

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,

HTC CORPORATION, AND HTC AMERICA, INC.

Petitioners

v.

NONEND INVENTIONS, N.V.,

Patent Owner

PTAB Case No. IPR2016-00225

Patent No. 8,099,513 B2

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

AND 37 C.F.R. § 42.74

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Patent Trial and Appeal Board

U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74(a)-(b), Petitioners HTC Corporation and HTC America, Inc. (collectively, “HTC”) and Patent Owner Nonend Inventions, N.V. (“Nonend”) jointly move to terminate the present *inter partes* review proceeding in light of the parties’ resolution of their dispute relating to U.S. Patent No. 8,099,513 B2 (“the ’513 patent”) and the executed written agreement regarding the parties’ resolution. (This proceeding has already been terminated as to petitioner Microsoft Corporation.)

Termination is appropriate in the instant proceeding because the dispute between HTC and Nonend has been resolved. The IPR petition was accorded a Nov. 20, 2015 filing date and this proceeding is at a sufficiently early stage.

As required by 35 U.S.C. § 317(b), the parties are filing, concurrently herewith, a true copy of their executed written agreement as Exhibit 1067. The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the agreement be treated as confidential business information and kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a motion to treat the settlement agreement as confidential business information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

The applicable statute, 35 U.S.C. § 317(a), provides that an *inter partes* review proceeding “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.” (emphasis added). Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding. Indeed, the Office Patent Trial Practice Guide provides:

N. Settlement. There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the 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.

The Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14 2012).

Notably, the IPR petition was filed on Nov. 20, 2015 and thus this proceeding is at a sufficiently early stage where no motions or actions are outstanding and the Board has not invested significant resources in this proceeding. Patent Owner’s Preliminary Response is due March 9, 2016 and has not been filed yet. The due date for the Board’s institution decision is June 9, 2016. Therefore,

the Office has not decided the merits of the proceeding. No public interest factors militate against termination of this proceeding.

Under 35 U.S.C. § 317(a), because Petitioner HTC and Patent Owner Nonend request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioner HTC.

Wherefore, HTC and Nonend respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 8,099,513, PTAB Case No. IPR2016-00225.

Dated: February 23, 2016

Respectfully submitted,

/Matthew J. Antonelli/

Lead Counsel

Matthew J Antonelli
Zachariah Harrington
Kris Yue Teng
Larry Dean Thompson , Jr

Antonelli, Harrington & Thompson LLP
4306 Yoakum Blvd., Ste. 450
Houston, TX 77006

Attorneys for Patent Owner
Nonend Inventions, N.V.

Dated: February 23, 2016

Respectfully submitted,

/Bing Ai/

Lead Counsel

Bing Ai, Reg. No. 43,312

Back-up Counsel

Matthew C. Bernstein, *Pro Hac Vice*

Kevin J. Patariu, Reg. No. 63,210

Christopher L. Kelley, Reg. No. 42,714

Vinay P. Sathe, Reg. No. 55,595

Philip A. Morin, Reg. No. 45,926

PERKINS COIE LLP
11988 El Camino Real, Suite 350
San Diego, CA 92130
(858) 720-5700

Attorneys for Petitioner

HTC

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