

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-00529 (Patent 5,809,428)¹
Case IPR2017-00530 (Patent 5,809,428)
Case IPR2017-00532 (Patent 5,894,506)
Case IPR2017-00533 (Patent 5,894,506)
Case IPR2017-00534 (Patent 5,894,506)
Case IPR2017-00535 (Patent 5,894,506)
Case IPR2017-00536 (Patent 5,754,946)
Case IPR2017-00537 (Patent 5,754,946)
Case IPR2017-00559 (Patent 5,809,428)

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, MIRIAM L. QUINN, and JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

JUDGEMENT

Termination of Proceeding
37 C.F.R. § 42.72

¹ This Judgement applies to each of the listed cases. We exercise our discretion to issue one Judgement to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

Case IPR2017-00529 (Patent 5,809,428); Case IPR2017-00530 (Patent 5,809,428)
Case IPR2017-00532 (Patent 5,894,506); Case IPR2017-00533 (Patent 5,894,506)
Case IPR2017-00534 (Patent 5,894,506); Case IPR2017-00535 (Patent 5,894,506)
Case IPR2017-00536 (Patent 5,754,946); Case IPR2017-00537 (Patent 5,754,946)
Case IPR2017-00559 (Patent 5,809,428)

On April 20, 2017, Patent Owner Mobile Telecommunications Technologies, LLC (“Mobile”) and Petitioner Google Inc. (“Google”) filed a joint motion to terminate the instant proceedings under 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 7), a true copy of the written settlement agreement (Ex. 2002), and a joint request to maintain confidentiality and to keep separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 8).²

Under 35 U.S.C. § 317(a), “[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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The grant of the motion to terminate will result in the termination of the instant proceeding. The parties are reminded that the Board is not a party to the settlements, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a).

Generally, however, the Board expects that a proceeding will terminate as to settling parties 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). As no trial has been instituted based on Google’s Petition, this matter is in the preliminary proceeding stage.³ The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding. *See* 37 C.F.R. § 42.72.

² For simplicity, we refer to paper numbers and exhibit numbers in IPR2017-00529.

³ A preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted. 37 C.F.R. § 42.2.

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Case IPR2017-00559 (Patent 5,809,428)

Accordingly, it is:

ORDERED that the joint motions to terminate IPR2017-00529, IPR2017-00530, IPR2017-00532, IPR2017-00533, IPR2017-00534, IPR2017-00535, IPR2017-00536, IPR2017-00537, IPR2017-00559 are GRANTED, and these proceedings are hereby terminated in their entirety; and

FURTHER ORDERED that the parties' joint requests that the settlement agreements be treated as business confidential information kept separate from the patent files, and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), are GRANTED.

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