

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC. AND MICROSOFT MOBILE OY
Petitioner

v.

E-WATCH, INC.
Patent Owner

Case IPR2015-00404
Patent 7,365,871

**JOINT MOTION TO TERMINATE WITH RESPECT TO MICROSOFT
MOBILE OY, MICROSOFT CORPORATION, AND NOKIA INC.
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

EXHIBIT

E-WATCH 2001 Confidential Settlement and License Agreement

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a)-(b), Petitioner Microsoft Mobile OY (“MMO”) and Real Parties in Interest, Microsoft Corporation and Nokia Inc. (collectively “the Microsoft/Nokia parties”) and Patent Owner e-Watch, Inc. (“e-Watch”) jointly request termination of the *Inter Partes* Review (IPR) of U.S. Patent No. 7,365,871, Case No. IPR2015-00404 with respect to the Microsoft/Nokia parties. The Microsoft/Nokia parties and e-Watch are collectively referred to herein as “Parties” and individually as a “Party.” The Parties agree that each Party shall bear its own fees and expenses.

Termination of this proceeding as to the Microsoft/Nokia parties is appropriate, as the Parties have agreed to settle their dispute. Moreover, this review is in its early stages. MMO jointly filed a petition with LG Electronics, Inc. (“LGE”) for IPR on December 10, 2014, which included the designation of the Microsoft/Nokia parties as real parties in interest. e-Watch has yet to file a Preliminary Patent Owner Response and the IPR has yet to be instituted. As a result, e-Watch has not filed any substantive papers or declarations.

The applicable statute, 35 U.S.C. § 317(a), provides that an *inter partes* review proceeding “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.” (emphasis added).

In this case, the *inter partes* review has not been instituted. Thus, the Office has not yet reached any decision on the merits of the proceeding. Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding, *see* Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012), and no public interest or other factors militate against termination of this proceeding with respect to the Microsoft/Nokia parties.

The Microsoft/Nokia parties and e-Watch have agreed to settle their dispute and have reached an agreement to terminate this review as to the Microsoft/Nokia parties. The Settlement Agreement between e-Watch and the Microsoft/Nokia parties has been made in writing and is filed separately as Exhibit 2001. The Settlement Agreement is being filed concurrently with a Joint Request to Treat Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317 (b) and 37 C.F.R. § 42.74 (c). There are no collateral agreements referred to in the Parties’ Settlement Agreement. As stated in 35 U.S.C. § 317(a), because the Microsoft/Nokia parties and e-Watch jointly request this termination, it is understood that no estoppel under 35 U.S.C. § 315(e) shall attach to the Microsoft/Nokia parties. As provided in 37 C.F.R. § 42.73(d)(3), because no

adverse judgment has been entered, it is also understood that, as to e-Watch, no estoppel under 37 C.F.R. § 42.73(d)(3) shall attach to e-Watch.

On January 23, 2015, the Microsoft/Nokia parties and e-Watch advised the Board that they have reached a settlement, and sought authorization to file a joint motion to terminate the proceeding as to the Microsoft/Nokia parties. The Board held a conference call with the parties on January 23, 2015. On January 23, 2015, the Board authorized the filing of a joint motion to terminate this proceeding as to the Microsoft/Nokia parties. Per the Board's January 23, 2015 authorization order, the Microsoft/Nokia parties and e-Watch understood that they were also to file a separate paper requesting that the Settlement Agreement be treated as business confidential information as specified in 37 C.F.R. § 42.74(c) and that the Settlement Agreement was to be filed in PRPS under the designation of "Board and Parties Only."

Wherefore, the Microsoft/Nokia parties and e-Watch respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 7,365,871, Case No. IPR2015-00404 as to the Microsoft/Nokia parties.

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