

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON SERVICES CORP., VERIZON SOUTH INC., VERIZON VIRGINIA
LLC, VERIZON COMMUNICATIONS INC., VERIZON FEDERAL INC.,
VERIZON BUSINESS NETWORK SERVICES INC., AND MCI
COMMUNICATIONS SERVICES, INC.
Petitioners,

v.

SPHERIX INCORPORATED
Patent Owner.

Case IPR2015-01381
Patent No. 6,980,564

JOINT MOTION TO TERMINATE THE PROCEEDING

AND

**JOINT REQUEST TO TREAT SETTLEMENT
AGREEMENT AS BUSINESS CONFIDENTIAL
UNDER 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioners Verizon Services Corp., Verizon South Inc., Verizon Virginia LLC, Verizon Communications Inc., Verizon Federal Inc., Verizon Business Network Services Inc., and MCI Communications Services, Inc. (collectively “Petitioners”) and Patent Owner Spherix Incorporated (“Patent Owner”) jointly request termination of the *inter partes* review of U.S. Patent No. 6,980,564, Case IPR2015-01381, based on a settlement between Petitioners and Patent Owner.

II. REASONS FOR GRANTING THE MOTION

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 joint motion and request on September 3, 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 patent at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements and is

accompanied by a true copy of the Parties' fully-executed settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

a. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because the Parties have settled their dispute and this *inter partes* review has not been instituted. Petitioners filed their petition for *inter partes* review on June 11, 2015. Patent Owner has not filed a preliminary response, and one is not due until September 17, 2015. The Parties have settled their dispute, and have reached agreement to terminate this *inter partes* review proceeding, as well as the Parties' related district court litigation regarding the '564 patent: *Spherix Incorporated v. Verizon Services Corp., Verizon South Inc., Verizon Virginia LLC, Verizon Communications Inc., Verizon Federal Inc., Verizon Business Network Services Inc., MCI Communications Services, Inc.*, Civil Action No. 1:14-cv-721-GBL-TCB (E.D. Virginia). There is no other pending litigation involving the '564 patent.

b. All Parties in Any Pending Related Litigation Involving the Patent at Issue

As noted above in Section II.a, Petitioners and Patent Owner are parties in a related district court litigation, which the parties also have settled.

c. Related Proceedings Currently Before the Office

Aside from this *inter partes* review proceeding, the '564 patent is not involved in any other proceeding currently before the Office.

d. Current Status of Each Such Related Litigation or Proceeding With Respect to Each Party to the Litigation or Proceeding

Sections II.a and b above indicate that the Parties have settled their dispute in the related district court litigation.

III. SETTLEMENT AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' Settlement Agreement has been made in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1010.¹

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and the Board's authorization of the filing of this joint request in its email to the Parties on September 3, 2015, the Parties jointly request that the true copy of the Settlement Agreement filed concurrently herewith as Exhibit 1010 be treated as business confidential information, which shall be kept separate from the file of U.S. Patent No. 6,980,564. The Parties further request the Board to not make Exhibit 1010 available to any third party, except as provided for in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

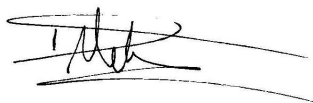
¹ The Settlement Agreement is being filed via the Patent Review Processing System (PRPS) with access to "Parties and Board Only."

IV. CONCLUSION

For all of these reasons, Petitioners and Patent Owner respectfully request termination of the *inter partes* review of U.S. Patent No. 6,980,564, Case IPR2015-01381.

As stated in 35 U.S.C. § 317(a), because Petitioners and Patent Owner request this termination as to Petitioners, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioners.

Respectfully submitted,



DATED: September 10, 2015

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