

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Microsoft Corporation,
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner

Case IPR2016-01581
Patent 5,754,946

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a), Microsoft Corporation (“Microsoft” or “Petitioner”) and Mobile Telecommunications Technologies, LLC (“Patent Owner”) (jointly, the “Parties”) jointly request termination of IPR2016-01581, which is directed to U.S. Patent No. 5,754,946 (“the ’946 Patent”).

On August 11, 2016, Petitioner filed a Petition for *Inter Partes* Review (“Petition”) before the United States Patent Trial and Appeal Board. Patent Owner’s preliminary response was filed on November 25, 2016. The United States Patent and Trademark Office (“USPTO”) has not yet issued a Decision to Institute *inter partes* review of the ’946 Patent. The Parties have settled their dispute, and have reached agreement to terminate this *inter partes* review.

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 January 3, 2017. 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 patents at issue, and the status of each; and (3) identify any related proceedings currently before the Office. IPR2013-00428, Paper No. 56 at 2. This Motion satisfies each of the above requirements.

Indeed, the Parties have entered into a Settlement Agreement, and a true copy of the same is attached hereto as Exhibit 2001, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).¹ The Parties desire that the Settlement Agreement (Exhibit 2001) be maintained as business confidential information under 37 C.F.R. §42.74(c) and a separate joint request to that effect is being filed on even date herewith.

1. Reasons Why Termination is Appropriate.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter 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.”

Because the parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed,” termination of the *inter partes* review with respect to Petitioner is warranted. Within the context of Section 317(a), a decision on the merits must be something beyond a decision instituting trial. Otherwise the quoted phrase would be rendered meaningless because every “*inter partes* review instituted under this

¹ The Settlement Agreement is being filed electronically via the Patent Review Processing System (PRPS) as “Parties and Board Only.”

chapter” originates with a decision instituting trial. Here, no decision on the merits has been made. Accordingly, the USPTO is required to terminate this *inter partes* review with respect to Petitioner based on this joint request.

Moreover, Petitioner, Microsoft, does not oppose Patent Owner in seeking termination of this *inter partes* review proceeding altogether.

Because § 317(a) indicates that the USPTO is not required to terminate an *inter partes* review when no petitioner remains in the proceeding, Patent Owner provides comments as to why termination with respect to Patent Owner is proper in *Patent Owner’s Explanation as to Why Termination Is Appropriate*, attached hereto as Exhibit 2002.

2. All parties in any pending related litigation involving the patents at issue, and current status of each such related litigation.

Petitioner is involved in another pending related litigation involving the '946 Patent.² However, that litigation is also resolved by the parties settlement agreement. Other parties involved in litigations related to the '946 Patent are identified in the table that follows.

Case Name	Case No.	Court	Defendants	Status
<i>Mobile Telecommunications Technologies LLC v. Google Inc.</i>	2.16-cv-00002-JRG-RSP	EDTX Marshall	Google Inc.	Pending

3. Related proceedings currently before the Office and Status.

Aside from this *inter partes* review proceeding, the '946 Patent is also the subject of the following proceeding(s) currently before the Office:

Related Proceeding	Requestor/Petitioner	Status
IPR2016-01576	Microsoft Inc.	Pending

Pursuant to the Settlement Agreement, Petitioner will not further participate in these proceedings even if the Petition is not terminated pursuant to this joint motion, except to the extent necessary to comply with any order from the PTAB or

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