UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INTEL CORPORATION,

Petitioner,

v.

BiTMICRO LLC,

Patent Owner.

Case No.: IPR2023-00783
U.S. Patent No. 6,496,939

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(a) and 37 C.F.R. § 42.74, Petitioner Intel Corporation ("Petitioner") and Patent Owner BiTMICRO LLC ("Patent Owner") hereby jointly request that the above-referenced pending *inter partes* review be terminated. The Board authorized the filing of this motion in an email to the parties on April 3, 2024.

Good cause exists to terminate this 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 (Nov. 2019); *see also* 35 U.S.C. § 317(a) ("An *inter partes* review instituted under this chapter 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"). Here, the parties respectfully submit that termination is appropriate because they have reached an agreement resolving the dispute involving the patent at issue in the above-captioned *inter partes* review, briefing has not been completed on the issues raised in the above-captioned *inter partes* review, and the Board has not issued a final written decision or decided the merits of the proceeding. Moreover, the parties filed a Joint Stipulation for Dismissal in the United States District Court for the Northern District of California on April 2, 2024 in the underlying lawsuit

styled *BiTMICRO LLC v. Intel Corporation*, Case No. 23-cv-00625-EJD (N.D. Cal.).

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit concurrently herewith a true and correct copy of the Confidential Settlement and License Agreement governing the resolution of the *inter partes* review and underlying litigation. *See* Confidential Exhibit 2100. There are no other collateral agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

The parties are concurrently filing a joint request that the Confidential Settlement and License Agreement, Confidential Exhibit 2100, be treated as business confidential information, be kept separate from the file of the involved patents, and 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. § 42.74(c).

Dated: April 3, 2024

Respectfully submitted,

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Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on April 3, 2024 a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email addresses of record as follows:

Intel-BiTMicro-IPRService@perkinscoie.com

/Wayne M. Helge/
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