

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION; SONY CORPORATION OF AMERICA;
SONY ELECTRONICS, INC.; SONY MOBILE
COMMUNICATIONS AB; SONY MOBILE COMMUNICATIONS
(USA) INC.; SONY COMPUTER ENTERTAINMENT INC. AND
SONY COMPUTER ENTERTAINMENT AMERICA LLC
Petitioner

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner

Case IPR2014-00230
Patent 6,108,704

**SONY AND STRAIGHT PATH'S JOINT MOTION TO TERMINATE
PROCEEDING PURSUANT TO 37 C.F.R. §42.74**

Pursuant to the Patent Trial and Appeal Board's Order (Paper No. 9) entered April 28, 2014, Petitioner Sony Corporation ("Sony") and Patent Owner Straight Path IP Group, Inc. ("Straight Path") jointly request termination of *Inter Partes Review* proceeding IPR2014-00230, relating to patent U.S. Patent No. 6,108,704 (the '704 Patent), with respect to Sony pursuant to 37 C.F.R. § 42.74. No other petitioners remain in the *Inter Partes Review* proceeding, and the parties request termination of the proceeding.

Straight Path commenced litigation against Sony (and other Real Parties in Interest identified in Sony's Petition) before the International Trade Commission and in Federal District Court in *Certain Point-to-Point Network Communication Devices and Products Containing Same*, Inv. No. 337-TA-892 (U.S.I.T.C., filed Aug. 1, 2013) ("ITC Investigation") and *Straight Path IP Group, Inc. v. Sony Corp. et al.* 1:13-cv-01071-AJT (E.D. Va., filed Aug. 1, 2013) ("District Court Litigation").

Sony filed its Petition for *Inter Partes Review* of the '704 Patent on December 5, 2013. Straight Path filed a preliminary response on March 21, 2014. No decision on institution has been entered in this proceeding, and one is not expected until approximately June 21, 2014.

The Parties have now settled their dispute with respect to the '704 Patent, and have reached agreement to terminate this proceeding.

Filed concurrently herewith is a complete, true and correct copy of an agreement to settle this *Inter Partes Review* proceeding as well as to dismiss Sony (and other Real Parties in Interest) as respondents in the ITC Investigation and as defendants in the District Court Litigation. (See Exhibit 1047). The parties request that the settlement agreement be treated as business confidential information, and kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). A request for treatment of the settlement agreement as confidential business information is submitted herewith.

Sony filed two related Petitions for *Inter Partes Review* on December 5, 2013. Those proceedings are IPR2014-00229, relating to U.S. Patent No. 6,131,121 and IPR2014-00231, relating to U.S. Patent No. 6,009,469. The Parties are concurrently requesting termination of those proceedings.

The settlement agreement does not involve other parties in the Related Proceedings identified in Patent Owner's Mandatory Notices filed December 26, 2013. (Paper 7.) Accordingly, those proceedings may continue despite this settlement.

Settlement and termination of this proceeding as jointly requested by the Parties is appropriate because doing so promotes judicial economy and furthers the policy of the Board. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

CONCLUSION

Therefore, Sony and Straight Path respectfully request that Sony be dismissed from *Inter Partes* Review of U.S. Patent No. 6,108,704, Case No. IPR2014-00230 and that the proceeding be terminated.

Dated: April 28, 2014

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this Joint Motion to Terminate Proceedings was served, by agreement of the parties, by electronic mail on counsel for the Patent Owner on April 28, 2014 as follows:

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