

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

MASAHIRO IIDA,
Patent Owner.

Case No. IPR2023-00864
U.S. Patent No. 6,812,737

**JOINT MOTION OF PETITIONER AND PATENT OWNER
TO TERMINATE PROCEEDING**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Patent Owner Masahiro Iida (“Patent Owner”) and Petitioner Intel Corporation (“Petitioner”) have entered into a confidential settlement agreement that resolves all underlying disputes between Patent Owner and Petitioner with respect to U.S. Patent No. 6,812,737 (“Patent-in-Suit”). A copy of the parties’ settlement agreement is being filed with this motion as Exhibit 1048 (the “Agreement”). The parties are concurrently filing a separate request that the Agreement be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Accordingly, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Patent Owner and Petitioner jointly request termination of this *inter partes* review proceeding in its entirety. The Board authorized the filing of this motion in an email dated February 8, 2024.

II. STATEMENT OF FACTS

On February 6, 2024, the parties entered into a confidential Agreement. *See* Ex.1048 (Confidential). Under the terms of the Agreement, the parties agreed to jointly seek termination of this proceeding.

II. TERMINATION IS APPROPRIATE

A. Legal Standard

35 U.S.C. § 317(a) provides that “[a]n 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.”

B. The Board Should Dismiss the Above-Captioned Proceeding

Petitioner and Patent Owner have settled their dispute regarding the Patent-in-Suit, including both this proceeding and Patent Owner’s assertion of the Patent-in-Suit in the related district court case, *Iida v. Intel Corp.*, No. 1:23-cv-00899-ADA (W.D. Tex.).¹ The parties do not anticipate further litigation between them concerning the Patent-in-Suit.

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the Patent-in-Suit. The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012). Further, the present motion is being submitted prior to a decision

¹ The district court litigation originally was assigned Case No. 6:22-cv-00662-ADA, but following transfer of the case from the Waco Division to the Austin Division of the Western District of Texas, the case was assigned Case No. 1:23-cv-00899-ADA.

on the merits. Terminating the proceedings now would serve the interests of judicial economy as well as the mutual interests of the parties.

C. A True Copy of the Parties' Settlement Agreement Has Been Filed With the Board

The parties represent that their entire agreement in connection with the termination of this proceeding is embodied in the Agreement, which has been made in writing. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.

A true and correct copy of the Agreement is filed herewith as Exhibit 1048. The Agreement has been filed for access by the "Parties and Board Only" due to the highly sensitive business confidential information it contains. The parties desire that the Agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request to treat the settlement agreement as business confidential information is being filed concurrently.

IV. CONCLUSION

Patent Owner and Petitioner have settled all disputes relating to the Patent-in-Suit. In addition, the Board has not decided the merits of the proceeding. Accordingly, the parties respectfully request that the Board terminate this proceeding in its entirety.

Respectfully submitted,

Dated: February 8, 2024

/s/ Joshua R. Slavitt

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Dated: February 8, 2024

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6(e)(4)

I hereby certify that on September 12, 2023, I will cause a copy of the foregoing document, including any exhibits filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

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