

Paper No. ____
Date Filed: January 5, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC
Patent Owner

Case No.: IPR2017-00142
Patent No.: 7,752,649

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

Pursuant to 35 U.S.C. § 317(a), Petitioner VIZIO, Inc. (“VIZIO”) and Patent Owner Personalized Media Communications, LLC (“PMC”) jointly request termination of the *inter partes* review (“IPR”) of U.S. Patent No. 7,752,649 (the “649 Patent”), Case No. IPR2017-00142.

This IPR has not been instituted. VIZIO filed its petition for IPR on October 26, 2016. PMC has not filed a preliminary response, and one is not due until February 8, 2017. The parties have settled their disputes, and have reached agreement to terminate this IPR.

In accordance with 37 C.F.R. § 42.20(b), the parties sought authorization from the Board to file this motion. The Board authorized the filing of this motion in the Order issued on January 4, 2017.

Termination of this proceeding is proper 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.” 35 U.S.C. § 317(a). Furthermore, the co-pending district court litigation in the Eastern District of Texas (Case No.: 2:15-cv-01206, consolidated with 2:15-cv-01366) has been dismissed with prejudice.

The parties in the co-pending district court litigation in the Eastern District of Texas (Case No.: 2:15-cv-01206) (“the ’1206 Case”) are Envision Peripherals, Inc.; Hon Hai Precision Industry (Taiwan) Co., Ltd.; TPV Electronics (Fujian) Co.

Ltd.; TPV Int'l (USA); Inc.; TPV Technology Co., Limited; Top Victory Electronics (Fujian) Co. Ltd.; Top Victory Electronics (Taiwan) Co. Ltd.; VIZIO, Inc.; Wistron Corporation; Wistron InfoComm Technology (Texas) Corp.; and Wistron InfoComm Technology (America) Corp. This case has been dismissed with prejudice with respect to all parties. The '1206 Case was consolidated with Case No. 2:15-cv-01366 (EDTX), in which Apple, Inc. is the only other party. That case is still pending before Judge Gilstrap with respect to Apple, Inc.

PMC has also asserted the '649 Patent in two other pending district court cases: Case No. 2:15-cv-01754 (EDTX) against Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (EDTX) and Case No. 2:16-cv-00105 (EDTX) against Funai Corporation, Inc.; Funai Electric Co., Ltd.; and P&F USA, Inc. Both cases are currently still pending.

The '649 Patent is also currently pending before the Board in IPR2016-00753 (trial instituted September 20, 2016), IPR 2017-00141 (petition filed October 26, 2016), IPR2017-00289 (petition filed November 18, 2016), and IPR2017-00290 (petition filed November 18, 2016).

The settlement agreement between VIZIO and PMC has been made in writing, and a true and correct copy shall be filed with this Office as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b)-(c).

Respectfully submitted,

Dated: January 5, 2017

/s/ Cono A. Carrano

Cono A. Carrano (Reg. No. 39,623)
David C. Vondle (Reg. No. 54,515)
Akin Gump Strauss Hauer & Feld LLP
1333 New Hampshire Avenue, NW
Washington, D.C. 20036
Phone: (202) 887-4000
Fax: (202) 887-4288
Attorneys For VIZIO, Inc.

/s/ Dmitry Kheyfits

Dmitry Kheyfits (Reg. No. 57,244)
Andrey Belenky (Reg. No. 59,194)
Kheyfits P.C.
1140 Avenue of the Americas, 9th Floor
New York, NY 10036
Phone: (212) 203-5399
Fax: (212) 203-6445
*Attorneys For Personalized Media
Communications, LLC*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that it caused to be served a true and correct copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317** on Patent Owner's counsel of record via email as follows:

Dmitry Kheyfits
dkheyfits@hkeyfits.com

Andrey Belenky
abelenky@hkeyfits.com

Date: January 5, 2017

Respectfully submitted,

By: /s/ Cono A. Carrano
Cono A. Carrano (Reg. No. 39,623)