

Paper No. \_\_\_\_\_  
Filed: August 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZTE USA, Inc.  
Petitioner

v.

Parthenon Unified Memory Architecture LLC  
Patent Owner

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Case IPR2016-00664  
Patent No. 5,812,789

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**JOINT MOTION TO TERMINATE PROCEEDING**

## **I. PRECISE RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317(a) and the Board's authorization of the filing of this joint motion in its email to the parties on August 18, 2016, Petitioner ZTE USA, Inc. ("ZTE") and Patent Owner Parthenon Unified Memory Architecture LLC ("PUMA") jointly request that this *inter partes* review proceeding involving U.S. Patent No. 5,812,789 ("the '789 Patent") be terminated based on a settlement between ZTE 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 August 18, 2016. 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 and ZTE will no longer be participating in this 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 '789 Patent: *Parthenon Unified Memory Architecture LLC v. ZTE Corp. et al.*, Case Number 2:15-cv-00225 (E.D. Tex.). The district court litigation was dismissed with prejudice on August 5, 2016.

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

ZTE, ZTE (TX) Inc., ZTE Corp., and PUMA are the only Parties to the related district court litigation, Case Number 2:15-cv-00225. The '789 patent is also at issue in other pending litigation. In *Parthenon Unified Memory Architecture LLC v. HTC Corp. et al.*, Case Number 2:14-cv-00690 (E.D. Tex.), the parties include PUMA, HTC America, Inc., and HTC Corp. In *Parthenon Unified Memory Architecture LLC v. Apple Inc.*, Case Number 2:15-cv-00621 (E.D. Tex.), the parties include PUMA and Apple Inc. No other litigation or proceeding involving the '789 patent is contemplated in the foreseeable future.

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

In addition to the instant proceeding, ZTE and PUMA are Parties to IPR2016-00665, IPR2016-00666, IPR2016-0667, and IPR2016-00670. The Parties are currently filing motions to terminate these related proceedings. Moreover, the '789 patent is at issue in IPR2016-00847, IPR2016-00923, and IPR2016-01135 where no decision on institution has yet issued.

**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 2001.<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 '789 Patent. There are no collateral agreements or

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

understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.

**IV. CONCLUSION**

For all of these reasons, the Parties respectfully request termination of this proceeding with respect to ZTE.

Respectfully submitted,

Dated: August 19, 2016

By: /s/ Masood Anjom  
Masood Anjom  
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Counsel for Patent Owner Parthenon  
Unified Memory Architecture, LLC

Dated: August 19, 2016

By: /s/ Lionel M. Levenue by permission  
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