Filed on behalf of Unified Patents Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.
Petitioner

v.

ADVANCED SILICON TECHNOLOGIES LLC
Patent Owner

IPR2016-01060
Patent 8,933,945

JOINT MOTION TO TERMINATE
UNDER 35 U.S.C. § 317(a)

Pursuant to 35 U.S.C. § 317(a), Petitioner Unified Patents Inc. ("Petitioner" or "Unified") and Patent Owner Advanced Silicon Technologies LLC ("Patent Owner" or "AST") jointly request termination of the *Inter Partes* Review of U.S. Patent 8,933,945 in IPR2016-01060.

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves all underlying disputes between the parties, including IPR2016-01060 against U.S. Patent 8,933,945 (the "Settlement Agreement"). The Parties are concurrently filing a copy of the Settlement Agreement as EX1017 along with a request to treat it as confidential business information pursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b). 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 EX1017 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

On October 4, 2016, the Parties informed the Board of the settlement and requested authorization to file a joint motion to terminate the proceeding with respect to both the Patent Owner and the Petitioner. As set forth in an e-mail dated October 5, 2016, the Board authorized the filing of the requested joint motion to terminate this proceeding as to both parties. Accordingly,

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) ("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).

Ending this IPR early promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012).

Permitting termination as to all parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation.

Additionally, termination of this IPR is appropriate as the Board has not yet "decided the merits of the proceeding." *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Unified filed its petition for *inter partes* review on July 22, 2015. AST filed a preliminary response prior to institution August 23, 2016. The Board has not yet instituted any of these proceedings on any grounds or claims, and no motions or petitions are currently outstanding. The parties have now settled their dispute, and have reached agreement to terminate this *inter partes* review. 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 Decision. Furthermore, no other party's rights will be prejudiced by the termination of this proceeding.

Lastly, in accordance with the guidelines suggested by a Board panel 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, Paper No. 26, at *2 (P.T.A.B. July 28,

2014).

In *Certain Computing or Graphics Systems, Components Thereof, and Vehicles Containing Same*, Inv. No. 337-TA-984, U.S. Patent No. 8,933,945 was asserted against respondents Harman International Industries Incorporated, et al., FUJITSU TEN LIMITED, et al., Texas Instruments Incorporated, Renesas Electronics Corporation, et al., NVIDIA Corporation, Bayerische Motoren Werke AG, et al., Honda Motor Co., Ltd., et al., Toyota Motor Company, et al, and Volkswagen AG, et al. Respondents NVIDIA and Texas Instruments have been terminated from the ITC investigation. The presiding ALJ has issued an initial determination to terminate respondents Harman, Bayerische Motoren Werke, and Toyota. Joint motions are pending to terminate all other respondents Fujitsu-Ten, Renesas, and Honda.

The status of all related district court litigation involving U.S. Patent 8,933,945 follows:

Case Caption	**Current Status**
Advanced Silicon Technologies LLC v. Harman International Industries Incorporated, et al., C.A. No. 1:15-cv- 1173-RGA, United States District Court for the District of Delaware (filed on December 21, 2015)	Dismissed without prejudice.
Advanced Silicon Technologies LLC	Dismissed with prejudice.

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