

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IQE PLC,
Petitioner

v.

CORNELL RESEARCH FOUNDATION INC.,
Patent Owner

Case: IPR2024-00609
U.S. Patent No. 7,250,360

JOINT MOTION TO TERMINATE PROCEEDING

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

TABLE OF EXHIBITS

Exhibit	Description
2001	Docket Sheet, Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et. al. v. Qorvo, Inc.</i> (E.D. Tex.) (retrieved June 17, 2024)
2002	Docket Sheet, Case No. 2:24-mc-00008-RSP, <i>IQE KC, LLC v. Akoustis Technologies, Inc.</i> (E.D. Tex.) (retrieved June 17, 2024)
2003	Corporate Disclosure Statement (Dkt. 4), Case No. 2:24-mc-00008-RSP, <i>IQE KC, LLC v. Akoustis Technologies, Inc.</i> (E.D. Tex. Feb. 8, 2024) (formerly Case No. 1:24-mc-91053-AK)
2004	Notice of Subpoena and Subpoena to IQE KC, LLC, Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. Oct. 17, 2023)
2005	Qorvo’s Invalidity Contentions Cover Pleading, Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. Sept. 14, 2023)
2006	Joint Claim Construction and Prehearing Statement (Dkt. 81), Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. Apr. 30, 2024)
2007	Petition (Paper 1), IPR2024-00758; <i>Qorvo, Inc. v. Cornell Research Foundation, Inc.</i> (PTAB Apr. 17, 2024)
2008	Akoustis’ Original Complaint (Dkt. 1). Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. Apr. 20, 2023)
2009	James Richard Shealy, Cornell Engineering, <i>available at</i> https://www.engineering.cornell.edu/faculty-directory/james-richard-shealy (retrieved on June 13, 2024)
2010	Declaration of Joseph A. Smart, Ph.D., dated June 14, 2024
2011	Smart, Joseph “High Electron Mobility Transistor Structures in the Gallium Arsenide and Gallium Nitride Material Systems by

	Organometallic Vapor Epitaxy” Dissertation (2006)
2012	Cornell University Invention Disclosure (IDS)
2013	Joseph Smart Notebook
2014	Screenshot of https://catalog.hathitrust.org/Record/009236785 (retrieved on June 13, 2024)
2015	Screenshot of https://catalog.library.cornell.edu/catalog/6035819 (retrieved on June 13, 2024)
2016	RF Micro Devices to Outsource Manufacturing of Wafer Starting Material, Qorvo Financial Release (June 5 2012), <i>available at</i> https://ir.qorvo.com/news-releases/news-release-details/rf-micro-devicesr-outsource-manufacturing-wafer-starting (retrieved on June 13, 2024)
2017	Merger of RFMD and TriQuint is now Complete, Qorvo emerges as a New Leader in RF Solutions, Qorvo News (January 2, 2015), <i>available at</i> https://www.qorvo.com/newsroom/news/2015/merger-of-rfmd-and-triquint-is-now-complete (retrieved on June 13, 2024)
2018	Locations, Qorvo, <i>available at</i> https://www.qorvo.com/about-us/locations (retrieved on June 13, 2024)
2019	Akoustis’ Response to IQE’s Motion to Quash (Dkt. 19), Case No. 2:24-mc-00008-RSP, <i>IQE KC, LLC v. Akoustis Technologies, Inc.</i> (E.D. Tex. Feb. 22, 2024) (formerly Case No. 1:24-mc-91053-AK)
2020	Qorvo’s Motion to Dismiss (Dkt. 24), Case No. 2:23-cv-00180-JRQ-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. June 30, 2023)
2021	Akoustis’ Motion for Leave to File an Amended Complaint (Dkt. 84), Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. May 1, 2024)
2022	Order on Motion to Quash Subpoena (Dkt. 35), Case No. 2:24-mc-00008-RSP, <i>IQE KC, LLC v. Akoustis Technologies, Inc.</i> (E.D. Tex. May 22, 2024) (formerly Case No. 1:24-mc-91053-AK)

2023	Petitioner’s Contingent Motion for Joinder with IPR2024-00609 (Paper 3), IPR2024-00758; <i>Qorvo, Inc. v. Cornell Research Foundation, Inc.</i> (PTAB Apr. 17, 2024)
2024	UPSTO Memorandum Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
2025	Docket Sheet, Case No. 1:21-cv-1417, <i>Qorvo, Inc. v. Akoustis Technologies, et. al.</i> (D. Del.) (retrieved June 17, 2024)
2026	Defendant’s Supplemental Brief in Opposition to Plaintiff’s Motion for Leave to File an Amended Complaint to Add Cornell University and Cornell Research Foundation, Inc. as Co-Plaintiffs (Dkt. 118), Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. July 11, 2024)
2027	Updated Docket Sheet, Case No. 2:24-mc-00008-RSP, <i>IQE KC, LLC v. Akoustis Technologies, Inc.</i> (E.D. Tex.) (retrieved July 16, 2024)
2028	Confidential Settlement Agreement

Petitioner IQE PLC (“IQE” or “Petitioner”) and Patent Owner Cornell Research Foundation, Inc. (“Cornell” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, and pursuant to email authorization from the Board on December 6, 2024, IQE and Cornell jointly move to terminate the present *inter partes* review (IPR) proceeding.

I. STATEMENT OF FACTS

IQE and Cornell (collectively, the “Settling Parties”) have reached a Confidential Settlement Agreement (the “Settlement Agreement”) to resolve their disputes, including their disputes regarding the patent (U.S. Patent No. 7,250,360, “the challenged patent”) that is challenged in this proceeding. The challenged patent is also at issue in the following district court cases and PTAB proceeding: *Akoustis Techs., Inc. v. Qorvo, Inc.*, No. 2:23-cv-180 (E.D. Tex.) and *IQE KC, LLC v. Akoustis Techs., Inc.*, No. 2:24-mc-8 (E.D. Tex.) (“the District Court Litigation”); *Qorvo, Inc. v. Cornell Research Foundation Inc.*, IPR2024-00758 (PTAB) (“the Additional PTAB Litigation”). In the Settlement Agreement, the Cornell entities, the Akoustis entities, Qorvo, and IQE KC, LLC have agreed to dismiss the District Court Litigation and the Additional PTAB Litigation. Apart from the present IPR proceeding, the Additional PTAB Litigation, and the District Court Litigation, there are no other litigations or proceedings involving the challenged patent between the

parties, and no litigations or proceedings involving the challenged patent between the parties are contemplated in the foreseeable future.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 2028. Apart from the Settlement Agreement, there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this IPR proceeding. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to Treat Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b)*” is being filed concurrently with this Joint Motion to Terminate Proceeding, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “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.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Settling Parties jointly request, for the following reasons.

First, IQE and Cornell have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, IQE and Cornell have reached a settlement as to all the disputes in this proceeding and as to the challenged patent between the parties. A true copy of the Settlement Agreement is being filed concurrently herewith. *See* Confidential Exhibit 2028. IQE and Cornell request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

Third, termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a

strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, IQE and Cornell respectfully request termination of this *inter partes* review.

Dated: December 6, 2024

Respectfully submitted,

/s/ John B. Campbell

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **JOINT MOTION TO TERMINATE PROCEEDING** has been served on Petitioner via email on the following counsel of record for Petitioner:

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Dated: December 6, 2024

By: /s/ John B. Campbell
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