

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILE IRON, INC.
Petitioners

v.

BLACKBERRY LIMITED,
Patent Owner

Case IPR2021-00162
Patent 8,442,489

JOINT MOTION TO TERMINATE PROCEEDING

LIST OF EXHIBITS

| Exhibit No. | Description of Document |
|-------------|--|
| 1001 | U.S. 8,442,489 (the “’489 Patent”) |
| 1002 | Declaration of Markus Jakobsson, Ph.D. |
| 1003 | File History of the ’489 Patent |
| 1004 | File History of U.S. 8,010,989 |
| 1005 | U.S. 7,665,118 to Mann <i>et al.</i> (Mann) |
| 1006 | U.S. 7,043,263 to Kaplan <i>et al.</i> (Kaplan) |
| 1007 | National Institute of Science and Technology (NIST), “ <i>Federal S/MIME V3 Client Profile</i> ,” NIST Special Publication 800-49 (2002) (S/MIME-Profile) |
| 1008 | R. Karri and P. Mishra, “Minimizing Energy Consumption of Secure Wireless Session with QoS Constraints,” in Proceedings of the 2002 IEEE International Conference on Communications Conference (ICC 2002) vol. 4, pp. 2053-2057 (2002) (Karri) |
| 1009 | Aoki, Kazumaro, and Helger Lipmaa, “Fast Implementations of AES Candidates,” in Proceedings of AES Candidate Conference, pp. 106-120 (2000). |

| Exhibit No. | Description of Document |
|-------------|---|
| 1010 | Srivaths Ravi <i>et al.</i> , “Security in Embedded Systems: Design Challenges,” 3 ACM Transactions on Embedded Computing Systems, pp. 461–491 (2004) |
| 1011 | U.S. Patent Application Publication No. US 2003/0182435 by Redlich <i>et al.</i> (Redlich) |
| 1012 | Federal Information Processing Standards Publication 197 (FIPS-197) |
| 1013 | Original Complaint filed April 27, 2020 in <i>MobileIron. Inc. v. Blackberry Corp., et al.</i> , Case No. 3:20-cv-02877 (N.D. Cal.) |
| 1014 | First Amended Complaint filed June 29, 2020 in <i>MobileIron. Inc. v. Blackberry Corp., et al.</i> , Case No. 3:20-cv-02877 (N.D. Cal.) |
| 1015 | Affidavit of Elizabeth Rosenberg Regarding S/MIME-Profile |
| 1016-1054 | Not used |
| 1055 | Settlement agreement |

Petitioner and Patent Owner (collectively “Parties”) hereby jointly move for an order terminating the preliminary proceeding initiated by the petition for *inter partes* review filed on November 5, 2020, directed to Patent No. 8,442,489 (“the challenged patent”) and assigned case number IPR2021-00162.

Patent Owner has yet to file a preliminary response. The Board has yet to issue a decision to institute trial.

1. Reasons Why Termination Is Appropriate

The Board emailed the Parties on March 3, 2021 to authorize this filing of a “Joint Motion To Terminate.” Termination is proper because the Parties are jointly requesting termination, this IPR proceeding is still in its early stages, and the Board has not yet “decided the merits of the proceeding.” *Samsung Electronics Co., Ltd. et al v. Neodron Ltd.*, IPR2020-01682, Paper 14, 3 (February 18, 2021); *see also Samsung Electronics Co., Ltd. v. Fundamental Innovation Systems Int’l*, IPR2018-00605, Paper 10, 2 (PTAB July 16, 2018) (noting that 35 U.S.C. § 317 “does not govern settlement prior to institution,” but explaining that “it is appropriate to dismiss the proceedings pursuant to 37 C.F.R. § 42.71(a)”). Accordingly, termination is appropriate here.

The parties are filing herewith as Exhibit 1025, a true copy of settlement agreement entered between the Parties and executed on February 22, 2021. *See* 37

C.F.R. § 42.74(c). The settlement agreement was entered into in contemplation of terminating this proceeding. This settlement agreement is the only agreement or understanding between Petitioner and Patent Owner made in connection with, or in contemplation of terminating this proceeding. *See* 37 C.F.R. § 42.74(b). A request is being filed herewith to treat this agreement as “business confidential information” and to keep it separate from the files of the involved patent. *See* 37 C.F.R. § 42.74(c).

The Parties understand that if the Board terminates this IPR proceeding, no estoppel under 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d)(1) will attach to Petitioner. The Parties understand that if the Board terminates this petition for *inter partes* review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

The lawsuit between Patent Owner and Petitioner involving the challenged patent here has been dismissed. The parties do not contemplate any litigation or proceeding involving the challenged patent in the foreseeable future.

2. No Future Participation by Petitioner

Petitioner will not be participating further in this proceeding.

3. Conclusion

The parties have settled all disputes relating to the challenged patent. This *inter partes* review is in an early stage, and the Board has not entered a final written

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