

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA SOLUTIONS AND NETWORKS US LLC; AND
NOKIA SOLUTIONS AND NETWORKS OY,
Petitioners

v.

HUAWEI TECHNOLOGIES CO. LTD.,
Patent Owner

Case: IPR2017-00661
U.S. Patent No. 9,060,268

**JOINT MOTION BY PETITIONERS AND PATENT OWNER TO
TERMINATE PROCEEDING PURSUANT TO
35 U.S.C. § 317 and 37 C.F.R. § 42.74**

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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(a) and 37 C.F.R. § 42.74, Petitioners Nokia Solutions and Networks US LLC and Nokia Solutions and Networks Oy (“Nokia” or “Petitioners”) and Patent Owner Huawei Techs. Co. Ltd. (“Huawei”) jointly request termination of the *inter partes* review of U.S. Patent No. 9,060,268 (“the 268 Patent”), Case No. IPR2017-00661, without prejudice, and request that the settlement agreement be treated as business confidential information pursuant to 35 U.S.C. § 317(b). The Board authorized the parties to file this Joint Request on December 22, 2017 via e-mail.

Patent Owner filed a patent infringement lawsuit alleging infringement of the 268 Patent in the United States District Court for the Eastern District of Texas, captioned *Huawei Techs. Co. Ltd. v. T-Mobile US Inc.*, Case No. 2:16-cv-57-JRG-RSP. The parties have agreed to the dismissal of all claims in this lawsuit, including those relating to the 268 Patent, and the parties have filed a stipulation and proposed order for dismissal. There is no other litigation or proceeding involving the 268 Patent, and no litigation or proceeding is contemplated in the foreseeable future in view of the *Litigation Settlement Agreement* (Ex. 1100).

I. Termination of Case No. IPR2017-00661 Would Be Appropriate.

Termination of IPR2017-00661 by the Board would be appropriate. The parties have executed a settlement agreement that resolves all of their disputes concerning the 268 Patent—expressly including the present IPR—and the Board has

not yet conducted an oral hearing. Motions to terminate based on settlement are routinely granted in the post-institution, pre-oral hearing timeframe. *See, e.g., Oracle Amer. Inc., et al. v. Realtime Data LLC*, Case IPR2016-00373 (PTAB Apr. 11, 2017) (Paper 30 at 3); *Nike, Inc. v. Point 3 Basketball, LLC*, Case No. IPR2016-00396 (PTAB Feb. 22, 2017) (Paper 20 at 3); *Amer. Megatrends, Inc., et al. v. Kinglite Holdings Inc.*, Case IPR2016-00114 (PTAB Dec. 13, 2016) (Paper 22 at 2). Accordingly, good cause exists to terminate the proceedings based on settlement as the Board has not yet conducted an oral hearing or otherwise resolved the merits of the Petition.

As set forth in 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the agreement has been made in writing in the form of a settlement agreement executed by the parties, and a true and correct copy of that settlement agreement has been filed as Exhibit 1100.

The parties hereby represent that the document filed as Exhibit 1100 represents all agreements made in connection with, or in contemplation of, the termination of this proceeding. All such agreements have been filed with the Board as required by § 317(b) and 37 C.F.R. § 42.74(b).

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

Submitted concurrently herewith is a request by Nokia and Huawei that the settlement agreement be treated as business confidential information, be kept

separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. Conclusion

Therefore, Nokia and Huawei respectfully request termination of the inter partes review of U.S. Patent No. 9,060,268, Case No. IPR2017-00661, without prejudice.

Dated: December 22, 2017

/s/ S. Benjamin Pleune
S. Benjamin Pleune
Registration No. 52,421
Lead Counsel for Petitioners

Dated: December 22, 2017

/s/ W. Karl Renner
W. Karl Renner
Registration No. 41,265
Lead Counsel for Patent Owner

CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e))

The undersigned hereby certifies that the above-captioned “JOINT MOTION BY PETITIONERS AND PATENT OWNER TO TERMINATE PROCEEDING” was served in its entirety on December 22, 2017 pursuant to agreement via email to counsel for Huawei at:

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