

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CELLCO PARTNERSHIP D/B/A/ VERIZON WIRELESS,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT LLC,
Patent Owner.

Patent No. 8,213,970
Filing Date: November 26, 2008
Issue Date: July 3, 2012

Inventor: Malcolm K. Beyer
Title: METHOD OF UTILIZING FORCED ALERTS FOR
INTERACTIVE REMOTE COMMUNICATIONS

JOINT MOTION TO TERMINATE PROCEEDINGS

Case No. IPR2023-00056

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Confidential Settlement Agreement

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Cellco Partnership, d/b/a Verizon Wireless (“Petitioner”) and Patent Owner AGIS Software Development LLC (“Patent Owner”) (collectively, “the Parties”) jointly request termination of this proceeding. The Parties have entered into a written confidential settlement agreement that settles all disputes between them, including those relating to this proceeding and the related district court action, which was dismissed with prejudice on January 13, 2023. *AGIS Software Development LLC v. Cellco Partnership, d/b/a Verizon Wireless*, Case No. 2-22-cv-00185, Dkt. 50 (E.D. Tex., Jan. 13, 2023). Pursuant to 37 C.F.R. § 42.74, a true copy of the Parties’ settlement agreement (including any other related agreement) has been filed as Exhibit 2001. This Joint Motion was authorized by the Board pursuant to e-mail correspondence on January 19, 2023.

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a). “There are strong public policy reasons to favor settlement between the parties to a proceeding.

... The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” PTAB Consolidated Trial Practice Guide at 86 (November 2019).

This proceeding is in a preliminary stage because trial has not been instituted and the Board has not finally decided the merits. Accordingly, it is appropriate for the Board to exercise its authority pursuant to 37 C.F.R. § 42.71 to terminate this proceeding in view of the settlement entered into between Petitioner and Patent Owner. By granting the present Motion, the Board and the Parties can conserve resources. Additionally, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

As required by statute and as directed by the Board, the Parties are filing concurrently herewith, as a separate submission, a Joint Motion to Treat Settlement Agreement as Business Confidential and to Keep Separate, pursuant to 35 U.S.C. § 317(b), along with the true copy of the written settlement agreement, which includes all agreements between the Parties related to this proceeding. *See* Exhibit 2001. The Parties request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patent. The Parties certify that there are no other collateral agreements or understandings,

oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this *inter partes* review.

Respectfully submitted,

Dated: January 20, 2023 By: /Vincent J. Rubino, III /
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Respectfully submitted,

Dated: January 20, 2023 By: /Justin J. Oliver /
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