

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDIATEK INC. and MEDIATEK USA, INC.  
Petitioners

v.

BANDSPEED, INC.  
Patent Owner

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Case IPR2015-00316  
Patent No. 7,477,624

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**JOINT MOTION TO TERMINATE  
PURSUANT TO 35 U.S.C § 317 AND 37 C.F.R. § 42.74**

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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 MediaTek Inc. and MediaTek USA, Inc. (“MediaTek”) and Patent Owner Bandspeed, Inc. (“Bandspeed”) jointly move to terminate the present *inter partes* review proceeding with respect to both Petitioner MediaTek and Patent Owner Bandspeed, in light of the parties’ resolution of their dispute relating to U.S. Patent No. 7,477,624 (“the ’624 patent”).

Termination with respect to both Petitioner MediaTek and Patent Owner Bandspeed 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 1018. 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. Bandseed's patent owner response is not due until September 15, 2015. 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 factors militate against termination of this proceeding.

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 (but expected to be terminated soon)	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.

Respectfully submitted,

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Date: August 5, 2015

**Appendix A - Exhibit List**

<b>Exhibit No.</b>	<b>Description</b>
<b>1001</b>	U.S. Patent No. 7,477,624 to Gan et al., issued January 13, 2009 (“The ’624 Patent”)
<b>1002</b>	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.”)
<b>1003</b>	U.S. Patent No. 6,760,319 to Gerten et al., issued July 6, 2004 (“Gerten”)
<b>1004</b>	U.S. Patent No. 6,418,317 to Cuffaro et al., issued July 9, 2002 (“Cuffaro”)
<b>1005</b>	U.S. Patent No. 6,115,407 to Gendel et al., issued September 5, 2000 (“Gendel”)
<b>1006</b>	U.S. Patent No. 7,280,580 to Haartsen, issued October 9, 2007 (“Haartsen”)
<b>1007</b>	U.S. Patent No. 5,781,582 to Sage et al., issued July 14, 1998 (“Sage”)
<b>1008</b>	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”)
<b>1009</b>	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”)
<b>1010</b>	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”)
<b>1011</b>	Definition of “vote,” The American Heritage Dictionary, Second College Edition, Boston: Houghton Mifflin Company, 1985; p. 1356
<b>1012</b>	Definition of “while,” The American Heritage Dictionary, Second College Edition, Boston: Houghton Mifflin Company, 1985; p. 1376
<b>1013</b>	Definition of “Register,”— Microsoft Press Computer Dictionary, 3 <sup>rd</sup> Edition, Redmond, WA: Microsoft, 1997; p. 402
<b>1014</b>	<i>Curriculum Vitae</i> of Zhi Ding, Ph.D.

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