

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioners,

v.

PARTHENON UNIFIED MEMORY ARCHITECTURE LLC,
Patent Owner.

Case No. IPR2016-01135¹
U.S. Patent No. 5,812,789

JOINT MOTION TO TERMINATE PROCEEDING

¹ Case IPR2017-00512 has been joined with this proceeding.

PETITIONERS' EXHIBIT LIST

No.	Exhibit Description
1001	U.S. Patent No. 5,812,789
1002	Prosecution History of U.S. Patent No. 5,812,789
1003	Declaration of Robert Colwell, Ph.D., Under 37 C.F.R. § 1.68
1004	Curriculum Vitae of Robert Colwell, Ph.D.
1005	U.S. Patent No. 5,546,547 to Bowes et al. ("Bowes")
1006	Texas Instruments, Inc., Houston, TX, "TMS320C8x System Level Synopsis," (September 1995) (Literature Ref. SPRU113) ("TMS")
1007	U.S. Patent No. 5, 001,625 to Thomas et al. ("Thomas")
1008	R. Gove, "The MVP: A Highly-Integrated Video Compression Chip", IEEE 1994 ("Gove")
1009	U.S. Patent No. 5,768,533 to Ran ("Ran")
1010	U.S. Patent No. 5,742,797 to Celi et al. ("Celi")
1011	Joint Claim Construction and Prehearing Statement, Parthenon Unified Memory Architecture LLC v. Apple Inc., case no. 2:15-cv-632-JRG-RSP (Feb. 16, 2016, E.D. Tex.)
1012	Decision of Institution of Inter Partes Review, Samsung Elec. Co., Ltd., et al. v. Parthenon Unified Memory Architecture LLC, IPR2015-01944 (Paper No. 7)
1013	Claim Construction Memorandum Opinion and Order, Parthenon Unified Memory Architecture LLC v. ZTE Corp. et al., No. 2:15-CV-00225 (E.D. Tex.)
1014	Claim Construction Memorandum Opinion and Order, Parthenon Unified Memory Architecture LLC v. Samsung Elecs. Co. Ltd. et al., No. 2:14-CV-00902 (E.D. Tex.)
1015	Claim Construction Memorandum Opinion and Order, Parthenon Unified Memory Architecture LLC v. HTC Corp. et al., 2:14-CV-00690 (E.D. Tex.)
1016	Claim Construction Memorandum Opinion and Order, ST Microelectronics, Inc. v. Motorola, Inc. et al., No. 4:03-CV-00276 (E.D. Tex.)

1017	“Pentium and Pentium Pro Processors and Related Products,” ISBN 1-55512-265-5
1018	Parthenon Unified Memory Architecture LLC v. Apple Inc., case no. 2:15-cv-632-JRG-RSP, Document No. 10 (June 16, 2015, E.D. Tex.)
1019	Texas Instruments, Inc., Houston, TX, “TMS320C80 to TMS320C82 Software Compatibility, User’s Guide,” (November 1995) (Literature Ref. SPRU154)
1020	Bader Declaration (including Appendix A)
1021	Declaration of Yakov Zolotorev in Support of Motion for Pro Hac Vice Admission
1022	Deposition Transcript of Dr. Mitchell A. Thornton
1023	Joint Stipulation And Motion To Dismiss (Sept. 13, 2017)
1024	Apple-PUMA Settlement Agreement (Board Only)
1025	Declaration of Curt Holbreich in Support of Motion for Pro Hac Vice Admission
1026 NEW	HTC-PUMA Written Agreement (Oct. 4, 2017)

I. Introduction

Petitioners HTC Corporation and HTC America, Inc. (“Petitioners”) and Patent Owner Parthenon Unified Memory Architecture LLC (“Patent Owner”) (collectively the “Parties”) have resolved their dispute with respect to claims 2, 7, 8, 12, and 14 of U.S. Patent No. 5,812,789 (“’789 patent”), the only claims that remain at issue in this proceeding. The Parties therefore jointly request termination of this *inter partes* review proceeding. The Board authorized the filing of this motion via email on October 5, 2017.

II. Statement of Facts

On or about June 12, 2014, Patent Owner filed Civil Action No. 2:14-cv-00690 in the U.S. District Court for the Eastern District of Texas, against Petitioners, asserting infringement of the ’789 patent (“Civil Action”). On August 23, 2016, the Board instituted an *inter partes* review of claims 1, 3-6, 11, and 13, originally requested by Apple Inc. *See* IPR2016-00923, Paper 10. On December 6, 2016, the Board instituted an *inter partes* review of claims 1-8 and 11-14 in this proceeding, also originally requested by Apple Inc. *See* Paper 7. Petitioners were joined to each proceeding after institution.

On August 4, 2017, the Board issued a Final Written Decision in IPR2016-00923 (“’923 FWD”), which found claims 1, 3-6, 11, and 13 of the ’789 patent to be unpatentable. IPR2016-00923, Paper 39 at 44. On September 22, 2017, the

Board vacated the Institution Decision in this proceeding with respect to claims 1, 3-6, 11, and 13 in light of the '923 FWD. Paper 43 at 11. As a result, claims 2, 7, 8, 12, and 14 are the only ones that remain at issue in this proceeding. *Id.*

Claims 2, 7, 8, 12, and 14, however, are not and have never been asserted by Patent Owner against Petitioners in the Civil Action. On October 4, 2017, the Parties executed a written agreement to resolve the Parties' disputes with respect to claims 2, 7, 8, 12, and 14. In short, the Parties have agreed to request termination of this proceeding and Patent Owner has agreed to grant Petitioners a covenant-not-to-sue on claims 2, 7, 8, 12, and 14 of the '789 patent. Pursuant to 37 C.F.R. § 42.74(b), the Parties' agreement is in writing, and a true and correct copy is being filed as Exhibit 1026.

The Parties' written agreement does not resolve the Parties' dispute with respect to claims 1, 3-6, 11, and 13 of the '789 patent, the claims found unpatentable in the '923 FWD. *See* Ex. 1026. On September 28, 2017, Patent Owner filed a notice of appeal of the '923 FWD, IPR2016-00923, Paper 40, which was recently docketed by the Court of Appeals for the Federal Circuit. *See* Appeal No. 17-2635 (Fed. Cir.). This appeal remains ongoing.

The Parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.

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