

**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**

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**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. 1020.

**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. On September 13, 2016, the Parties filed a Joint Motion to Terminate. On September 27, 2016 the Board denied the Joint Motion without prejudice citing the Parties' failure to include "a statement certifying that there are no additional collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review." Paper 17.

**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. 1021.

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. Statement Concerning Collateral Agreements**

In accordance with the Board’s Order, other than as described in this Section IV and accompanying exhibits, the Parties certify that there are “no additional collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.” The Parties settled their dispute pursuant to the terms set forth in the Settlement Term Sheet. Ex.

1021. In furtherance of the Settlement Term Sheet, Patent Owner granted SMART a license to the claimed inventions. Ex. 1022. Also in furtherance of the Settlement Term Sheet, the Parties stipulated that SMART's DDR2, DDR3, and DDR4 products do not infringe any claim of the '315 patent. Ex. 1023. The Court entered the stipulation on September 13, 2016. *Id.* Other than as described herein, there are no agreements between the Parties concerning the validity of any claim of the '315 patent or the *inter partes* review.

**V. Statement Concerning Future Litigation**

The Patent Owner plans to license and if necessary, enforce his rights under the '315 Patent, but not against SMART.

**VI. 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: October 3, 2016

Respectfully submitted,

s/Michael F. Heafey/

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