UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY CORPORATION
Petitioner

v.

ARRIS ENTERPRISES LLC
Patent Owner

Case IPR2018-00072
Patent 9,521,466

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

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
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. IPR2018-00072 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. 9,521,466 ("the '466 Patent") on November 8, 2017. ARRIS's Preliminary Response is due on February 15, 2018, and the Board has not yet issued its institution decision. *Inter Partes* Review No. IPR2018-00075 related to the '466 Patent is also pending, and is the subject of a corresponding motion to terminate. The Board has also not yet issued its institution decision in *Inter Partes* Review No. IPR2018-00075.

On November 17, 2017, the Parties executed a detailed and legally binding and enforceable settlement agreement titled "Memorandum of Understanding" (MOU). Ex.-1021, 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 1021) 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 '466 Patent to end this dispute. A copy of the confidential settlement agreement pertaining to this case is filed concurrently herewith. *See* Ex.-1021. The Parties further jointly certify that there is no other agreement or understanding between them beyond Exhibit 1021 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 '466 Patent; (c) the Parties have agreed to dismiss the related district court and International Trade Commission litigation between themselves with respect to the '466 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 '466 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.

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.