

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WAVEMARKET, INC. D/B/A/ LOCATION LABS

Petitioner

v.

LOCATIONNET SYSTEMS, LTD.

Patent Owner

Case IPR2014-00920
U.S. Patent 6,771,970

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. §§ 317, 327 AND 37 C.F.R. §§ 42.72, 42.74**

Pursuant to 35 U.S.C. §§ 317(a) and 327(a), as well as 37 C.F.R. §§ 42.72 and 42.74, and as authorized by the Board's e-mail dated May 12, 2015, Petitioner (Wavemarket Inc. d/b/a Location Labs) and Patent Owner (LocatioNet Systems Ltd.) (collectively, "the Parties") provide notice they have executed a settlement agreement, and now jointly request termination of the *Inter Partes* Review Case No. IPR2014-00920 involving U.S. Patent No. 6,771,970 ("the '970 Patent"). The Parties have settled their dispute, and an agreement has been reached to terminate this *inter partes* review. After the requested termination of this proceeding, dismissal of Petitioner from district court action (*Callwave Communications, LLC v. Wavemarket, Inc.*, N.D. Cal., Civil Case No. 4:14-mc-80112) and dismissal of the carrier defendants AT&T Mobility, LLC, Sprint Spectrum L.P., Sprint Communications Company L.P., and T-Mobile USA Inc. ("Carrier Defendants") from related district court actions (*Callwave Communications, LLC v. AT&T Mobility LLC, et al.*, D. Del., Civil Case No. 1:12-cv-1701, *Callwave Communications, LLC v. Sprint Spectrum L.P., Sprint Communications Company L.P., et al.*, D. Del., Civil Case No. 1:12-cv-1702, and *Callwave Communications, LLC v. T-Mobile USA, Inc., et al.*, D. Del., Civil Case No. 1:12-cv-1703), no other disputes between the Parties will remain.

As required by statute, the Parties are filing concurrently, as a separate submission, a true copy of the written settlement agreement as **Exhibit 1121**, as

well as true copies of a collateral agreement associated with settlement as **Exhibit 1122**, along with a joint request to treat **Exhibits 1121-1122** as business confidential information and to keep them separate from the file of the '970 Patent.

I. STATEMENT OF PRECISE RELIEF REQUESTED

The Parties jointly request that the Board terminate this *inter partes* review *as to both parties*, without rendering a final written decision.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

Termination of this proceeding as to both parties, without rendering a final written decision, is appropriate because (i) the trial is at a sufficiently early stage and the record is incomplete; (ii) the parties have settled their disputes in this proceeding and the related litigation; (iii) the parties to this *inter partes* review agree that it should be terminated; and (iv) public policy strongly favors settlement.

A. Termination With Respect to Petitioner

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.” 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,” termination of this proceeding with respect to the Petitioner is proper.

B. Termination With Respect to Patent Owner

Upon termination of this proceeding regarding Petitioner, no petitioner shall remain. Termination of this proceeding with respect to the Patent Owner is supported by the Petitioner and is appropriate for at least the following reasons.

1. Incomplete Record

The record in this proceeding is incomplete, and the Board has not yet decided the merits of this proceeding. Petitioner has not filed a reply brief or reply declarations to address the arguments and evidence from the Patent Owner's Response filed March 3, 2015, Patent Owner has not yet deposed any reply witnesses and has not yet filed observations on cross-examination (DUE DATE 4), neither party has filed (or responded to) a motion to exclude (DUE DATES 4–6), and no oral hearing has yet been requested or held (DUE DATE 7). The only outstanding motions before the Board are a fully briefed Motion to Seal and for Entry of Protective Order and a fully briefed Motion for Additional Discovery.

The Board has terminated, without final written decision, other *inter partes* review proceedings in which a joint motion for termination was filed following a patent owner's response and prior to a petitioner's reply. *See, e.g., Panasonic Corp. v. Optical Devices, LLC*, IPR2014-00303 , Paper 23 (Feb. 10, 2015); *Rackspace US, Inc. v. PersonalWeb Technologies, LLC*, IPR2014-00057, Paper 36 (Oct. 28, 2014); *Sealed Air Corporation v. Pregis Innovative Packaging, Inc.*,

IPR2013-00554, Paper 47 (Sept. 12, 2014); and *Xerox Corp. v. RR Donnelley & Sons Co.*, IPR2013-00529, Paper 21 (August 29, 2014). And in cases after a petitioner's reply. *See Apex Medical Corp. v. ResMed Limited*, IPR2013-00512, Paper 39 (Sept. 3, 2014).

2. No Further Participation by Petitioner

Petitioner informs the Board that Petitioner will file no reply papers in this proceeding, will not attend any oral hearing in this proceeding, will oppose no motions to exclude in this proceeding, and will not further participate further in this proceeding before the Board. Petitioner supports the termination of this *inter partes* review regarding Patent Owner.

Because the record is incomplete and will not be further developed, termination with respect to all parties is favored. Patent Owner notes that absent a Petitioner, it is unclear how these proceedings could properly proceed. Under these circumstances, there is every reason to honor the Parties' wishes to terminate *as to both parties* without final written decision.

3. Maintaining this Inter Parties Review Would Discourage Settlements and Waste Judicial Resources

Congress and federal courts have expressed a strong interest in encouraging settlement of disputes. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.