

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC. and T-MOBILE USA, INC.,
Petitioners

v.

HUAWEI TECHNOLOGIES CO. LTD.,
Patent Owner

Case IPR2017-00671

Patent 8,638,750

**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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Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioners T-Mobile US, Inc. and T-Mobile USA, Inc. (“T-Mobile” or “Petitioners”) and Patent Owner Huawei Technologies Co. LTD. (“Huawei” or “Patent Owner”) jointly request termination of the *inter partes* review of U.S. Patent No. 8,638,750 (“the 750 Patent”), Case No. IPR2017-00671, 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 28, 2017 via email.

I. Termination of Case No. IPR2017-00671 Would Be Appropriate.

Termination of IPR2017-00671 by the Board would be appropriate. The parties have executed a settlement agreement that resolves all of their disputes concerning the 750 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 No. 1028.

The parties hereby represent that the document filed as Exhibit 1028 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 T-Mobile and Huawei request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioners T-Mobile.

Submitted concurrently herewith is a request by T-Mobile 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, T-Mobile and Huawei respectfully request termination of the inter partes review of U.S. Patent No. 8,638,750, Case No. IPR2017-00671, without prejudice.

Dated: December 29, 2017

/Joseph F. Haag/
Joseph F. Haag
Registration No. 42,612
Counsel for Petitioners,
T-Mobile US, Inc. et al.

Dated: December 29, 2017

/W. Karl Renner/
W. Karl Renner
Registration No. 41,265
Counsel for Patent Owner Huawei
Technologies Co. LTD.

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 PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74” was served in its entirety via email to the Patent Owner by serving the correspondence email addresses of record as follows:

Michael T. Hawkins (IPR35548-0058IP1@fr.com)

W. Karl Renner (AXF-PTAB@fr.com, PTABInbound@fr.com)

Jeremy Monaldo (monaldo@fr.com)

Roberto Devoto (devoto@fr.com)

Stuart A. Nelson (PTABInbound@fr.com)

Kevin K. Su (PTABInbound@fr.com)

Conrad A. Gosen (PTABInbound@fr.com)

IPR35548-0058IP1@fr.com (ref.: Docket No. 35548-0058IP1)

/Joseph F. Haag/ _____

Joseph F. Haag
Registration No. 42,612

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