

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 IPR2015-00316
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**

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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 1017. 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	Non-Final Office Action mailed January 12, 2012, <i>Inter Partes</i> Reexamination of U.S. Patent No. 7,027,418, Control No. 95/000648 (“Non-Final Office Action”)
1009	Patent Owner’s Housekeeping Amendment, filed February 11, 2013 in <i>Inter Partes</i> Reexamination of U.S. Patent No. 7,027,418, Control No. 95/000648 (“Housekeeping Amendment”)
1010	Patent Owner’s Comments after Action Closing Prosecution, filed December 3, 2013 in <i>Inter Partes</i> Reexamination of U.S. Patent No. 7,027,418, Control No. 95/000648 (“Comments After ACP”)
1011	Definition of “vote,” The American Heritage Dictionary, Second College Edition, Boston: Houghton Mifflin Company, 1985; p. 1356
1012	Definition of “while,” The American Heritage Dictionary, Second College Edition, Boston: Houghton Mifflin Company, 1985; p. 1376
1013	Definition of “Register,”— Microsoft Press Computer Dictionary, 3 rd Edition, Redmond, WA: Microsoft, 1997; p. 402
1014	<i>Curriculum Vitae</i> of Zhi Ding, Ph.D.

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