

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.

IPR2015-01682 (Patent 7,764,231)¹
IPR2015-01684 (Patent 7,764,231)
IPR2015-01686 (Patent 7,764,231)
IPR2015-01709 (Patent 7,525,484)

Before KEVIN F. TURNER, RICHARD E. RICE, DAVID C. MCKONE,
JAMES A. TARTAL, BARBARA A. PARVIS, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

DECISION
Joint Motions to Terminate
37 C.F.R. § 42.71

¹ The parties are not authorized to use this case caption, or to file consolidated papers.

On November 24, 2015, the parties filed a Joint Motion to Terminate Proceedings in each of the above cited proceedings, as well as a Joint Submission of Narrowing Agreement in each (IPR2015-01682, Papers 8 and 9; IPR2015-01684, IPR2015-01686, and IPR2015-01709, Papers 6 and 7, in each proceeding), with joint requests to treat as confidential the submitted Narrowing Agreement (Exhibit 2001, in each proceeding).²

Under 35 U.S.C. § 317(a), applicable to *inter partes* review proceedings, a 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. These matters are in the preliminary stage. Patent Owner has not filed Preliminary Responses in any of the indicated cases, and decisions whether to institute trial have not been issued in any of the cases.

Under 35 U.S.C. § 317(b), any agreement or understanding between the Patent Owner and a Petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding, shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. The Narrowing Agreement appears to be a true copy of the agreement between the parties, specifies all of the affected Petitions, and identifies the claims that will continue to be asserted in the infringement action between the parties, limiting the set of claims previously asserted to be infringed. Ex. 2001. None of the identified claims are the subject of the Petitions in the proceedings that the parties seek to terminate.

² The Motions and supporting documents are substantially identical in each case. Thus, for ease of reference we will refer to the filings in IPR2015-01682.

Under these circumstances, we determine that it is appropriate to dismiss the Petitions. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is

ORDERED that the Joint Motions to Terminate Proceedings, filed in IPR2015-01682, IPR2015-01684, IPR2015-01686, and IPR2015-01709, are GRANTED; and

FURTHER ORDERED that the Narrowing Agreement, Exhibit 2001, be treated as business confidential information, be designated “Board Only,” and be kept separate from the files of the involved patents.

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