

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.

Petitioner

v.

ADVANCED SILICON TECHNOLOGIES LLC

Patent Owner

Case IPR2016-00894
Patent 8,933,945 B2

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

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Inter Partes Review of U.S. Patent No. 8,933, 945

Petitioner Volkswagen Group of America, Inc. (“Petitioner”) and Patent Owner Advanced Silicon Technologies LLC. (“Patent Owner”) have entered into a confidential Agreement that resolves all underlying disputes between the parties, including IPR2016-00894 against U.S. Patent No. 8,933,945. The parties are concurrently filing a copy of the Agreement as Exhibit 1016 along with a request to treat it as Confidential Business Information under 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b), sealing it from the public absent a showing of good cause. The undersigned represents that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding and that Exhibit 1016 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

Accordingly, pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.72 and § 42.74, and pursuant to the authorization to file this motion provided by the Board via email to the parties on August 10, 2016, Petitioner and Patent Owner jointly request termination of the present proceeding.

Public policy favors terminating the present *inter partes* review proceeding. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986)

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(“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Additionally, termination of the present proceeding at this stage, in view of the Agreement, is appropriate as the Board has not yet “decided the merits of this proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012); *see also* 35 U.S.C. § 317. Indeed, this proceeding has not yet been instituted, and no Motions or Petitions are currently outstanding. The USPTO can conserve its resources through terminating the proceedings now, removing the need for the Board to further consider the arguments, to issue an Institution Decision, and to render a Final Written Decision. Furthermore, no other party’s rights will be prejudiced by the termination of this proceeding.

Moreover, no additional disputes remain between Petitioner and Patent Owner involving U.S. Patent No. 8,933,945 as the Agreement also resolves the two pending litigations between the parties: *Certain Computing or Graphics Systems, Components Thereof, and Vehicles Containing Same*, Inv. No. 337-TA-984 and

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Advanced Silicon Technologies, LLC v. Volkswagen AG, 1:15-cv-01181 (D. Del.).

Additionally, the parties do not contemplate any further litigation or proceedings related to U.S. Patent No. 8,933,945.

Lastly, in accordance with the guidelines established by the Board in *Heartland Tanning, Inc. v. Sunless, Inc.*, the parties hereby identify, and set forth the status of, all other related litigation involving U.S. Patent No. 8,933,945. *See* IPR2014-00018, PaperNo. 26, at *2 (P.T.A.B. July 28, 2014).

In the above-identified ITC Investigation, U.S. Patent No. 8,933,945 was also asserted against respondents *Harman International Industries Incorporated, et al., Texas Instruments Incorporated, Renesas Electronics Corporation, et al., NVIDIA Corporation, Bayerische Motoren Werke AG, et al., and Honda Motor Co., Ltd., et al.* Respondent NVIDIA Corporation has been terminated from the ITC Investigation, and joint motions to terminate the ITC investigation are pending for all other respondents.

The status of all other related district court litigation involving U.S. Patent No. 8,933,945 is as follows:

Case Caption	Current Status
<i>Advanced Silicon Technologies LLC v. Harman International Industries Incorporated, et al.</i> , C.A. No. 1:15-cv-1173-RGA, United States District Court for the District of Delaware (filed on	Administratively closed in view of ITC Inv. No. 337-TA-984.

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Case Caption	Current Status
December 21, 2015)	
<i>Advanced Silicon Technologies LLC v. Texas Instruments Incorporated, C.A. No. 1:15-cv-1175-RGA, United States District Court for the District of Delaware (filed on December 21, 2015)</i>	Administratively closed in view of ITC Inv. No. 337-TA-984.
<i>Advanced Silicon Technologies LLC v. Renesas Electronics Corporation, et al., C.A. No. 1:15-cv-1176-RGA, United States District Court for the District of Delaware (filed on December 21, 2015)</i>	Administratively closed in view of ITC Inv. No. 337-TA-984.
<i>Advanced Silicon Technologies LLC v. NVIDIA Corporation, C.A. No. 1:15-cv-1177-RGA, United States District Court for the District of Delaware (filed on December 21, 2015)</i>	Dismissed with prejudice.
<i>Advanced Silicon Technologies LLC v. Bayerische Motoren Werke AG, et al., C.A. No. 1:15-cv-1178-RGA, United States District Court for the District of Delaware (filed on December 21, 2015)</i>	Administratively closed in view of ITC Inv. No. 337-TA-984.
<i>Advanced Silicon Technologies LLC v. Honda Motor Co., Ltd., et al., C.A. No. 1:15-cv-1179- RGA, United States District Court for the District of Delaware (filed on December 21, 2015)</i>	Administratively closed in view of ITC Inv. No. 337-TA-984.

Further, the following related *Inter Partes* Review proceedings for U.S. Patent No. 8,933,945 are currently before the USPTO:

Case Caption	Current Status

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