IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS INSTRUMENTS INCORPORATED,
Petitioner,

v.

ADVANCED SILICON TECHNOLOGIES LLC
Patent Owner

Case No. IPR2016-01108
Patent No. 8,933,945

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

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of July 28, 2016, Petitioner Texas Instruments Incorporated and Patent Owner Advanced Silicon Technologies LLC jointly move to terminate the present *inter partes* review proceeding in light of the parties' settlement of their dispute insofar as it relates to U.S. Patent No. 8,933,945 ("the '945 patent"). The parties are filing, concurrently herewith, a true and complete copy of their written Settlement and License Agreement ("Settlement Agreement") (Confidential Exhibit 1013) in connection with this matter as required by the statute. The Settlement Agreement completely settles the parties' controversy and their dispute relating to the '945 patent as between Patent Owner and Texas Instruments Incorporated, the Petitioner and real party-in-interest in the present proceeding, who was named as a defendant in the U.S. district court litigation captioned *Advanced Silicon Technologies LLC v. Texas Instruments Incorporated*, C.A. No. 1:15-cv-1175-RGA (D. Del.) and as a repondent in an investigation before the U.S. International Trade Commission (ITC) captioned *Certain Computing or Graphics Systems, Components Thereof, and Vehicles Containing Same;* Investigation No. 337-TA-984 ("ITC Investigation"). In the ITC Investigation, the parties filed a

Joint Motion to Terminate Investigation and Stay the Procedural Schedule as to Respondent Texas Instruments Based on Settlement on July 26, 2016 (Exhibit 1014),[1] and will file a Stipulation or Notice or Dismissal in the district court litigation within two (2) business days after receipt of consideration (*see* Settlement Agreement (Confidential Exhibit 1013), para. 2.6.2 and Exhibit C).

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioner, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Settlement Agreement (Confidential Exhibit 1013) be treated as business confidential information and kept separate from the file of the '945 patent. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently herewith.

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[1] Highly Confidential Exhibit B cited in Exhibit 1014 is the same document as the "Settlement Agreement" cited in this paper as Confidential Exhibit 1013.

Termination with Respect to Inter Partes Review Proceeding

A joint motion to terminate generally "must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). Each element is addressed below:

As for requirement (1), termination is appropriate in this proceeding because the parties have settled their dispute with respect to the '945 patent, and have agreed to terminate this *inter partes* review. The applicable statute, 35 U.S.C. § 317(a), 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." In this case, the *inter partes* review has not yet been instituted. The Patent Owner's Preliminary Response to the petition has not yet been filed, and the Office has made no decision on the merits. Moreover, as recognized by the rules of practice before the Board:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a

> settlement discussion as part of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As for requirements (2) and (4), the table below identifies parties in district court litigations that involve or involved the '945 patent, and discusses the current status of these related litigations with respect to each party to the litigation. *See Heartland Tanning, Inc.,* Paper No. 26, at *2.

Case Caption	**Current Status of Each Related Litigation With Respect to Each Party to the Litigation or Proceeding**
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)	Administratively closed in view of ITC Inv. No. 337-TA-984.
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)	Administratively closed in view of ITC Inv. No. 337-TA-984.
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)	Administratively closed in view of ITC Inv. No. 337-TA-984.

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