UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK, INC. AND MEDIATEK USA, INC.,
Petitioner

v.

MOSAID TECHNOLOGIES INC.,
Patent Owner

Case No. IPR2024-00600
U.S. Patent No. 8,854,077

JOINT MOTION TO TERMINATE

PURSUANT TO 35 U.S.C. § 317

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, all parties to this proceeding, MediaTek, Inc. and MediaTek USA, Inc. ("MediaTek" or "Petitioner") and MOSAID Technologies Inc. ("MOSAID" or "Patent Owner") (collectively "the Parties"), jointly request termination of the *inter parties* review (IPR) in all pending proceedings between the Parties ("the MediaTek-MOSAID IPR Proceedings"). For the Board's convenience, it is noted that the Parties are filing a substantially identical Joint Motion in each of the four pending cases:

IPR2024-00598	Patent No. 7,051,306
IPR2024-00599	Patent No. 7,224,563
IPR2024-00600	Patent No. 8,854,077
IPR2021-00719	Patent No. 7,945,885

The Parties have resolved their disputes concerning the patents-at-issue in the proceedings above (collectively, the "Patents-at-Issue"), and pursuant to a written agreement that resolves their disputes ("License and Rights Agreement") now move to terminate this IPR. In accordance with 37 C.F.R. 42.20(b), the Parties jointly sought authorization to file this motion, and received such authorization from the Board on December 27, 2024.

Termination is proper for at least the following reasons:

- The Board has not yet "decided the merits of the proceeding ***before the request for termination is filed***." 35 U.S.C. § 317(a) (emphasis

added); 77 Fed. Reg. at 48768 ("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."). In each of the MediaTek-MOSAID IPR Proceedings, institution was only recently granted in late September or early October 2024, no due date to respond at trial to any petition has been reached, and no final decision at trial has been entered. This supports the propriety of terminating this proceeding. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012). And 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."

- The Parties are jointly requesting termination. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("There are strong public policy reasons to favor settlement between the parties to a proceeding").
- The pending related district court litigation between the Parties regarding the Patents-at-Issue is *MOSAID Technologies Inc. v. MediaTek, Inc., et al.*, No. 2:23-cv-00129 (E.D. Tex., filed Mar.

28, 2023) ("the District Court Action"), as noted in both Parties' Mandatory Notices. Pursuant to the License and Rights Agreement, the Parties have fully resolved their disputes regarding the Patents-at-Issue, and a stipulation of dismissal with prejudice is being filed in the District Court Action. Based on the above, the Parties do not anticipate any further litigation or proceeding between the Parties involving the Patents-at-Issue.

- The Parties are unaware of any other pending related proceedings regarding the Patents-at-Issue before the Board, or any other matter before the USPTO that would be affected by the requested termination of this proceeding.
- Terminations, forgoing a Final Written Decision, have long been granted even if oral argument had already taken place before the Board. *See Callidus Software Inc. v. Versata Software*, CBM2013-00052, Paper 50 (Nov. 24, 2014) (terminating proceeding after oral argument); *Clio USA, Inc. v. Procter & Gamble Co.*, IPR2013-00438, Paper 57 (Oct. 31, 2014) (same); *Volusion, Inc. v. Versata Software*, CBM2013-00017, Paper 53 (June 17, 2014) and CBM2013-00018, Paper 52 (June 17, 2014) (same).
- Pursuant to the License and Rights Agreement, the Parties are

required to seek authorization from the Board to file this Motion to Terminate and have received such authorization. MediaTek has also agreed not to voluntarily participate in this or other IPR proceedings involving the Patents-at-Issue or any other patent-at-issue in the District Court Action.

The License and Rights Agreement, Exhibit 2007, has been made in writing, and true and correct copies shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b)-(c). The Parties certify that there are no collateral agreements or understandings made in connection with or in contemplation of, the termination of these *inter partes* reviews.

For the foregoing reasons, the Parties jointly and respectfully, request that the Board terminate the instant proceeding.

Dated: December 27, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following document was served by electronic service, by agreement between the parties, on the date below:

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

The names and address of the parties being served are as follows:

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Respectfully submitted,

/ Granville C. Kaufman /

Date: December 27, 2024