

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NXP USA, INC.
Petitioner, v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner.

Case: IPR2024-01044
Patent No. RE48,629

JOINT MOTION TO TERMINATE

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

INDEX OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. RE48,629
1002	U.S. Provisional Application No. 60/591,104 (“’629 July 2004 Provisional”)
1003	U.S. Patent No. 7,990,842
1004	File History of U.S. Patent No. RE48,629
1005	Declaration of Dr. R. Michael Buehrer
1006	I.E.E.E. 802.11-1999 Standard (“802.11”)
1007	MacPherson Declaration Regarding 802.11
1008	I.E.E.E. 802.11a-1999 Standard (“802.11a”)
1009	Ringle Declaration Regarding 802.11a
1010	U.S. Patent No. 7,599,332 (“Zelst”)
1011	U.S. Provisional Application No. 60/575,608 (“Zelst Provisional”)
1012	U.S. Patent No. 8,014,267 (“Boer”)
1013	U.S. Provisional Application No. 60/483,719 (“Boer Provisional”)
1014	U.S. Patent No. 7,453,793 (“Jones”)
1015	Assignment of Jones to Airgo Networks
1016	WWiSE Proposal: High throughput extension to the 802.11 Standard (“WWiSE Proposal”)
1017	Order No. 29, Construing Certain Claim Terms, ITC Inv. No. 337-TA-1367
1018	Order No. 42, Denying Respondents’ Motion for Summary Determination on Invalidity of Asserted Claims of U.S Patent No. RE48,629, ITC Inv. No. 337-TA-1367
1019	IPR2019-01174, filed 6/12/2019
1020	IPR2019-01345, filed 7/18/2019
1021	IPR2019-01437, filed 8/5/2019
1022	PO’s Infringement Claim Chart, ITC Inv. No. 337-TA-1367
1023	https://www.cnet.com/home/internet/group-proposes-faster-wi-fi-specification/ (Group Proposes Faster WiFi Specification (CNET))
1024	https://grouper.ieee.org/groups/802/11/Reports/highthroughput_update.html (Status of Project IEEE 802.11n)
1025	https://www.air802.com/ieee-802.11-standards-facts-amp-channels.html (IEEE 802.11 Standards Facts & Channels)
1026	Order No. 52: Initial Determination Granting Motion to Withdraw Complaint and Terminate Investigation as to NXP, ITC Inc. No. 337-TA-1367

Exhibit No.	Description
1027	Commission Determination Not to Review Initial Determination Granting Motion to Withdraw Complaint and Terminate Investigation as to NXP, ITC Inc. No. 337-TA-1367
1028	International Application No. PCT/US2004/021026 (“Boer PCT Application”)
1029	U.S. Provisional Application No. 60/634,102 (“’629 December 2004 Provisional”)
1030	U.S. Provisional Application No. 60/462,286 (“Jones Provisional”)
1031	U.S. Patent No. 7,646,703 (“Parent of ’629 Patent”)
1032	Confidential Settlement Agreement

Petitioner NXP USA INC., (“Petitioner NXP” or “NXP”) and Patent Owner Bell Northern Research, LLC (“Patent Owner” or “BNR”) (collectively “the parties”) have entered into an agreement (“Agreement”) that resolves all underlying disputes between the parties involving U.S. Patent No. RE48,629 (“the ’629 Patent”). All pending related litigations between the parties have been dismissed. The Agreement is the only agreement or understanding between the parties made in connection with, or in contemplation of, the termination of this inter partes review.

In an email dated January 6, 2025, the Board authorized the parties to file (a) a joint motion to terminate and (b) a joint request to treat the Agreement as business confidential information.

As authorized, the parties jointly move that the Board terminate the above-captioned inter partes review. 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 is appropriate because the Board has not yet issued a decision on institution in this inter partes review.

No other party’s rights would be prejudiced by the termination of this inter partes review. The parties are not aware of any other pending proceeding involving the subject patent 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), the parties certify that they are filing concurrently herewith, as Ex. 1032, a true copy of the Agreement between the parties related to the subject patent, and a joint request to treat that agreement as business confidential information and to keep that agreement 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 Agreement does not reference any other agreement and, in fact, is the entire agreement between the parties. Ex. 1032, 6 (“Entire Agreement”). The settlement was facilitated by a third party. The parties certify that none of the agreements with that third party is a settlement agreement or understanding entered into between the Petitioner and Patent Owner as signatories nor is it a collateral agreement that is referenced in the Agreement submitted with this joint motion. *See* Paper 10, *Axis Comm’s AB, v. Compression Vectors LLC*, IPR2021-01143, at 2 (terminating IPR based on similar certification).

In view of the above, the parties respectfully request that the Board grant the parties’ joint motion to terminate this inter partes review. The parties further request that the Board grant their joint request to treat the Agreement as business confidential information and keep it separate from the file of the involved patent.

Respectfully submitted,

Date: January 15, 2025

/s/ Brian Erickson

Brian Erickson

Reg. No. 48,895

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Dated: January 15, 2025

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document has been served via electronic mail upon the following on January 15, 2025:

DLF-BNR-NXP-629IPR@devlinfirm.com

Dated: January 15, 2025

Respectfully Submitted,

/Brian K. Erickson/

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Attorney for Petitioner