

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDIATEK INC. and NXP USA, INC.,  
Petitioners,

v.

BELL NORTHERN RESEARCH, LLC,  
Patent Owner.

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Case IPR2023-01414  
Patent No. 8,416,862

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**JOINT MOTION TO TERMINATE PROCEEDING AS TO PETITIONER  
MEDIATEK INC.**

Petitioner MediaTek Inc. (“MediaTek”) and Patent Owner Bell Northern Research, LLC (“BNR”) have entered into a settlement agreement that resolves all underlying disputes between Petitioner MediaTek and Patent Owner BNR, including the related district court proceeding, *Bell Northern Research, LLC v. Qualcomm Inc. et al.*, Case No. 8-23-cv-01065 (C.D. Cal) (the “CACD Litigation”), the related ITC proceeding, *In the Matter of Certain Electronic Devices and Semiconductor Devices Having Wireless Communication Capabilities and Components Thereof*, Case No. 337-TA-1367 (ITC) (the “ITC Investigation”), and this *inter partes* review proceeding IPR2023-01414, involving U.S. Patent No. 8,416,862 (the ’862 patent”), currently before the Board.

In an email dated May 23, 2024, the Board authorized the parties to file a joint motion to terminate as to Petitioner MediaTek and a joint request to treat the settlement agreement as business confidential information. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement between Petitioner MediaTek and Patent Owner BNR made in connection with, or in contemplation of, the termination of this proceeding is included with this request. The agreement ends all patent disputes between Petitioner MediaTek and Patent Owner BNR, including this IPR proceeding with respect to Petitioner MediaTek.

Petitioner MediaTek and Patent Owner BNR jointly request that the Board terminate this proceeding with respect to Petitioner MediaTek. MediaTek and Patent

Owner BNR note that granting this motion will not result in termination of the proceeding in its entirety, because Petitioner NXP USA, Inc. is not requesting termination. Pursuant to 35 U.S.C. § 317(a), “[a]n *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.” Termination is appropriate as to Petitioner MediaTek because the Board has not yet decided the merits of this *inter partes* review. Trial was instituted on April 2, 2024 [Paper 11]; however, Patent Owner BNR has not yet filed a Patent Owner’s Response and a Final Written Decision is not due until April 2, 2025, one year from institution.

The ’862 Patent is subject to the following pending lawsuits in which Petitioner MediaTek is not a party:

- *Bell Northern Research, LLC v. NXP Semiconductors NV et al.*, Case No. 1:23-cv-00633 (W.D. Tex.).
- *Bell Northern Research, LLC v. ASUSTeK Computer, Inc. et al.*, Case No. 4:23-cv-00573 (E.D. Tex.).
- *Bell Northern Research, LLC v. AT&T Inc. et al.*, Case No. 4:23-cv-00789 (E.D. Tex.).
- *Bell Northern Research, LLC v. T-Mobile USA, Inc. et al.*, Case No. 4:23-cv-00910 (E.D. Tex.).

No other party's rights would be prejudiced by the termination of this *inter partes* review as to Petitioner MediaTek. Petitioner NXP USA, Inc. does not oppose this motion and remains active in this proceeding. Accordingly, Petitioner MediaTek and Patent Owner BNR respectfully request that the Board grant this Joint Motion to Terminate as to Petitioner MediaTek.

Respectfully submitted,

Dated: May 31, 2024

/Cory C. Bell/  
Cory C. Bell, Reg. No. 75,096  
Counsel for Petitioner MediaTek, Inc.

Dated: May 31, 2024

/Jason M. Shapiro/  
Jason M. Shapiro, Reg. No. 35,354  
Counsel for Patent Owner Bell Northern  
Research, LLC

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **Joint Motion To Terminate Proceeding as to Petitioner MediaTek, Inc.** was served on May 31, 2024, via email directed to counsel of record for Patent Owner at the following:

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