

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner.

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

JOINT MOTION TO TERMINATE

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

EXHIBITS

Exhibit No.	Description
EX1001	U.S. Pat. No. 8,416,862 to Aldana et al. (“the ’862 patent”)
EX1002	Prosecution History of the ’862 patent (Serial No. 11/237,341)
EX1003	Declaration of Dr. Jonathan Wells
EX1004	U.S. Pat. No. 7,236,748 to Li et al. (“Li-748”)
EX1005	U.S. Pub. No. 2008/0108310 to Tong et al. (“Tong”)
EX1006	U.S. Pat. No. 7,312,750 to Mao et al. (“Mao”)
EX1007	U.S. Pub. No. 2006/0092054 to Li et al. (“Li-054”)
EX1008	Yang et al., Reducing the Computations of the Singular Value Decomposition Array Given by Brent and Luk, SIAM J. MATRIX ANAL. APPL., Vol. 12, No. 4, pp. 713-725, Oct. 1991 (“Yang”)
EX1009	U.S. Pat. No. 7,710,925 to Poon (“Poon”)
EX1010	U.S. Provisional Application Serial No. 60/673,451 (“’451 provisional”)
EX1011	U.S. Provisional Application Serial No. 60/698,686 (“’686 provisional”)
EX1012	U.S. Provisional Application Serial No. 60/614,621 (“’621 Provisional”)
EX1013	U.S. Provisional Application Serial No. 60/619,461 (“’461 Provisional”)
EX1014	U.S. Patent Application Serial No. 11/168,793 (“’793 application”)
EX1015	Plaintiff Bell Northern Research, LLC’s Patent Rule 3-1 and 3-2 Disclosure of Asserted Claims and Infringement Contentions

Exhibit No.	Description
	Against the Huawei Defendants in <i>Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.</i> (Case No. 3:18-cv-1784) (S. D. Cal.)
EX1016	Defendants’ Invalidity Contentions in <i>Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.</i> (Case No. 3:18-cv-1784) (S.D.Cal.)
EX1017	Defendants’ Joint Opening Claim Construction Brief in <i>Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.</i> (Case No. 3:18-cv-1784) (S.D.Cal.)
EX1018	Plaintiff’s Opening Claim Construction Brief in <i>Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.</i> (Case No. 3:18-cv-1784) (S.D.Cal.)
EX1019	Defendants’ Memorandum of Points and Authorities in Support of Their Joint Motion for Summary Judgement on Indefiniteness in <i>Bell Northern Research, LLC, v. Huawei Device (Dongguan) Co., Ltd., Huawei Device (Shenzhen) Co., Ltd., and Huawei Device USA, Inc.</i> (Case No. 3:18-cv-1784) (S.D.Cal.)
EX1020	Transcript of Claim Construction Hearing, Day Two, Volume Two, Pages 1-122 in <i>Bell Northern Research, LLC, v. Huawei Technologies CO., LTD., Huawei Device (Hong Kong) CO., LTD., and Huawei Device USA, Inc.</i> (Case No. 3:18-cv-1784) (S.D.Cal.)
EX1021	Declaration of Sylvia Hall-Ellis
Ex1022	Claim Construction Order and Order on Motions for Summary Judgment, <i>Bell Northern Research v. Huawei Techs. Co. et al.</i> (Case No. 18-cv-1784-CAB-BLM) (S.D.Cal.)
Ex1023	Joint Claim Construction and Prehearing Statement, <i>Bell Northern Research LLC v. HMD North America, Inc. et al</i> (Case No. 1:22-cv-22706-RNS) (S.D. Fla)

Exhibit No.	Description
Ex1024	Deposition transcript of Todor Cooklev, dated September 18, 2024
Ex1025	IEEE 802.11-2016 (excerpts)
Ex1026	IEEE Standard 802.11, 1999 Ed. (R2003) (excerpts)
EX1027	IEEE Standard 802.11a-1999 supplement to 802.11-1999 (excerpts)
EX1028	Singh, et al., Wwise Proposal: High throughput extension to the 802.11 Standard (2004)
Ex1029	Mujtaba, et al., TGn Sync Proposal Technical Specification (2005)
EX1030	Supplemental Declaration of Dr. Jonathan Wells
Ex1031	Public Transcript of February 9, 2024 Deposition of Dr. Todor Cooklev in ITC proceeding 337-TA-1367
Ex1032	Confidential Settlement Agreement

Petitioner NXP USA INC., (“Petitioner NXP” or “NXP”) and Patent Owner Bell Northern Research, LLC (“Patent Owner” or “BNR”) (collectively “the parties”) have entered into an agreement (“Agreement”) that resolves all underlying disputes between the parties involving U.S. Patent No. 8,416,862 (“the ’862 Patent”). The Board previously terminated this IPR with respect to Petitioner MediaTek Inc. on June 12, 2024. *See* Paper 21. All pending related litigations between the parties have been dismissed. The Agreement is the only agreement or understanding between the parties made in connection with, or in contemplation of, the termination of this inter partes review.

In an email dated January 6, 2025, the Board authorized the parties to file (a) a joint motion to terminate and (b) a joint request to treat the Agreement as business confidential information.

As authorized, the parties jointly move that the Board terminate the above-captioned inter partes review. Pursuant to 35 U.S.C. § 317(a), “[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.” Here, termination is appropriate because the Board has not yet decided the merits of this inter partes review, as a Final Written Decision is not due until April 2, 2025, one year from institution.

No other party’s rights would be prejudiced by the termination of this inter

partes review. The parties are not aware of any other pending proceeding involving the subject patent that would be affected by the requested termination of this proceeding.

Pursuant to 35 U.S.C. 317(b) and 37 C.F.R. § 42.74(b), the parties certify that they are filing concurrently herewith, as Ex. 1032, a true copy of the Agreement between the parties related to the subject patent, and a joint request to treat that agreement as business confidential information and to keep that agreement separate from the file of the involved patent, pursuant to 35 U.S.C. 317(b) and 37 C.F.R. § 42.74(c).

The Agreement does not reference any other agreement and, in fact, is the entire agreement between the parties. Ex. 1032, 6 (“Entire Agreement”). The settlement was facilitated by a third party. The parties certify that none of the agreements with that third party is a settlement agreement or understanding entered into between the Petitioner and Patent Owner as signatories nor is it a collateral agreement that is referenced in the Agreement submitted with this joint motion. *See* Paper 10, *Axis Comm’s AB, v. Compression Vectors LLC*, IPR2021-01143, at 2 (terminating IPR based on similar certification).

In view of the above, the parties respectfully request that the Board grant the parties’ joint motion to terminate this inter partes review. The parties further request that the Board grant their joint request to treat the Agreement as business confidential information and keep it separate from the file of the involved patent.

Respectfully submitted,

Date: January 15, 2025

/s/ Brian Erickson

Brian Erickson

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Dated: January 15, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document has been served via electronic mail upon the following on January 15, 2025:

BNR-MEDIATEK-IPR@devlinlawfirm.com

Dated: January 15, 2025

Respectfully Submitted,

/Brian K. Erickson/

Brian K. Erickson, Reg. No. 48,895

Attorney for Petitioner