

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QORVO, INC.,
Petitioner

v.

CORNELL RESEARCH FOUNDATION INC.,
Patent Owner

Case: IPR2024-00758
U.S. Patent No. 7,250,360

**JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS
BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. §
317(B)**

Mail Stop “PATENT BOARD”
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.) (July 24, 2024)
2002	Intentionally Omitted
2003	Intentionally Omitted
2004	Intentionally Omitted
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	Intentionally Omitted
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	Intentionally Omitted
2023	Intentionally Omitted
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	Qorvo’s Supplemental Brief in Opposition to Plaintiffs’ 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-JRQ-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. July 11, 2024)
2027	Intentionally Omitted
2028	Joint Claim Construction Chart (Dkt. 115), Case No. 2:23-cv-00180-JRG-RSP, <i>Akoustis Technologies, Inc. et.al. v. Qorvo, Inc.</i> (E.D. Tex. Apr. 30, 2024)
2029	Petition (Paper 1), IPR2024-00609; <i>IQE PLC v. Cornell Research Foundation, Inc.</i> (PTAB Mar. 1, 2024)
2030	Confidential Settlement Agreement

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, and the Board's email of December 6, 2024, Petitioner Qorvo, Inc. ("Qorvo" or "Petitioner") and Patent Owner Cornell Research Foundation Inc. ("Cornell" or "Patent Owner") (collectively, the "Settling Parties"), which have reached a settlement, jointly request that the Board treat as business confidential information, the true and complete copy of the Confidential Settlement Agreement (Confidential Exhibit 2030, "Settlement Agreement") between the parties, as referenced in the parties' Joint Motion to Terminate Proceeding (pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74), filed concurrently herewith.

35 U.S.C. § 317(b) provides that:

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.

Likewise, 37 C.F.R. § 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of

an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

- (1) To a Government agency on written request to the Board; or*
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.*

The present request, which is being filed contemporaneously with the Settlement Agreement, is timely and in accordance with the foregoing authority. Therefore, the Settling Parties request that the Settlement Agreement (Confidential Exhibit 2030): (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) shall be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Petitioner and Patent Owner consider the Settlement Agreement to contain highly sensitive business confidential information that would substantially harm their business interests if publicly disclosed.

The Settling Parties also respectfully request that the Board inform the Settling Parties if anyone seeks production of the agreement and afford the Settling Parties an opportunity to address whether such request is supported by good cause.

Dated: December 6, 2024

Respectfully submitted,

/s/ John B. Campbell

John B. Campbell
Reg. No. 54,665
jbcampbell@mckoolsmith.com
McKOOL SMITH, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701
Telephone: (512) 692-8700
Facsimile: (512) 692-8744

James E. Quigley
Reg. No. 78,596
jquigley@mckoolsmith.com
McKOOL SMITH, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701
Telephone: (512) 692-8700
Facsimile: (512) 692-8744

George Fishback
Reg. No. 76,345
gfishback@mckoolsmith.com
McKOOL SMITH, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701
Telephone: (512) 692-8700
Facsimile: (512) 692-8744

*Counsel for Patent Owner, Cornell
Research Foundation Inc.*

/s/ Robert M. Masters

Robert M. Masters (Reg. No. 35,603)
Timothy Cremen (Reg. No. 50,855)
Jonathan R. DeFosse (*pro hac vice* to be
requested)

**Sheppard, Mullin, Richter & Hampton
LLP**

2099 Pennsylvania Ave, NW, Suite 100

Washington, DC 20006

Telephone: 202.747.1900

Facsimile: 202.747.1901

LegalTM-Qorvo-IPR@sheppardmullin.com

Counsel for Petitioner Qorvo, Inc.

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing **JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317(B)** has been served on Petitioner via email on the following counsel of record for Petitioner:

Robert M. Masters
Timothy Cremen
Jonathan R. DeFosse
LegalTM-Qorvo-IPR@sheppardmullin.com

Dated: December 6, 2024

By: /s/ John B. Campbell
John B. Campbell
Reg. No. 54,665