

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Iron Dome LLC

Petitioner

v.

E-WATCH, INC.

Patent Owner

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Case IPR2014-00439

Patent 7,365,871

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JOINT MOTION TO TERMINATE PROCEEDING

PURSUANT TO 35 U.S.C. §317

Pursuant to 35 U.S.C. § 317(a), Petitioner Iron Dome LLC ("Petitioner") and Patent Owner e-Watch, Inc. ("Patent Owner") jointly request termination of IPR2014-00439, which is directed to Patent 7,365,871 (the "'871 Patent").

On August 4, 2014, the United States Patent and Trademark Office ("USPTO") issued a Decision to Institute *inter partes* review of certain claims of the '871 Patent. IPR2014-00439, Paper 16. No final written decision on the merits of this *inter partes* review proceeding has been entered and no oral hearing has been held.

The parties have settled their dispute and have reached agreement to terminate this *inter partes* review. The parties' Agreement has been made in writing.

The parties desire that the Agreement be maintained as business confidential information under 37 C.F.R. §42.74(c). A separate joint request to that effect has been filed. A true and accurate copy of the Agreement has been filed electronically via the Patent Review Processing System (PRPS) as "Parties and Board Only."

**1. Reasons Why Termination is Appropriate.**

Under 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." Because the parties are jointly requesting termination and the Office has not yet "decided the merits of the proceeding before the request for termination is filed," the USPTO is required to terminate the *inter partes* review with respect to Petitioner. Within the context of Section 317(a), a decision on the merits must be something beyond a decision instituting trial. Otherwise, the quoted phrase would be rendered meaningless because every "*inter partes* review instituted under this chapter" originates with a decision instituting trial. Here, no decision on the merits has been made. Accordingly, the USPTO is required to terminate this *inter partes* review with respect to Petitioner based on this joint request.

Petitioner supports Patent Owner's position that this *inter partes* review proceeding should be terminated with respect to Patent Owner.

Patent Owner e-Watch and Petitioner Iron Dome LLC have conferred and have mutually determined that it is in the best interest of both parties to terminate the subject case IPR2014-00439, which involves U.S. Patent No. 7,365,871 ('871 patent).

In the interest of judicial economy and in the interest of

minimizing the costs associated with this matter, it is appropriate that the subject IPR case be terminated without further action by the Board.

No decision has been rendered by the board at the present time and no oral hearing has been conducted. No interest of either party will be served by continuing the IPR case since there are no longer any adverse positions to be resolved.

Although the patent-at-issue in this IPR proceeding (i.e. the '871 patent) has been asserted against certain Defendants in civil litigation, none of these Defendants have sought to join this IPR proceeding. In addition, none of these Defendants have cited the same ground of rejection as cited in this IPR proceeding in their IPR petitions related to the '871 patent.

## 2. **Related District Court Litigations and Status Involving the '871 Patent.**

Case Name	Case No.	Court	Defendant(s)	Status
e-Watch, Inc. and e-Watch Corporation v. Apple, Inc.	13-01061	(E.D. Tex-Marshall	Apple, Inc.	Pending
e-Watch, Inc. and e-Watch Corporation v. Blackberry Limited and Blackberry Corporation	13-01078	E.D. (Tex) Marshall Div.	Blackberry Limited and Blackberry Corporation	Pending

e-Watch, Inc. and e-Watch Corporation v. HTC Corporation and HTC America, Inc.	13-01063	(E.D. Tex-Marshall Division)	HTC Corporation and HTC America, Inc.	Pending
e-Watch, Inc. and e-Watch Corporation v. Huawei Technologies Co., Ltd. and Huawei Technologies USA, Inc.	13-01076	(E.D. Tex-Marshall Division)	Huawei Technologies Co., Ltd. and Huawei Technologies USA, Inc.	Pending
e-Watch, Inc. and e-Watch Corporation v. Kyocera Communications, Inc. and Kyocera International, Inc. Technologies USA, Inc.	13-01077	(E.D. Tex-Marshall Division)	Kyocera Communications, Inc. and Kyocera International, Inc. Technologies USA, Inc.	Pending
e-Watch, Inc. and e-Watch Corporation v. LG Electronics, Inc., LG Electronics U.S.A, Inc.	13-01064	(E.D. Tex-Marshall Division)	LG Electronics, Inc., LG Electronics U.S.A, Inc.	Pending
e-Watch, Inc. and e-Watch Corporation v. Nokia Corporation and Nokia, Inc.	13-01075	(E.D. Tex-Marshall Division)	Nokia Corporation and Nokia, Inc.	Terminated

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