

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

NETWORK-1 TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-00345
U.S. Patent No. 8,205,237

**JOINT MOTION TO TERMINATE PROCEEDINGS
UNDER 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorizing order, Petitioner Google LLC and Patent Owner Network-1 Technologies, Inc., jointly request termination of this proceeding with respect to claims 25-27, 29, and 30 (the "Remaining Claims").

The parties have resolved their dispute as described in the Joint Stipulation by the parties filed herewith as Exhibit 1022. Other 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. *See, e.g., General Growth Properties, Inc. et al. v. Peschke*, IPR2013-00400, Paper 35 at 2-3 (Apr. 9, 2014).

Termination of this proceeding is proper under 35 U.S.C. § 317(a). Pursuant to the decision of the U.S. Court of Appeals for the Federal Circuit in *Google LLC v. Network-1 Techs., Inc.*, 726 F. App'x 779, 786 (Fed. Cir. 2018), the decision of the Board in this proceeding has been vacated with respect to the Remaining Claims and, with respect to those claims, has been “remanded to the Board for consideration of patentability based upon the [Federal Circuit’s] claim construction.” In light of the Federal Circuit’s vacatur, the USPTO has not, with respect to the Remaining Claims, “decided the merits of the proceeding before [this] request for termination [was] filed.” 35 U.S.C. § 317(a). Therefore, this request for termination is proper. The only related proceedings in the USPTO are IPR2015-00343, IPR2015-00347, and IPR2015-00348, which involve U.S. Patent Nos. 8,640,179, 8,010,988, and 8,656,441, respectively. The parties are concurrently requesting termination of those three proceedings with respect to their remanded, remaining claims as well. Thus, other than proceedings the parties seek to terminate, there are no related inter partes review proceedings or other proceedings before the USPTO involving the ‘237 patent. Accordingly, the parties

respectfully request termination of this proceeding. For the avoidance of doubt, the United States Patent and Trademark Office issued an Inter Partes Review Certificate on February 16, 2018 cancelling claims 9-16, 23, and 24 of U.S. Patent No. 8,205,237 (the “Cancelled Claims”), and the parties agree that this joint motion shall have no effect on the legal status of those Cancelled Claims.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with the filing to Deposit Account 501710 (Customer ID No. 27160).

Dated: December 21, 2018

Respectfully submitted,

/David M. Krinsky/

David M. Krinsky (Reg. No. 72,339)

Christopher A. Suarez (Reg. No.
72,553)

WILLIAMS & CONNOLLY LLP

725 Twelfth Street, N.W.

Washington, DC 20005

(202) 434-5000

Attorneys for Petitioner

/Charles R. Macedo/

Charles R. Macedo (Reg. No. 32,781)

AMSTER, ROTHSTEIN &
EBENSTEIN LLP

90 Park Avenue

New York, NY 10016

(212) 336-8000

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned *Joint Motion to Terminate Proceedings Under 35 U.S.C. § 317(a)*, along with Exhibit 1022, was served on December 21, 2018 by filing this document through the Patent Review Processing System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner and Patent Owner:

Charles R. Macedo
Reg. No. 32,781

David M. Krinsky
Reg. No. 72,338
Christopher A. Suarez
Reg. No. 72,553

AMSTER, ROTHSTEIN
& EBENSTEIN LLP
90 Park Avenue
New York, NY 10016

WILLIAMS & CONNOLLY LLP
725 Twelfth Street, NW
Washington, D.C. 20005

cmacedo@arelaw.com

dkrinsky@wc.com
csuarez@wc.com

Dated: December 21, 2018

Respectfully submitted,

/David M. Krinsky/
David M. Krinsky (Reg. No. 72,339)
Christopher A. Suarez (Reg. No. 72,553)
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005
(202) 434-5000

Attorneys for Petitioner