

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC. et al,
Petitioners,

v.

BELL SEMICONDUCTOR, LLC,
Patent Owner.

Case IPR2024-00168
Patent 7,345,245

JOINT MOTION TO TERMINATE AS TO PETITIONER

TEXAS INSTRUMENTS INCORPORATED

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

UPDATED EXHIBIT LIST

Ex. 1001	U.S. Patent No. 7,345,245
Ex. 1002	Declaration of R. Jacob Baker, PhD, PE (“Dr. Baker”)
Ex. 1003	Curriculum Vitae of Dr. Baker
Ex. 1004	File History of U.S. Patent No. 7,345,245
Ex. 1005	US Patent Pub. 2003/0183919 to Devnani et al. (“Devnani”)
Ex. 1006	US Patent Pub. 2003/0003705 to Chung, et al. (“Chung”)
Ex. 1007	US Patent No. 6,680,530 to Pillai et al. (“Pillai”)
Ex. 1008	Mobile Intel® Celeron® Processor (0.13 μ) in Micro-FCBGA and Micro-FCPGA Packages Datasheet (April 2003) (“Celeron”)
Ex. 1009	US Patent No. 6,172,305 to Tanahashi (“Tanahashi”)
Ex. 1010	Thomas D. Moore and John L. Jarvis, The effects of in-plane orthotropic properties in a multi-chip ball grid array assembly, Microelectronics Reliability, Volume 42, Issue 6, June 2002, pages 943-949 (“Moore & Jarvis”)
Ex. 1011	D.J. Xie and Z.P. Wang, Process capability study and thermal fatigue life prediction of ceramic BGA solder joints, Finite Elements in Analysis and Design, Volume 30, Issues 1-2, July 15, 1998, pages 31-45 (“Xie and Wang”)
Ex. 1012	Memorandum from Director Vidal (dated June 21, 2022)
Ex. 1013	Scheduling Order, Bell Semiconductor, LLC vs. NXP USA, INC, et al. 8:22-cv-02133-HDV-ADS (C. D. California)
Ex. 1014	Reassignment Order Scheduling Order, Bell Semiconductor, LLC vs. NXP USA, INC, et al. 8:22-cv-02133-HDV-ADS (C. D. California)

Ex. 1015	Plaintiff Bell Semiconductor, LLC Analysis of Infringement of U.S. Patent No. 7,345,245, Bell Semiconductor, LLC vs. NXP USA, INC, et al. 8:22-cv-02133-HDV-ADS (C. D. California) (May 17, 2023)
Ex. 1016	Critical Review and Technology Assessments '91-'92, Reliability Analysis Center, AD-A278 419; April 21, 1994, 452 pages ("CRTA")
Ex. 1017	2000 Packaging Handbook, Chapter 4: Performance Characteristics of IC Packages; pages 1-66, 2000 ("PCIP")
Ex. 1018	A Review of Ball Grid Arrays For Electronic Assembly, S B Dunkerton and J M Goward, Presented at ICAWT '98, The 1998 International Conference on Advances in Welding Technology - 'Joining applications in electronics and medical devices', Columbus, Ohio, USA, 30 September - 2 October 1998 ("Review of BGAs")
Ex. 1019	Order Granting Motion to Stay Pending IPR
Ex. 1020	Email dated 12 June 2024 from the Patent Trial & Appeal Board authorizing Petitioner to file a motion to supplement information pursuant to 37 C.F.R. §42.123(a)
Ex. 1021	Declaration of June Ann Munford
Ex. 1022	2nd Declaration of R. Jacob Baker, P.E., Ph.D.
Ex. 1023	Declaration of Elizabeth Jones
Ex. 1024	Effect of the drop impact on BGA/CSP package reliability, Kinuko Mishiro et al., Microelectronics Reliability 42 (2002) 77-82, 2002

Ex. 1025	Excerpt of Figure 3 of Ex. 1005-annotated
Ex. 1026	Deposition Transcript of Dr. Joseph Bernstein, dated November 7, 2024
Ex. 1101	Petitioner's <i>Sotera</i> stipulation sent to Patent Owner on June 6, 2024
Ex. 1102	Confidential Settlement Agreement between Bell Semiconductor, LLC and Texas Instruments Incorporated

Petitioner Texas Instruments Incorporated (“Petitioner TI”) and Patent Owner Bell Semiconductor, LLC (“Patent Owner”) (collectively “the parties”) have entered into a settlement agreement that resolves all underlying disputes between the parties involving U.S. Patent No. 7,345,245 (“the ’245 Patent”), including the related district court proceeding, Bell Semiconductor, LLC v. Texas Instruments Incorporated, Case No. 4:23-cv-00609, pending in the Eastern District of Texas, and the above-captioned inter partes review currently before the Board. The settlement agreement is the only agreement or understanding between Petitioner TI and Patent Owner made in connection with, or in contemplation of, the termination of this inter partes review with respect to Petitioner TI.

Petitioner TI became a party in the above-captioned inter partes review on November 1, 2024, when the Board entered a Decision in Inter Partes Review No. IPR2024-01010 granting Petitioner TI’s motion for joinder with this inter partes review. Texas Instruments Incorporated v. Bell Semiconductor, LLC, IPR2024-01010, Paper 10 (P.T.A.B. Nov. 1, 2024). The other Petitioners in this proceeding, namely NXP USA, Inc., NXP Semiconductors N.V., NXP B.V., and Freescale Semiconductor Holdings V, Inc. (“the other Petitioners”) are not requesting termination. Therefore, granting this motion will not result in termination of the proceeding in its entirety.

In an email dated January 2, 2025, the Board authorized Petitioner TI and Patent Owner to file (a) a joint motion to terminate as to Petitioner TI and (b) a joint request to treat the settlement agreement as business confidential information.

As authorized, Petitioner TI and Patent Owner jointly move that the Board terminate the above-captioned inter partes review as to Petitioner TI. 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 as to Petitioner TI is appropriate because the Board has not yet decided the merits of this inter partes review, as Patent Owner has not yet filed its Sur-Reply and a Final Written Decision is not due until May 8, 2025, one year from institution.

No other party's rights would be prejudiced by the termination of this inter partes review as to Petitioner TI. The '245 Patent is subject to the following pending lawsuit in which Petitioner TI is not a party: Bell Semiconductor, LLC v. NXP USA, Inc. et al, Case No. 8:22-cv-02133-HDV-ADS (C.D. Cal.); and the other Petitioners (NXP USA, Inc., NXP Semiconductors N.V., NXP B.V., and Freescale Semiconductor Holdings V, Inc.) do not oppose this motion and remain active in this proceeding.

Aside from the proceedings identified above, Petitioner TI and Patent Owner are unaware of any other pending related proceeding regarding the involved patent before the Board, or any other matter before the USPTO (or any other tribunal) 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), Petitioner TI and Patent Owner are filing concurrently herewith, as Ex. 1102, a true copy of the settlement agreement. The parties request that the settlement agreement between them be treated as business confidential information and be kept 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 settlement agreement is being filed as “Available only to board” to preserve the confidentiality of the agreement so that, inter alia, the other Petitioners will not have access to the agreement.

In view of the above, Petitioner TI and Patent Owner respectfully request that the Board grant the parties' joint motion to terminate this inter partes review as to Petitioner TI. Petitioner TI and Patent Owner further request that the Board grant Petitioner TI and Patent Owner's joint request to treat the settlement agreement between the parties as business confidential information and keep it separate from the file of the involved patent.

Respectfully submitted,

Dated: January 7, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on January 7, 2025, a complete and entire copy of this filing was provided by email by serving the correspondence addresses of record as follows:

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