

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORP.,

Petitioner,

v.

OPTIS CELLULAR TECHNOLOGY, LLC,

Patent Owner.

Case IPR2017-00755

Patent No. 8,174,506

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a) and authorization of the Board granted on April 28, 2017, Petitioner BlackBerry Corp. (“BlackBerry”) and Patent Owner Optis Cellular Technology, LLC (“Optis”) jointly request termination of IPR2017-00755, which is directed to U.S. Patent No. 8,174,506 (“the ‘506 Patent”).

This *inter partes* review was filed January 23, 2017. A Preliminary Response has not been filed by the Patent Owner and no decision regarding institution of the proceeding has issued. Further, no final written decision on the merits of this review proceeding has been entered. The parties have settled their dispute, and have reached agreement to terminate this *inter partes* review. As there are no other petitioners in this proceeding, and the proceeding is still at a very early stage, the parties respectfully submit that termination of this proceeding is appropriate.

The parties’ Settlement Agreement has been made in writing, and a true copy of same is attached hereto as Exhibit 1018.¹ The parties further jointly certify that there is no other agreement or understanding between them, including any other collateral agreements, made in connection with, or in contemplation of, the termination of the instant proceeding as set forth in 35 U.S.C. § 317(b). The parties desire that the Settlement Agreement be maintained as business confidential

¹ The Settlement Agreement is being filed electronically via the Patent Trial and Appeals Board’s E2E as “Parties and Board Only.”

information under 37 C.F.R. § 42.74(c) and a separate joint request to that effect is being filed concurrently.

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

I. Reasons Why Termination is Appropriate

Termination with respect to Petitioner is proper under 35 U.S.C. § 317(a) because the parties are jointly requesting termination and the Office has not yet “decided on the merits of the proceeding before the request for termination is filed.” Here, no decision on the merits has been made. Accordingly, the parties are entitled to terminate this proceeding as to Petitioner under Section 317(a) upon their joint request.

The parties respectfully submit that termination of this proceeding is appropriate because (a) this proceeding is at a very early stage and no motions are outstanding; (b) the parties have reached agreement to end their dispute concerning the ‘506 Patent; (c) the parties have agreed to dismiss the related district court litigation with respect to the ‘506 Patent; (d) the parties agree that this Inter Partes Review should be terminated; and (e) termination of this proceeding will preserve the Board’s resources and obviate the need for any more Board involvement in this matter.

II. Related District Court Litigation and Status

The '506 patent was asserted in *PanOptis Patent Management, LLC v. BlackBerry Limited*, No. 2:16-cv-00062-JRG-RSP (E. D. Tex.). This litigation proceeding has been dismissed as part of the parties' Settlement Agreement. There are no other current litigation proceedings involving the subject patent.

III. Related Proceedings Before the Office

No other proceedings related to the '506 Patent are pending.

Dated: May 2, 2017

Respectfully submitted,

/Robert C. Mattson/

Robert C. Mattson (Reg. No. 42,850)
OBLON, MCCLELLAND, MAIER
& NEUSTADT, LLP
1940 Duke Street
Alexandria, Virginia 22314
(703) 412-6466
cpdocketmattson@oblon.com
Counsel for Petitioner
BlackBerry Corp.

/Barry J. Bumgardner/

Barry J. Bumgardner
Registration No. 38,397
NELSON BUMGARDNER, P.C.
3131 W. 7th Street, Suite 300
Fort Worth, Texas 76107
(817) 377-3494
barry@nelbum.com
Counsel for Patent Owner
Optis Cellular Technology, LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of JOINT MOTION TO TERMINATE PROCEEDING with EXHIBIT 1018 on the counsel of record for the Patent Owner by filing this document through the PTABE2E System as well as delivering a copy via electronic mail to the following address:

Barry J. Bumgardner
Brent N. Bumgardner
NELSON BUMGRDNER, P.C.
barry@nelbum.com
brent@nelbum.com
optis-IPR@nelbum.com

Dated: May 2, 2017

/Robert C. Mattson/
Robert C. Mattson (Reg. No. 42,850)