

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMART MODULAR TECHNOLOGIES INC.

Petitioner

v.

JAMES B. GOODMAN

Patent Owner

Case No. IPR2015-01675

Patent 6,243,315

JOINT MOTION TO TERMINATE PROCEEDING

PURSUANT TO 35 U.S.C § 317

VIA PRPS

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

The Parties have settled their litigation concerning U.S. Patent No. 6,243,315 and the Court issued an order requiring the Parties to terminate the *inter partes* review. Ex. 1018.

I. Brief Statement Of Relief Requested

Pursuant to 35 U.S.C. § 317, the Parties jointly request termination of the present *inter partes* review proceeding, Case No. IPR2015-01675, with respect to both Petitioner and Patent Owner, in light of the Parties' resolution of their disputes relating to U.S. Patent No. 6,243,315.

II. Authorization To File A Joint Motion To Terminate

On August 24, 2016, Petitioner and Patent Owner advised the Board that they have reached a settlement and requested authorization to file a joint motion to terminate the present *inter partes* review proceeding. On August 26, 2016, the Board authorized the filing of a joint motion to terminate the present *inter partes* review proceeding. Paper 15.

III. Argument In Support Of Termination Of Proceeding

The applicable statute provides that an *inter partes* review “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). The Parties have settled their disputes involving the '315 patent and have agreed to terminate the

present *inter partes* review proceeding. Pursuant to 35 U.S.C. § 317(b), the Parties are filing, concurrently herewith, a true copy of their written settlement agreement as Ex.1019B.

Further, the present *inter partes* review proceeding is still in its early stages. The Board instituted the present *inter partes* review proceeding on February 11, 2016, and Patent Owner filed its patent owner's response on March 3, 2016. See Scheduling Order, Paper 7 at page 6. The Board has not decided the merits of the present *inter partes* review proceeding.

In light of the foregoing, termination of the present *inter partes* review proceeding with respect to Petitioner and Patent Owner is appropriate.

IV. Conclusion

For the foregoing reasons, the Parties jointly and respectfully request termination of the present *inter partes* review, Case No. IPR2015-01675, with respect to both Petitioner and Patent Owner. Because the Parties jointly request termination as to Petitioner, no estoppel under 35 U.S.C. §315(e) shall attach to Petitioner under 35 U.S.C. § 317(a).

Dated: September 13, 2016

Respectfully submitted,

s/Michael F. Heafey/

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Certificate Of Service In Compliance With 37 C.F.R. § 42.6(e)(4)

The undersigned certifies that a complete copy of this JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C § 317 was served via email on Counsel for Patent Owner in this proceeding:

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