

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BLACKBERRY CORPORATION and BLACKBERRY LIMITED<sup>1</sup>  
Petitioner

v.

MOBILEMEDIA IDEAS LLC  
Patent Owner

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Case IPR2013-00016  
Patent 6,441,828

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Before KEVIN F. TURNER, JONI Y. CHANG, and  
KALYAN K. DESHPANDE, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> Real-parties-in-interest Research In Motion Corporation and Research In Motion Limited have changed their names to “BlackBerry Corporation” and “BlackBerry Limited,” respectively. Paper 22.

On October 16, 2013, a telephone conference call was held between respective counsel for the parties and Judges Turner, Chang, and Deshpande. The call was initiated jointly by the parties, requesting: (1) leave to file a joint motion to terminate the instant proceeding on the basis that the parties have reached a settlement agreement, (2) the entry of the pending motion to amend claims, (3) the settlement agreement be treated as business confidential information, and (4) the cancellation of the oral hearing on October 18, 2013.

During the conference call, the Board first provided a brief summary of the status of the proceeding and asked MobileMedia a few preliminary questions regarding the status of the original challenged claims 6, 7, 15, 17, and 18 of patent 6,441,828 (“the ’828 patent”). On March 18, 2013, the Board issued a decision (Paper 16) instituting the instant *inter partes* review as to the challenged claims based on four grounds of unpatentability under 35 U.S.C. §§ 102 and 103. In that decision, the Board determined that there is a reasonable likelihood that those challenged claims are unpatentable. Paper 16. MobileMedia did not file a patent owner response. Instead, MobileMedia filed a motion to amend, cancelling claims 6, 7, 15, 17, and 18, and proposing five substitute claims. Paper 21. Blackberry filed an opposition to MobileMedia’s motion to amend (Paper 23), and MobileMedia filed a reply to Blackberry’s opposition (Paper 24).

The Board indicated that, based on the record of this proceeding, MobileMedia appeared to concede that claims 6, 7, 15, 17, and 18 are unpatentable based on the grounds instituted. MobileMedia confirmed that

it did not contest those grounds of unpatentability. Upon further discussion, MobileMedia conceded that claims 6, 7, 15, 17, and 18 had been canceled.

Next, the Board stated that the filing of a joint motion to terminate the instant proceeding is authorized. The Board also indicated that the joint motion must include a sufficient explanation as to why termination is appropriate, especially at such a late stage when both parties already filed all of their written briefs. Under 35 U.S.C. § 317(a), the Board has the option to first terminate the proceeding with respect to Blackberry and then, with no petitioner remaining in the proceeding, proceed to a final written decision.

The parties indicated that Blackberry is not opposing MobileMedia's request for entry of the motion to amend (Paper 21). As explained by the Board during the conference call, proposed substitute claims are not entered as matter of right, even in the situation where the parties reached a settlement agreement. Notably, MobileMedia, as a movant, has the burden to show entitlement to the relief requested. 37 C.F.R. §§ 42.20(c) and 42.121. The Board will determine whether MobileMedia's motion to amend complies with the regulatory and statutory requirements. *See, e.g.*, 35 U.S.C. §§ 316(d) and 318(a).

The joint motion to terminate also must be accompanied by *a true copy* of the settlement agreement in connection with the termination of this proceeding, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

With respect to requesting that the settlement agreement be treated as business confidential information under 37 C.F.R. § 42.74(c), the Board indicated that the parties must file the confidential settlement agreement, as

Case IPR2013-00016  
Patent 6,441,828

an exhibit, electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). For more information, see FAQ G2 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

Lastly, the Board granted the parties' request for cancellation of the oral hearing.

Accordingly, it is

ORDERED that the parties are authorized to file a joint motion to terminate within five business days from the date of this Order;

FURTHER ORDERED that the joint motion must be accompanied by a true copy of the parties' settlement agreement in connection with the termination of this proceeding, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may file a separate paper requesting that the settlement agreement be treated as business confidential information as specified in 37 C.F.R. § 42.74(c);

FURTHER ORDERED that any confidential settlement agreement must be filed, as an exhibit, electronically in PRPS in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"); and

FURTHER ORDERED that the oral hearing for the instant proceeding is cancelled.

Case IPR2013-00016  
Patent 6,441,828

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