

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE, INC.,
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-00343 (Patent 8,640,179 B1)
Case IPR2015-00345 (Patent 8,205,237 B2)
Case IPR2015-00347 (Patent 8,010,988 B2)
Case IPR2015-00348 (Patent 8,656,441 B1)¹

Before KEVIN F. TURNER, LYNNEE. PETTIGREW, and
JON B. TORNQUIST, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

ORDER
Termination of Proceedings after Remand
35 U.S.C. § 317

¹ We use this caption to indicate that this Order applies to, and is entered in, all four proceedings.

IPR2015-00343 (Patent 8,640,179 B1)
IPR2015-00345 (Patent 8,205,237 B2)
IPR2015-00347 (Patent 8,010,988 B2)
IPR2015-00348 (Patent 8,656,441 B1)

We entered Final Written Decisions in these cases on June 20, 2016. IPR2015-00343, Paper 30; IPR2015-00345, Paper 30; IPR2015-00347, Paper 30; IPR2015-00348, Paper 30. In our decisions, we concluded, *inter alia*, that Petitioner, Google, Inc., had not shown by a preponderance of the evidence that the following claims are unpatentable:

Case	Patent	Claims
IPR2015-00343	8,640,179 B1 ("the '179 patent")	1–3, 6, 8–14, 18, 19, 21–27, 29–31, and 34–37
IPR2015-00345	8,205,237 B2 ("the '237 patent")	25–27, 29, and 30
IPR2015-00347	8,010,988 B2 ("the '988 patent")	15, 16, 21–28, 31–33, 38, 51, and 52
IPR2015-00348	8,656,441 B1 ("the '441 patent")	1–3, 6, 8–14, 18, 19, 21–27, 29, and 30

Petitioner appealed our decisions regarding these claims to the United States Court of Appeals for the Federal Circuit.² The Federal Circuit vacated our final decisions with respect to all claims at issue on appeal and remanded to the Board for consideration of patentability based on a modified construction

² In IPR2015-00345, we also concluded Petitioner had not shown that claims 1–8, 21, 22, 33–35, 37, and 38 of the '237 patent are unpatentable. Petitioner did not appeal our decision with respect to those claims. We further concluded in IPR2015-00345 that Petitioner had shown that claims 9–16, 23, and 24 of the '237 patent are unpatentable. Patent Owner, Network-1 Technologies, Inc., did not appeal that part of our decision. Finally, in IPR2015-00347, we also concluded Petitioner had not shown that claim 17 of the '988 patent is unpatentable. Petitioner did not appeal that determination.

IPR2015-00343 (Patent 8,640,179 B1)
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of the claim term “non-exhaustive search.” *Google LLC v. Network-1 Techs., Inc.*, 726 Fed. App’x 779 (Fed. Cir. 2018).

On December 21, 2018, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceedings under 35 U.S.C. § 317(a) in each of these four proceedings, requesting termination of the proceedings with respect to the claims remaining after remand. IPR2015-00343, Paper 38 (“Mot.”); IPR2015-00345, Paper 37; IPR2015-00347, Paper 37; IPR2015-00348, Paper 37.³ The parties also filed a true copy of a Joint Stipulation entered into by and between the parties. Ex. 1023.⁴

In the Joint Motion, the parties represent that

[o]ther than as indicated in the Joint Stipulation, there are no written or oral agreements or understandings, including any collateral agreements, between the parties, including but not limited to licenses, covenants not to sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of this proceeding.

Mot. 1–2. Under the terms of the Joint Stipulation, Patent Owner covenants not to sue Petitioner for infringement of the claims of the ’179 patent, the ’237 patent, the ’988 patent, and the ’441 patent remaining in these proceedings after remand (i.e., the claims identified in the table above).

Ex. 1023, 3–4.

³ The parties filed similar motions in each of the four proceedings. For convenience, we cite to the motion filed in IPR2015-00343, unless otherwise noted.

⁴ The Joint Stipulation was filed as Exhibit 1023 in each proceeding.

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Under 35 U.S.C. § 317(a), an *inter partes* review “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.” We have not issued decisions on remand and thus have not decided the merits of the remanded proceedings. Under 35 U.S.C. § 317(b), the parties must file any agreement between the parties, including any collateral agreements referred to in such agreement, made in connection with or in contemplation of the termination of an *inter partes* review. The Joint Stipulation entered into by the parties and filed in these proceedings satisfies this requirement. Accordingly, we determine it is appropriate to terminate these proceedings without rendering decisions on remand.

It is:

ORDERED that the Joint Motions to Terminate Proceedings under 35 U.S.C. § 317 are *granted*; and

FURTHER ORDERED that IPR2015-00343, IPR2015-00345, IPR2015-00347, and IPR2015-00348 are *terminated*.

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IPR2015-00345 (Patent 8,205,237 B2)
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