

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC,
Patent Owner

Case No. IPR2015-01709
Patent 7,525,484

JOINT MOTION TO TERMINATE PROCEEDINGS

I. Statement of the Precise Relief Requested.

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74 and an email authorizing this motion,¹ Petitioners T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson (collectively “Petitioners”) and Patent Owner TracBeam, LLC (“Patent Owner”) jointly request that the Board Terminate this *Inter Partes* Review of U.S. Patent No. 7,525,484 (“the ‘484 patent”).

II. Statement of Facts.

Petitioners filed this Petition for *Inter Partes* Review on August 11, 2015, requesting review of certain claims the ‘484 patent.

This proceeding is still in its preliminary stages. The Board has yet to decide whether to institute a trial.

¹ Email from Maria Vignone, Paralegal Operations Manager, Patent Trial and Appeal Board, to Sean Luner and others, respective counsel for Patent Owner and Petitioners (November 17, 2015).

The T-Mobile Petitioners and Patent Owner are parties in a litigation involving the '484 patent in the United States District Court for the Eastern District of Texas, *TracBeam, LLC v. T-Mobile US, Inc. et al.*, Case No. 6:14-cv-00678.²

On November 16, 2015, all Petitioners and Patent Owner executed a *Narrowing Agreement*, in which they agreed to limit the issues in dispute in both the District Court litigation and in multiple *Inter Partes* Reviews, by, among other things, agreeing to file this Motion to Terminate.

Concurrent with this *Joint Motion to Terminate* in this proceeding, pursuant to the *Narrowing Agreement*, the Patent Owner and Petitioners are also filing:

(a) *Joint Motions to Terminate* in the following proceedings:

- IPR2015-01682;
- IPR2015-01684; and
- IPR2015-01686;

(b) *Joint Motions to Limit Petition* in the following proceedings:

² The District Court litigation also involves U.S. Patent Nos. 7,764,231, 7,298,327, and 8,032,153. Petitioners filed Petitions for *Inter Partes* Review concerning each of these patents. See IPR2015-01681, IPR2015-01682, IPR2015-01684, IPR2015-01686, IPR2015-01687, IPR2015-01709, IPR2015-01711, IPR2015-01712, and IPR2015-01713.

- IPR2015-01681 limited to claims 25 and 82;
- IPR2015-01687 limited to claims 17, 20, and 25;
- IPR2015-01708 limited to claims 1, 25, and 51;
- IPR2015-01711 limited to claim 27;
- IPR2015-01712 limited to claims 1, 2, 44, and 60; and
- IPR2015-01713 limited to claims 1, 3, and 15.

III. Argument.

A. Termination of this *Inter Partes* Review proceeding is Appropriate.

The parties respectfully submit that the Board should terminate this proceeding for the following reasons:

- (i) this proceeding is in the preliminary stages;
- (ii) the parties have resolved their dispute as to all issues in this proceeding;
- (iii) the issues addressed in this proceedings will be removed from the District Court litigation between the parties;
- (iv) other *Motions to Terminate* and *Motions to Limit Petition* are being filed in the related IPRs involving the same parties;
- (v) the parties agree that this *inter partes* review proceeding should be terminated; and

(vi) under the *Narrowing Agreement*, Petitioners agreed that they will not participate in this IPR proceeding if this Motion to Terminate is not granted and the proceeding is instituted.

Narrowing the issues between the Petitioner and Patent Owner and terminating this proceeding will serve to both conserve judicial resources and facilitate the Board's goal of resolving *inter partes* review in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b).

B. A Copy of the Narrowing Agreement is Provided.

The *Narrowing Agreement* has been executed in writing. A true copy is filed along with this Motion, as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, as Exhibit 2001.

A Joint Request to File an Agreement as Business Confidential Information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 is also being filed along with this Motion.

C. Summary.

For the foregoing reasons, Petitioners and Patent Owner respectfully request that the Board terminate this proceeding.

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