

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION
Petitioner

v.

INTELLECTUAL VENTURES II LLC
Patent Owner

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

Inter Partes Review No. 2018-01641

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandra, VA 22313-1450

Pursuant to 35 U.S.C. § 317(a), Petitioner Nokia of America Corporation (“Nokia” or “Petitioner”) and Patent Owners Intellectual Ventures II LLC (“IV” or “Patent Owner”) jointly request termination of IPR2018-01641, which is directed to U.S. Patent No 8,897,828 (the “’828 Patent”).

I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner and Patent Owner jointly request termination of this *inter partes* review pursuant to a settlement.

II. STATEMENT OF FACTS

Petitioner and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreement. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office). The Board previously provided authorization to file this motion on April 29, 2019. Ex. A. A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or

proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB July 28, 2014).

(1) Brief Explanation.

Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreements.

(2) Related Litigation

The following litigations concerning the ’828 patent are pending: *Intellectual Ventures II LLC v. Sprint Spectrum L.P. et al.* 2:17-cv-00662 (TXED) (Lead) and *Intellectual Ventures II LLC v. T-Mobile USA, Inc. et al.* 2:17-cv-00661 (TXED) both filed September 21, 2017.

(3) Related Proceedings Before the Office

Petitioner and Patent Owner are aware of the following pending *inter partes* review proceedings: *Ericsson Inc. et al v. Intellectual Ventures II LLC*, IPR2018-01694 (PTAB) and *T-Mobile USA, Inc. et al v. Intellectual Ventures II LLC*, IPR2018-01773 (PTAB).

(4) Related Litigation or Proceeding Status

Jury selection for the related litigation stated above is set for May 13, 2019.

Ex. B. Both pending *inter partes* review proceedings have been instituted: *Ericsson Inc. et al v. Intellectual Ventures II LLC*, IPR2018-01694, Paper 7 at 1 (PTAB Mar. 20, 2019) and *T-Mobile USA, Inc. et al v. Intellectual Ventures II LLC*, IPR2018-01773, Paper 9 at 1 (PTAB Apr. 22, 2019).

III. ARGUMENT

The Board should terminate this case as the parties jointly request, for the following reasons.

First, Petitioner and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding and as to the ’828 Patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Ex. C. The parties request that the settlement agreements be treated as business confidential information, and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, the parties in the present proceeding jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding.

Third, a termination of this proceeding will conserve the Board's resources and obviate the need for any more Board involvement in this matter.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this *inter partes* review of the '828 Patent.

Respectfully Submitted,

Date: April 29, 2019

/s/ Brianne M. Straka
Brianne Straka (Reg. No. 70,152)
QUINN EMANUEL URQUHART &
SULLIVAN LLP
191 N Wacker Drive Suite 2700
Chicago, Illinois 60606
Telephone: (312) 705-7400
Fax: (312) 705-7401

*Counsel for Petitioner Nokia of America
Corporation*

Date: April 29, 2019

/s/ Byron Pickard

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