

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE INC.,  
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC  
Patent Owner

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Case IPR2017-00536  
Patent 5,754,946

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

Pursuant to 35 U.S.C. § 317(a), Google Inc. (“Google” or “Petitioner”) and Mobile Telecommunications Technologies, LLC (“Patent Owner”) (jointly, the “Parties”) jointly request termination of IPR2017-00536, which is directed to U.S. Patent No. 5,754,946 (“the ’946 Patent”).

On December 29, 2016, Petitioner filed a Petition for *Inter Partes* Review (“Petition”) before the United States Patent Trial and Appeal Board. Patent Owner’s preliminary response is not due until April 20, 2017. 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 April 18, 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).<sup>1</sup> 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 in its entirety is warranted. *See, e.g., Microsoft Corp. v. Mobile Telecommunications Technologies, LLC*, IPR2015-01576, Paper No. 9, p. 2 (P.T.A.B. January 19, 2017). Within the context of Section 317(a), a decision on the merits must be something beyond a decision

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

instituting trial. Otherwise the quoted phrase would be rendered meaningless because every “*inter partes* review instituted under this chapter” originates with a decision instituting trial. Here, no decision on the merits has been made, and “this proceeding is in its initial stages.” *Microsoft Corp. v. Mobile Telecommunications Technologies, LLC*, IPR2015-01581, Paper No. 9, p. 2 (P.T.A.B. January 19, 2017). Moreover, Petitioner, Google, does not oppose Patent Owner in seeking termination of this *inter partes* review proceeding altogether. Accordingly, the Parties jointly request that the USPTO terminate this *inter partes* review in its entirety for reasons similar to those identified by the Board in the above-cited cases (IPR2015-01576 at Paper No. 9; IPR2015-01581 at Paper No. 9).

**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 a pending related litigation involving the '946 Patent. However, as indicated in the table below, that litigation is also resolved by the parties settlement agreement.

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.	Settled

**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:

<b>Related Proceeding</b>	<b>Requestor/Petitioner</b>	<b>Status</b>
IPR2017-00537	Google Inc.	Motion to terminate filed concurrently

Accordingly, as discussed above, the Parties jointly request termination of IPR2017-00536, which is directed to the '946 Patent.

Respectfully submitted,

Dated: April 20, 2017

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Dated: April 20, 2017

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