

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION
Petitioner

v.

ARRIS ENTERPRISES LLC
Patent Owner

Case IPR2017-01964
Patent 6,473,858

**JOINT MOTION TO TERMINATE (WITHDRAW) PROCEEDING
PURSUANT TO 37 C.F.R. § 42.74**

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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.74, and the Board's authorization provided on December 4, 2017, Petitioner Sony Corporation ("Sony") and Patent Owner ARRIS Enterprises LLC and Real Party-in-Interest ARRIS International plc (together "ARRIS") (collectively, "the Parties") jointly request termination of *Inter Partes* Review No. IPR2017-01964 pursuant to settlement. As there are no other petitioners in this proceeding and the proceeding is still at an early stage, the Parties respectfully submit that termination of this proceeding is appropriate.

II. STATEMENT OF FACTS

Sony filed its petition in this proceeding for *Inter Partes* Review of U.S. Patent No. 6,473,858 ("the '858 Patent") on September 14, 2017. ARRIS's Preliminary Response is due on December 21, 2017, and the Board has not yet issued its institution decision.

On November 17, 2017, the Parties executed a detailed and legally binding and enforceable settlement agreement titled "Memorandum of Understanding" (MOU). Ex.-1011, Sect. 3. Among other things, the MOU settles all current disputes between the Parties and contains provisions requiring the Parties to terminate with prejudice their various legal actions (including specifically this proceeding and all of the litigations and proceedings related to the challenged patent) immediately upon execution of the MOU.

The MOU contains all the material terms and conditions related to the Parties' settlement. The MOU also specifically provides for a final agreement implementing the terms set out in the MOU to be entered into no later than December 15, 2017. *Id.* at Sect. 3. The Parties certify that, at this time, no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceeding exist. Should the final agreement come into existence before these proceedings are terminated, as required by the Rules, the Parties will contact the Board for authorization to file the final agreement along with a motion to treat it as business confidential and keep it separate from the file.

In an email dated December 4, 2017, the Board authorized the Parties to file a joint motion to terminate and a joint request to file the settlement agreement as confidential business information. As required by the Board, the Parties are submitting a true copy of the agreement (Exhibit 1011) along with this joint motion to terminate and a joint request to file the settlement agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

III. ARGUMENT

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 26 at 2 (PTAB Jul. 28, 2014).

The Board should terminate this proceeding as the Parties jointly request, for the following reasons.

A. Brief explanation as to why termination is appropriate

The proceeding is still at an early stage as no institution decision has yet been issued by the Board.

The Parties have reached a settlement as to the '858 Patent to end this dispute. A copy of the confidential settlement agreement pertaining to this case is filed concurrently herewith. *See* Ex.-1011. The Parties further jointly certify that there is no other agreement or understanding between them beyond Exhibit 1011 made in connection with, or in contemplation of, the termination of the instant proceeding as set forth in 35 U.S.C. §317(b).

The Parties respectfully submit that termination of this proceeding is appropriate because (a) this proceeding is at an early stage and no motions are outstanding; (b) the Parties have reached agreement to end their dispute concerning the '858 Patent; (c) the Parties have agreed to dismiss the related district court and International Trade Commission litigation between themselves with respect to the

'858 Patent; (d) the Parties agree that this *Inter Partes* Review should be terminated; and (e) termination of this proceeding will preserve the Board's resources and obviate the need for any more Board involvement in the present proceeding.

The Board requested that Patent Owner advise the Board whether any litigation or proceeding involving the subject matter of the patent is contemplated in the foreseeable future. Whether or not anything is contemplated, Patent Owner cannot do so without disclosing confidential information regarding legal strategies and thus potentially waiving the attorney client privilege, and requests that the Board act on the motion without requiring such disclosure.

B. Identity and status of parties in related litigation involving the patent

The '858 Patent was in dispute against Sony in *ARRIS Solutions, Inc. et al v. Sony Interactive Entertainment LLC et al*, Case 5:17-cv-02669-BLF (N.D. Cal.). On November 30, 2017, this case was dismissed pursuant to the settlement agreement between the Parties.

The '858 Patent is also in dispute against Sony in International Trade Commission Investigation No. 337-TA-1060, "Certain Consumer Electronic Devices, Including Televisions, Gaming Consoles, Mobile Phones and Tablets, and Network-Enabled DVD and Blu-Ray Players." On November 20, 2017, that

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