

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC
Petitioner

v.

TECHNO VIEW IP, INC.
Patent Owner

Case No. IPR20218-01045
Patent No. 8,206,218

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S.
PATENT 8,206,218 UNDER 37 C.F.R. § 42.72 AND TO KEEP
CONFIDENTIAL AND SEPARATE UNDER 35 U.S.C. § 317(b) AND 37
C.F.R. § 42.74(c)**

Pursuant to 37 C.F.R. § 42.74, Petitioner Sony Interactive Entertainment LLC (“Sony”) and Patent Owner Techno View IP, Inc. (“TVIP”) request termination of the Petition for Inter Partes Review of Claim 1 of U.S. Patent 8,206,218 (“the ‘218 Patent”) in Case IPR2018-01045.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties also jointly request that the agreement between the parties (Exhibit 1049) filed concurrently herewith (a) be treated as business confidential information, (b) be kept separate from the file of the involved patent, and (c) be made available only as permitted pursuant to the provisions of 37 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317, Sony and TVIP jointly request termination of this inter partes review. On February 8, 2019, the parties informed the Board of their agreement via email and requested authorization to file a joint motion to terminate the petition with respect to both the Patent Owner and Petitioner. As set forth in an email dated February 11, 2019, the Board authorized the filing of the requested joint motion to terminate this petition. Accordingly, the parties jointly request termination of the present proceeding.

The parties are concurrently filing a copy of the license agreement as Exhibit 1049 and request that this agreement be treated as business confidential information and kept separate pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. *See* U.S.C. § 317(b) (requiring parties to file agreements in writing). The undersigned represent that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding and that Exhibit 1049 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

II. EXPLANATION OF WHY TERMINATION IS APPROPRIATE

On July 23, 2017, Patent Owner brought a suit against Sony and several related Sony entities in the United States District Court for the Central District of California (Case No. 8:17-cv-01268), asserting infringement against Petitioner of the '218 Patent and U.S. Patent No. 7,666,096. Petitioner filed its petition for *inter partes* review of the '218 Patent on May 22, 2018. The Board issued an Institution Decision instituting this proceeding on December 4, 2018. The parties have now resolved their dispute with regards to the '218 Patent and have reached an agreement to terminate this proceeding.

Public policy favors terminating the present petition for inter partes review. Congress and federal courts have expressed a strong interest in encouraging

settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

Ending this petition for IPR early promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680 (Aug. 14, 2012). Permitting termination provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation. Additionally, termination of this petition for IPR is appropriate as the Board has not yet “decided the merits of the proceeding.” *See, e.g., Office Patent Trial Practice Guide*, 77 Fed.

Reg. 48,756, 48,768 (Aug. 14, 2012). Therefore, the parties respectfully request termination of this *Inter Partes* Review of U.S. Patent No. 8,206,218 (Case IPR2018-01045).

III. IDENTIFICATION OF RELATED PROCEEDINGS BEFORE THE OFFICE

The Parties identify Case No. IPR2018-01044, challenging U.S. Patent No. 7,666,096, as the only other known proceeding pending before the Office and note that, concurrently with this Motion, the parties are also seeking termination of that proceeding. Neither Sony nor TVIP is aware of any other pending Office proceedings involving the '218 Patent.

IV. IDENTIFICATION OF ALL PARTIES IN RELATED LITIGATION

In addition to TVIP and Sony, Sony Interactive Entertainment, Inc., Sony Interactive Entertainment America LLC, and Sony Corporation of America were named as parties (as defendants) in the Case No. 8:17-cv-01268 (C.D. Cal.), but were either dropped from the case or no longer exist. The '218 Patent has also been asserted against Facebook Technologies, LLC and Facebook, Inc. in Case No. 1:17-cv-00386 (D. Del.).

V. CONCLUSION

For the foregoing reasons, the Parties respectfully request termination of this *inter partes* review of the '218 Patent. At least due to its confidential nature, the

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