

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NVIDIA CORPORATION,
Petitioner,

v.

TESSERA ADVANCED TECHNOLOGIES, INC.,
Patent Owner.

IPR2020-00708
Patent 6,317,333 B1

Before MICHAEL R. ZECHER, TREVOR M. JEFFERSON, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.72

I. DISCUSSION

On October 23, 2020, the parties filed the following documents: (1) a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72 (Paper 13, “Mot.”); (2) a true copy of an order entered in the district court case captioned *Invensas Corp. and Tessera Advanced Techs., Inc. v. NVIDIA Corp.*, No. 19-cv-861-RGA (D. Del.) (Ex. 2014, “Dismissal Order”) that dismisses with prejudice Patent Owner’s, Tessera Advanced Technologies, Inc. (“Tessera”), assertion that Petitioner, NVIDIA Corporation (“NVIDIA”), infringes U.S. Patent No. 6,317,333 B1 (Ex. 1001, “the ’333 patent”); and (3) true copies of emails memorializing the parties’ agreement to terminate this proceeding (Exs. 2011–2013). For the following reasons, we *grant* the parties’ Joint Motion to Terminate.

This trial is still in its early stages. On September 2, 2020, we entered a decision instituting an *inter partes* review of claims 1 and 2 of the ’333 patent. Paper 9. Since we entered that decision granting institution, Tessera has not yet filed a Patent Owner Response to the Petition, no discover has occurred, and we have not yet decided the merits of this proceeding.

In the Joint Motion to Terminate, the parties indicate that they “have resolved their dispute with respect to the ’333 patent, and [they] have agreed to terminate this [proceeding].” Mot. 2. The parties represent the Dismissal Order and the emails memorializing the parties’ agreement to terminate this proceeding are “true and complete copies,” and that “there are no other agreements or understandings, oral or written, between [Tessera] and [NVIDIA], including any collateral agreements, made in connection with, or in contemplation of, the termination of [this] proceeding.” *Id.* at 1.

The parties further represent that there is a related proceeding involving the ’333 patent currently pending before the Board. Mot. 3 (citing *Semiconductor*

Components Indus., LLC d/b/a ON Semiconductor v. Tessera Advanced Techs., Inc., IPR2020-01732, Papers 1 and 3 (PTAB Sept. 30 2020) (Petition and accompanying Motion for Joinder)). The parties in IPR2020-01732, however, have settled their dispute with respect to the '333 patent (IPR2020-01732, Paper 7 at 2), and we will be entering a decision granting the Joint Motion to Terminate filed in that proceeding concurrently.

Under these particular circumstances, we determine that it is appropriate to terminate this trial without rendering any further decisions. *See* 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby ORDERED that the Joint Motion to Terminate is *granted*, and this proceeding is hereby terminated.

IPR2020-00708
Patent 6,317,333 B1

For PETITIONER:

Alan A. Limbach
James M. Heintz
DLA PIPER LLP (US)
alan.limbach@us.dlapiper.com
jim.heintz@us.dlapiper.com

For PATENT OWNER:

Peter P. Chen
David A. Garr
Laura E. Muschamp
COVINGTON & BURLING LLP
pchen@cov.com
dgarr@cov.com
lmuschamp@cov.com