

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 REQUEST TO TREAT SETTLEMENT AGREEMENT

AS BUSINESS CONFIDENTIAL INFORMATION

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

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 the parties made in connection with, or in contemplation of, 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.

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.

In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement between Petitioner TI and Patent Owner is being submitted concurrently herewith in this proceeding as Ex. 1102. The parties consider Exhibit 1102 to contain highly sensitive confidential business information that would substantially harm their business interests if publicly disclosed. The parties certify that, to the best of their knowledge, the settlement agreement has not been made publicly available. Because the other Petitioners are not requesting termination, the settlement agreement between Petitioner TI and Patent Owner has been filed for access by the “Board Only,” and the parties jointly request that the agreement remain available for the “Board Only.”

If requested, the rules permit the parties to have any filed settlement agreement treated as business confidential information and kept separate from the files of the involved patent. 37 C.F.R. § 42.74(c). Indeed, the statute requires it:

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to

Federal Government agencies on written request, or to any person on a showing of good cause.

35 U.S.C. § 317(b).

Accordingly, pursuant to 35 U.S.C. §317(b) and 37 C.F.R. § 42.74(c), Bell Semiconductor, LLC (“Patent Owner”) and Texas Instruments Incorporated (“Petitioner”), by and through their respective counsel of record, jointly request that the Board treat the settlement agreement filed concurrently herewith as Exhibit 1102 as business confidential information, that the agreement be kept separate from the file of the involved patent, and that the agreement be made available only to Federal Government agencies on written request, or to other persons only on a showing of good cause.

Respectfully submitted,

Dated: January 7, 2025

/Joshua A. Griswold/

Joshua A. Griswold, Reg. No. 46,310

Patrick J. Bisenius, Reg. No. 63,893

Fish & Richardson P.C.

60 South Sixth Street, Suite 3200

Minneapolis, MN 55402

T: 202-783-5070

F: 877-769-7945

*Attorneys for Petitioner Texas Instruments
Incorporated*

Dated: January 7, 2025

/Jason M. Shapiro/
Jason M. Shapiro, Reg. No. 35,354
DEVLIN LAW FIRM LLC
1526 Gilpin Ave.
Wilmington, DE 19806
Telephone: (302) 449-9010
Email: jshapiro@devlinlawfirm.co

Attorney for Patent Owner

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:

Counsel for NXP USA Inc.	
Lead Counsel	
Patricia Healy Reg. No. 73,072 Garlick & Markison 2025 Guadalupe Street, Suite 260 Austin, Texas 78705 Tel.: (512) 751-5682 Fax: (888) 456-7824 GM-NXP-Bell-IPR@texaspatents.com	
Back-up Counsel	
Bruce Garlick Reg. No. 36,520 Garlick & Markison 2025 Guadalupe Street, Suite 260 Austin, Texas 78705 Tel.: (512) 751-5682 Fax: (888) 456-7824 GM-NXP-Bell-IPR@texaspatents.com	Timothy Markison Reg. No. 33,534 Garlick & Markison 2025 Guadalupe Street, Suite 260 Austin, Texas 78705 Tel.: (512) 751-5682 Fax: (888) 456-7824 GM-NXP-Bell-IPR@texaspatents.com
Timothy Taylor Reg. No. 76,643 Garlick & Markison 2025 Guadalupe Street, Suite 260 Austin, Texas 78705 Tel.: (512) 751-5682 Fax: (888) 456-7824 GM-NXP-Bell-IPR@texaspatents.com	
Counsel for Texas Instruments Incorporated	
<u>Lead Counsel</u>	<u>Backup Counsel</u>

Joshua A. Griswold, Reg. No. 46,310 Fish & Richardson P.C. 60 South Sixth Street Suite 3200 Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 Email: IPR12189-0094IP1@fr.com	Patrick J. Bisenius, Reg. No. 63,893 Fish & Richardson P.C. 60 South Sixth Street Suite 3200 Minneapolis, MN 55402 Tel: 202-783-5070 Fax: 877-769-7945 PTABInbound@fr.com
<u>Additional Emails</u> PTABInbound@fr.com; griswold@fr.com; bisenius@fr.com.	

/Jason M. Shapiro/
Jason M. Shapiro, Reg. No. 35,354