

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. AND TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners

v.

INTELLECTUAL VENTURES I LLC
Patent Owner

Case IPR2018-00727
U.S. Patent No. 6,628,629

JOINT MOTION TO TERMINATE PROCEEDING

Petitioners Telefonaktiebolaget LM Ericsson and Ericsson Inc. and Patent Owner Intellectual Ventures I LLC have reached a settlement agreement and jointly request termination of IPR2018-00727 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on June 12, 2019.

I. Statement of Relief Requested

Due to a settlement, Petitioners and Patent Owner jointly request termination of IPR2018-00727 under 35 U.S.C. § 317(a).

II. Statement of Facts

Petitioners and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. Petitioners and Patent Owner are filing the settlement agreement concurrently with this motion, along with a “Joint Request That the Settlement Agreement Be Treated as Business Confidential and Key Separate Under 35 U.S.C. § 317(b).” 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 (P.T.A.B. July 28, 2014).

(1) Brief Explanation.

Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That the Settlement Agreement Be Treated as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b)” is being filed concurrently with this motion.

(2) Related Litigation.

The parties completed a district court trial on the '629 Patent in February 2019. *Intellectual Ventures I LLC v. Telefonaktiebolaget LM Ericsson et al.*, No. 2:17-cv-00577-JRG (E.D. Tex.).

(3) Related Proceedings Before the Office.

Petitioners and Patent Owner are not aware of other *inter partes* review proceedings involving the '629 Patent. Petitioners and Patent Owner are aware of the following pending *inter partes* review proceedings involving patents related to the '629 Patent: *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2018-00758 (P.T.A.B.) (RE46,206); *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2018-00782 (P.T.A.B.) (RE46,206); *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2018-01121 (P.T.A.B.) (RE46,206); *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2018-01256 (P.T.A.B.) (RE46,206); *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2018-01318 (P.T.A.B.) (RE46,206); *Ericsson Inc. v.*

Intellectual Ventures I LLC, IPR2018-01007 (P.T.A.B.) (U.S. Patent No. 7,412,517); and *Ericsson Inc. v. Intellectual Ventures I LLC*, IPR2018-01058 (P.T.A.B.) (U.S. Patent No. 7,359,971).

(4) Status of Related Litigation and Proceedings Before the Office.

Post-trial briefing in the related district court proceeding is incomplete. The Board has instituted trial in all of the above-referenced *inter partes* review proceedings.

III. Argument

The Board should terminate this *inter partes* review for the following reasons.

First, Petitioners and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under § 317(a), an *inter partes* review “shall” be terminated up a joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding. A true copy of the settlement agreement is filed concurrently herewith. *See* Paper No. 27. The parties request that the settlement agreement be

treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, the parties in the present proceeding jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of this proceeding.

Third, a termination of this proceeding will conserve the Board's resources and obviate the need for any more Board involvement in this matter.

IV. Conclusion

For these reasons, Petitioners and Patent Owner respectfully request termination of this *inter partes* review of the '629 Patent.

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