

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.  
Petitioner

v.

SILVER STATE INTELLECTUAL TECHNOLOGIES, INC.  
Patent Owner

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Case IPR2015-01738

U.S. Patent No. 7,650,234

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**JOINT MOTION TO TERMINATE PROCEEDING**

## **I. PRECISE RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317(a), Petitioner Google Inc. and Patent Owner Silver State Intellectual Technologies, Inc. jointly request that this *inter partes* review proceeding involving U.S. Patent No. 7,650,234 (“the ’234 Patent”) be terminated based on a settlement between Petitioner and Patent Owner (“the Parties”).

## **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 motion on October 14, 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 (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office, and (d) 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 copy of the Parties’ 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 a final written decision has not been reached in this proceeding. Indeed, Petitioner filed its petition for *inter partes* review recently on August 17, 2015. Patent Owner has not yet filed any preliminary response, nor has the Board instituted this proceeding.

Termination of this proceeding is appropriate because Petitioner will no longer be participating in this proceeding, and the Board has not decided the merits of the proceeding. The Parties have settled their disputes and executed a settlement agreement to terminate this proceeding, as well as the Parties' related district court litigation regarding the '234 Patent: *Silver State Intellectual Techs., Inc. v. Google Inc.*, Case Number 2:14-cv-00662 (D. Nev.). The district court litigation was dismissed per the parties' settlement agreement on October 1, 2015.

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

In addition to Google Inc., Motorola Mobility, LLC and Waze, Inc. are defendants in the related district court litigation. The settlement agreement to terminate the district court litigation includes termination as to Motorola Mobility, LLC and Waze, Inc.

**c. Related Proceedings Currently Before the Office**

There is no other pending *inter partes* review proceeding involving the '234 Patent.

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

Sections II.b and c above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding.

**III. SETTLEMENT AGREEMENT**

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1012.<sup>1</sup> The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the settlement agreement as business confidential information and keep it separate from the files of the '234 Patent.

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<sup>1</sup> The settlement agreement is being filed via the Patent Review Processing System (PRPS) with access to the "Parties and Board only."

**IV. CONCLUSION**

For all of these reasons, the Parties respectfully request termination of this proceeding.

Respectfully submitted,

Dated:

By: /Frederick S. Berretta/

By: /Naveen Modi/

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