

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC.,
Petitioner,

v.

MEDIATEK INC.,
Patent Owner.

Case IPR2022-00759
Patent 8,464,037 B2

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner NXP USA, Inc. and Patent Owner MediaTek Inc. jointly move to terminate this *inter partes* review (IPR). The Board authorized the filing of this Joint Motion in an email dated July 14, 2022.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The parties settled their underlying dispute and reached agreement to terminate this IPR in a written settlement agreement. A true copy of the settlement agreement is submitted as Exhibit 1020 in accordance with 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(b). The parties request that the settlement agreement be treated as business confidential information, to be kept separate from the file of the involved patent, and to be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). There are no collateral agreements or understandings made in connection with the termination of this IPR.

The parties are jointly requesting dismissal of *MediaTek Inc. v. NXP Semiconductors N.V.*, C.A. No. 21-cv-04969-GW-AFM (C.D. Cal.) (the “Court Action”), which concerns U.S. Patent No. 8,464,037 B2 (the “’037 Patent”). Other than the Court Action, there are no litigation matters or proceedings between the parties involving the ’037 Patent.

No other petitioners remain in this IPR. Thus, the parties respectfully submit that termination of the IPR is appropriate under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(a).

NORTON ROSE FULBRIGHT US LLP

Dated: July 14, 2022

By: /Mark T. Garrett/

Mark T. Garrett (Reg. No. 44,699)
Lead Counsel for Petitioner

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER L.L.P.

Dated: July 14, 2022

By: /Cory C. Bell/

Cory C. Bell (Reg. No. 75,096)
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), true copies of this JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW and Exhibit 1020 are being served electronically on July 14, 2022 to the following lead and back-up counsel for Patent Owner at the following email addresses:

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