

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUAWEI TECHNOLOGIES CO., LTD and HUAWEI ENTERPRISE USA

Petitioners,

v.

SPHERIX INCORPORATED

Patent Owner.

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Case IPR2015-01390

Patent 7,664,123

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**JOINT MOTION TO TERMINATE PROCEEDING**

**AND**

**JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT  
AS BUSINESS CONFIDENTIAL UNDER  
35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

**RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317(a), Petitioners Huawei Technologies Co., LTD and Huawei Enterprise USA (“Huawei”) and Patent Owners Spherix Incorporated and NNPT, LLC. (“Spherix”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 7,664,123, Case No. IPR2015-01390.

**REASONS FOR GRANTING THE MOTION**

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

The Board authorized the filing of the instant joint motion and request in an email dated September 15, 2015. In that email, the Board set a date of September 23, 2015 for the filing of this motion and the settlement agreement. In a further email, dated September 16, 2015, the Board indicated that the panel is aware that the parties intend to file this motion and settlement agreement. The email of September 16 further indicates that the panel intends to wait to receive the motions before acting on the case.

IPR2013-00428, Paper No. 56, provides guidance as to the content of a motion to terminate. There, the Board indicates that a joint motion, such as this one, should (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patent 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. *Id.* at 2. This motion satisfies each of the above requirements and is accompanied by a true copy of the Parties’ fully-executed settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

**(1) Brief Explanation of Why Termination is Appropriate.**

Petitioners filed their petition for *Inter Partes* Review on June 11, 2015. Patent Owner has not filed a preliminary response, and one is not due until September 26, 2015. Termination is appropriate because the Parties have settled their dispute and reached agreement to terminate this *Inter Partes* Review proceeding, and this *Inter Partes* Review has not been instituted.

**(2) All Parties in Any Pending Related Litigation Involving the Patent at Issue.**

Petitioners and Patent Owner are parties in a related district court litigation, *Huawei Investment & Holding Co., Ltd.; Huawei Technologies Co., Ltd.; Huawei Device (Hong Kong) Co., Ltd.; Huawei Device USA Inc.; Huawei Technologies USA Inc.; Huawei Technologies Cooperatif U.A. and Futurewei Technologies, Inc.*, Civil Action No. 2:14-cv-677 (E.D. Texas), which the parties also have settled.

**(3) Related Proceedings Currently Before the Office.**

Aside from this *Inter Partes* Review proceeding, U.S. Patent No. 7,664,123 is not involved in any other proceeding currently before the Office.

**(4) Current Status of Each Such Related Litigation or Proceeding With Respect to Each Party to the Litigation or Proceeding.**

As indicated above, the Parties have settled their dispute in the related district court litigation.

**SETTLEMENT AGREEMENT**

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' settlement agreement has been made in writing, and a true and correct copy is being filed concurrently

herewith as Exhibit A. The settlement agreement is being filed via the Patent Review Processing System (PRPS) with access to "Parties and Board Only."

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and the Board's authorization of the filing of this joint request in its email to the Parties on September 15, 2015, the Parties jointly request that the true copy of the settlement agreement filed concurrently herewith be treated as business confidential information, which shall be kept separate from the file of U.S. Patent No. 7,664,123. The Parties further request the Board to not make the settlement agreement available to any third party, except as provided for in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

### **CONCLUSION**

For all of these reasons, Petitioners and Patent Owner respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 7,664,123, Case No. IPR 2015-01390.

As stated in 35 U.S.C. § 317(a), because Petitioners and Patent Owner request this termination as to Petitioners, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioners.

Date: September 21, 2015

Respectfully submitted,

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