

Case IPR2015-00316
Patent 7,477,624 B2

Before MICHELLE N. WORMMEESTER,
Administrative Patent Judge.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On May 20, 2015, a telephone conference call was held between respective counsel for the parties and Judge Wormmeester. One of the three constituents of Petitioner, i.e., Marvell Semiconductor, Inc. (“Marvell”), and Patent Owner sought authorization to file a joint motion to terminate this proceeding, under 35 U.S.C. § 317(a), with respect to Marvell, on the basis

that Marvell and Patent Owner have settled. We recognize that a trial has not yet been instituted, but the same considerations apply.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all constituent entities of Petitioner. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Here, we would expect the proceeding to terminate with respect to Marvell, but not the other constituent entities of Petitioner and the Patent Owner. Any agreement or understanding between Marvell and Patent Owner made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy of the agreement shall be filed with the Board prior to termination. *See* 37 C.F.R. § 42.74(b).

The joint motion must include a brief explanation as to why termination as to Marvell is appropriate. Information should be provided on the status of related district court actions in which U.S. Patent No. 7,477,624 B2 has been asserted, particularly regarding the status of all defendants.

The joint motion to terminate must be accompanied by **a true copy** of the settlement agreement, as well as any collateral agreements referred to in the settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement.

With regard to having the settlement agreement treated as business confidential information and kept separate from the patent file(s) under 37 C.F.R. § 42.74(c), Marvell and Patent Owner must file the confidential settlement agreement electronically via the Patent Review Processing

System (PRPS) in accordance with the instructions provided on the Board's website (uploading as "Board Only"). Marvell and Patent Owner also are directed to FAQ G2 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file a settlement agreement as confidential.

During the conference call, counsel for the two other constituents of Petitioner, i.e., MediaTek Inc. and MediaTek USA, Inc. (collectively, "MediaTek entities"), indicated that those two constituent entities will not oppose the joint motion to terminate the proceeding as to Marvell. Counsel for the MediaTek entities also indicated that the same counsel for Petitioner will continue to represent the MediaTek entities after termination of this proceeding as to Marvell.

Accordingly, it is

ORDERED that Marvell Semiconductor, Inc. and Patent Owner are authorized to file a joint motion to terminate this *inter partes* review proceeding with respect to Marvell Semiconductor, Inc.;

FURTHER ORDERED that the joint motion must be accompanied by a true copy of the settlement agreement, labeled as an exhibit, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that in a separate motion Marvell Semiconductor, Inc., and Patent Owner may request that the settlement agreement be treated as business confidential information and kept separate from the underlying patent file, as provided in 37 C.F.R. § 42.74(c);

FURTHER ORDERED that any confidential settlement agreement must be filed electronically via PRPS in accordance with the instructions provided on the Board's website (uploading as "Board Only"); and

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FURTHER ORDERED that the motions shall be filed on or before
June 5, 2015.

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