

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sony Corporation,
Petitioner,

v.

One-E-Way, Inc.
Patent Owner.

Case No. IPR2016-01638
U.S. Patent No. 9,282,396

**JOINT MOTION TO TERMINATE PROCEEDINGS
UNDER 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, and the February 5, 2018, email correspondence where the Board authorized this filing, Petitioner Sony Corporation and Patent Owner One-E-Way, Inc. jointly request termination of this proceeding seeking inter partes review of U.S. Patent No. 9,282,396.

The parties have resolved their dispute with respect to U.S. Patent No. 9,282,396—as described in the Confidential Settlement and License Agreement by the parties filed herewith as Exhibit 1014. Other than as indicated in the Agreement Exhibit 1014, there are no written or oral agreements or understandings, including any collateral agreements, between the parties, including but not limited to licenses, covenants not to sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of this proceeding. *See, e.g., General Growth Properties, Inc. et al. v. Peschke*, IPR2013-00400, Paper 35 at 2-3 (Apr. 9, 2014).

The parties are also filing concurrently herewith a joint request to treat the Agreement as business confidential information and to keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c).

Similar motions to terminate are being filed in IPR2016-01639 (also involving U.S. Patent No. 9,282,396) and in IPR2018-00216, IPR2018-00217,

IPR2018-00218, and IPR2018-00219 (involving related U.S. Patent Nos. 7,865,258 and 8,131,391). The parties have also settled and are filing a motion to terminate the Sony Respondents from *In re Certain Wireless Headsets*, Inv. No. 337-TA-943, pending before the U.S. International Trade Commission, which involves U.S. Patent Nos. 7,865,258 and 8,131,391.

Termination of this proceeding is proper under 35 U.S.C. § 317(a). Strong public policy reasons favor settlement between the parties to a proceeding, *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012), including the consequent conservation of resources and elimination of uncertainties. No final written decision has been entered on the merits of this proceeding. Therefore, “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Id.*

Accordingly, the parties respectfully request termination of this proceeding.

Dated: February 8, 2018

Respectfully submitted,

/ Paul T. Qualey /

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the Joint Motion To Terminate Proceedings Under 35 U.S.C. § 317(a) and associated Exhibit has been served on the Patent Owner's attorneys of record via electronic mail on February 8, 2018, at the following address:

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Dated: February 8, 2018

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