

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
ZTE (USA) INC.,
AND
ZTE CORPORATION,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

Case IPR2020-01158
Patent No. 7,460,868

**JOINT MOTION OF ZTE CORPORATION, ZTE (USA) INC., AND
PATENT OWNER TO TERMINATE ZTE CORPORATION AND ZTE
(USA) INC. FROM THE PROCEEDING AND RECONSTITUTE THE
PETITIONER AS DELL INC. PURSUANT TO 35 U.S.C. § 317(a)
AND 37 C.F.R. §§ 42.5(a) AND 42.74**

TABLE OF EXHIBITS

Exhibit	Description
2001	Declaration of Stu Lipoff in Support of Patent Owner
2002	Affidavit of Stephanie Berger
2003	Affidavit of Neil Benchell
2004	Affidavit of Andrew DeMarco
2005	Second Declaration of Stu Lipoff in Support of Patent Owner
2006	3rd Generation Partnership Project; Technical Specification Group Core Network; NAS Functions related to Mobile Station (MS) in idle mode (Release 7) (3GPP TS 23.122 V7.0.0) (“TS 23.122 V7.0.0”)
2007	3rd Generation Partnership Project; Universal Mobile Telecommunications (UMTS); Characteristics of the USIM application (Release 6) (3GPP TS 31.102 V6.8.0) (“TS-31.102 V6.8.0”)
2008	<i>“The North American Official Cellular User’s Guide” Available to Help Cellular Telephone Users</i> , Business Wire, December 18, 1990
2009	Amy Zuckerman, <i>Those Black Holes in Your Mobile Phone Service</i> , New York Times, December 24, 2000
2010	Nancy Gohring, <i>Falling Short of Replacement: Wireless Carrier Plans Compete with Landline but Don’t Cut it Out of the Equation</i> , Telephony, April 27, 1998
2011	Judy Strausbaugh, <i>Oh, Give me a Cell Phone Where the Signals Won’t Roam</i> , Sunday News (Lancaster, PA), May 19, 2002
2012	Settlement Agreement dated August 4, 2021

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.5(a), and the Board's authorization via email on August 13, 2021, Petitioner constituents ZTE Corporation and ZTE (USA) Inc. ("the ZTE entities"), and Patent Owner, 3G Licensing S.A. (collectively "the Joint Movants"), jointly move that the Board terminate the above-captioned proceeding with respect to the ZTE entities, and dismiss the ZTE entities therefrom, as a result of a settlement between the ZTE entities and Patent Owner. The other party to this proceeding, Petitioner constituent Dell Inc. ("Dell") does not object to dismissing the ZTE entities from this proceeding. Patent Owner and the ZTE entities further move to reconstitute the Petitioner as Dell only.

The ZTE entities and Patent Owner are filing concurrently herewith a request that the settlement agreement between the ZTE entities and Patent Owner, submitted as Ex. 2012, be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. 317(b) and 37 C.F.R. § 42.74(c).

The settlement agreement is being filed as "Available only to board" to preserve the confidentiality of the agreement so that, *inter alia*, Dell continues to not have access to that agreement.

II. STATEMENT OF FACTS

In July of 2019, Patent Owner filed an infringement action against the ZTE entities ("the Litigation") asserting infringement of certain claims of U.S. Patent Nos. 6,529,561 ("the '561 patent"), 7,433,698 ("the '698 patent"), 8,364,196 ("the '196 patent"), 7,751,803 ("the '803 patent"), 7,894,443 ("the '443 patent"), 7,274,933 ("the '933 patent"), 7,460,868 ("the '868 patent"), 7,596,375 ("the '375 patent"), 8,275,374 ("the '374 patent"), 8,472,955 ("the '955 patent"), 8,948,756 ("the '756 patent"), and 8,897,503 ("the '503 patent") (collectively, "the Asserted Patents"). Dell had a separate infringement action involving the Asserted Patents filed against them. Petition at 69-70.

Dell, the ZTE entities, and other parties jointly sought *inter partes* review of the '803 patent, the '698 patent, the '196 patent, the '561 patent, the '443 patent, and the '503 patent as petitioner in *inter partes* reviews IPR2020-01069, IPR2020-01070, IPR2020-01071, IPR2020-01099, IPR2020-01102, IPR2020-01103, respectively.¹ Dell and the ZTE entities jointly sought *inter partes* review of the '933 patent, the '868 patent, the '375 patent, the '374 patent, the '955 patent, and the

¹ A joint motion to terminate the ZTE entities is also being filed in each of these IPRs.

'756 patent in *inter partes* reviews IPR2020-01157, IPR2020-01158, IPR2020-01159, IPR2020-01160, IPR2020-01161, and IPR2020-01162, respectively.

The Litigation is currently stayed. Dell's litigation is also stayed. On August 4, 2021, the ZTE entities and Patent Owner entered into a settlement agreement resolving their disputes in connection with the involved patent. See Ex. 2012 (Confidential). Pursuant to the terms of the settlement agreement, the ZTE entities and Patent Owner agreed, among other things, to jointly move for termination of the above-captioned IPR proceeding with respect to the ZTE entities. Ex. 2012 at 14.

III. ARGUMENT

A. Legal Standard

35 U.S.C. § 317(a) provides that "[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." In addition, "[t]he Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding." 37 C.F.R. § 42.5(a).

B. The Board Should Dismiss the ZTE entities from the Above-Captioned Proceeding

As noted above, "[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner

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