

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

Huawei Device Co., Ltd., LG Electronics, Inc., and ZTE (USA) Inc.

Petitioners,

v.

Papst Licensing GmbH & Co. KG

Patent Owner.

Case No. IPR2017-00443

Patent No. 6,470,399 B1

**JOINT MOTION TO TERMINATE
WITH RESPECT TO HUAWEI DEVICE CO., LTD.
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of August 14, 2017, Petitioner Huawei Device Co., Ltd. ("Huawei") and Patent Owner Papst Licensing GmbH & Co. KG ("Patent Owner" or "Papst") jointly move to terminate the present *inter partes* review proceeding with respect to Huawei in light of Patent Owner and Huawei's settlement of their dispute regarding U.S. Patent No. 6,470,399 ("the '399 patent").

Huawei and Patent Owner are concurrently filing a true and complete copy of their written Settlement Agreement (Confidential Exhibit 2005) in connection with this matter as required by the statute. Huawei and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding with respect to Huawei. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

LEGAL STANDARD

An *inter partes* review proceeding “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.” 35 U.S.C. § 317(a). A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014).

ARGUMENT

Termination of the present *inter partes* review proceeding with respect to Huawei is appropriate because (1) Huawei and Patent Owner have settled their dispute regarding the '399 patent and have agreed to terminate the proceeding with respect to Huawei, (2) the Office has not yet decided the merits of the proceeding, (3) the proceeding is expected to continue with Petitioners LG Electronics, Inc. and ZTE (USA) Inc., and (4) public policy favors the termination.

First, the Settlement Agreement completely resolves the controversy between Patent Owner and Huawei relating to the '399 patent. Huawei

Technologies Co, Ltd. and Huawei Technologies USA, Inc., which are two of the real parties in interest in the present proceeding, were named defendants in *Papst Licensing GmbH & Co. KG v. Apple Inc.*, No. 6:15-cv-1095-RWS (E.D. Tex) and the consolidated case *Papst Licensing GmbH & Co. KG v. Huawei Technologies Co., Ltd.*, No. 6:15-cv-1115-RWS (E.D. Tex.). On August 11, 2017, the district court entered orders in both cases dismissing all claims against the Huawei entities and all counterclaims by the Huawei entities with prejudice.

Second, the Office has not decided the merits of the proceeding. Although the Board has instituted trial (Paper 7), the proceeding is still in a relatively early stage. Patent Owner has not yet filed its Response to the Petition.

Third, Huawei filed the Petition jointly with LG Electronics, Inc. and ZTE (USA) Inc. LG and ZTE are not parties to the Settlement Agreement and the parties have not requested that the proceeding be terminated with respect to either LG or ZTE. This termination will not impact petitioners LG and ZTE and the proceeding is therefore expected to continue with LG and ZTE as petitioners.

Fourth, public policy favors the termination. As recognized by the rules of practice before the Board:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part

of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding with respect to Huawei.

As to the remaining *Heartland Tanning* requirements, Exhibit A identifies each district court litigation that involves the '399 patent or any related patents and discusses the current status of these related litigations. Exhibit B identifies all petitions for *Inter Partes* Review that have been filed against the '399 patent or any related patent and discusses the status of each.

CONCLUSION

For the foregoing reasons, Huawei and Patent Owner jointly and respectfully request that the instant proceeding be terminated with respect to Huawei.

Date: August 21, 2017

Respectfully submitted,

By: /s/ David A. Garr

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