

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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T-MOBILE USA, INC. and T-MOBILE US, INC.,  
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,  
Patent Owner

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Case IPR2014-01035  
Patent No. 5,659,891

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**JOINT MOTION TO TERMINATE PROCEEDING  
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a), T-Mobile USA, Inc. and T-Mobile US, Inc. (“T-Mobile” or Petitioner) and Mobile Telecommunications Technologies, LLC (“Patent Owner”) (jointly, the “Parties”) jointly request termination of IPR2014-01035, which is directed to U.S. Patent No. 5,659,891 (the “’891 Patent”).

On June 27, 2014, Apple Inc. (“Apple”) filed a Petition for *Inter Partes* Review (“Apple IPR” – which is the above-captioned *Inter Partes* Review, *i.e.*, IPR2014-01035) before the United States Patent Trial and Appeal Board (“the Board”). Patent Owner’s preliminary response was filed on October 24, 2014. On January 22, 2015, the Board issued a Decision to Institute *inter partes* review of the ’891 Patent in the Apple IPR. Paper 10.

On October 3, 2014, T-Mobile filed a Petition for *Inter Partes* Review (“T-Mobile IPR”) before the Board (assigned IPR2015-00018). Patent Owner’s preliminary response was filed on January 15, 2015 in the T-Mobile IPR. On April 8, 2015, the Board issued a Decision to Institute *inter partes* review of the ’891 Patent in the T-Mobile IPR and to join the Apple IPR and T-Mobile IPR (“Joined *Inter Partes* Review” – which is also the above-captioned *Inter Partes* Review, *i.e.*, IPR2014-01035). Paper 13 of the T-Mobile IPR, *i.e.*, IPR2015-00018. *See also*, paper 16 of the Apple IPR, *i.e.*, IPR2014-01035.

On April 22, 2015, Apple and Patent Owner filed a Joint Motion to Terminate with respect to Apple, paper 14. On April 27, 2015, the Board issued a

decision granting the Joint Motion to Terminate with respect to Apple, paper 17.

Patent Owner has not filed a response, and one is not due (by stipulation of Petitioner and Patent Owner, paper 13) until June 21, 2015. No final written decision on the merits of this *inter partes* review proceeding has been entered. The Parties have settled their dispute, and have reached agreement to terminate this *inter partes* review.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed.Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized the filing of the instant Motion in an email dated May 19, 2015. IPR2013-00428, Paper No. 56 provides guidance as to the content of a motion to terminate. There, the Board indicates that a joint motion, such as this one, should (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue, and the status of each; and (3) identify any related proceedings currently before the Office. IPR2013-00428, Paper No. 56 at 2. This Motion satisfies each of the above requirements.

Indeed, the Parties have entered into a Settlement Agreement, and a true copy of the same is attached hereto as Exhibit 2003, as required by 35 U.S.C. §

317(b) and 37 C.F.R. § 42.74(b).<sup>1</sup> The Parties desire that the Settlement Agreement (Exhibit 2003) be maintained as business confidential information under 37 C.F.R. §42.74(c) and a separate joint request to that effect is being filed on even date herewith.

### **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.” With respect to T-Mobile, termination is appropriate because a final written decision has not been reached in this Review. Indeed, Patent Owner has not yet filed its Response, nor has T-Mobile filed responsive papers. Termination of this proceeding with respect to T-Mobile is further appropriate because, if this Motion is granted, T-Mobile will not be participating as a party in this proceeding going forward. To this point, the Parties have settled their dispute and executed the earlier-referenced Settlement Agreement to terminate this proceeding as to T-Mobile, as well as the Parties’ related district court litigation. The Parties agree that this district court litigation

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<sup>1</sup> The Settlement Agreement is being filed electronically via the Patent Review Processing System (PRPS) as “Board Only.”

will be dismissed per the Parties' Settlement Agreement. For all these reasons, the Parties respectfully request termination of this proceeding with respect to T-Mobile.

Moreover, Petitioner, T-Mobile, does not oppose Patent Owner in seeking termination of this *inter partes* review proceeding altogether.

Because § 317(a) indicates that the USPTO is not required to terminate an *inter partes* review when no petitioner remains in the proceeding, Patent Owner provides its own additional comments as to why termination with respect to Patent Owner is proper in *Patent Owner's Explanation as to Why Termination Is Appropriate*, attached hereto as Exhibit 2004.

**2. All parties in any pending related litigation involving the patents at issue, and current status of each such related litigation.**

Petitioner is not involved in any other pending related litigations involving the '891 Patent. Other parties involved in litigations related to the '891 Patent are identified in the table that follows.

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