

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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T-MOBILE USA, INC., T-MOBILE US, INC., SPRINT SPECTRUM L.P., and  
SPRINTCOM, INC.,

Petitioner

v.

INTELLECTUAL VENTURES II LLC

Patent Owner

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Case IPR2018-01773

Patent No. 8,897,828

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**JOINT MOTION TO TERMINATE PROCEEDING**

Sprint Spectrum L.P., SprintCom, Inc., T-Mobile USA, Inc., and T-Mobile US, Inc. (collectively, “Petitioner”) and Intellectual Ventures II LLC (“Patent Owner”) have reached a settlement and jointly request termination of IPR2018-01773 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on June 25, 2019.

### **I. Statement of Relief Requested**

Due to a settlement, Petitioner and Patent Owner jointly request termination of IPR2018-01773 under 35 U.S.C. § 317(a).

### **II. Statement of Facts**

Petitioner and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. Petitioner and Patent Owner are filing settlement agreements concurrently with this motion, along with a “Joint Request That the Settlement Agreements Be Treated as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b).” 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 (P.T.A.B. July 28, 2014).

(1) Brief Explanation.

Termination is appropriate in this case because the parties have settled their dispute. A “Joint Request That the Settlement Agreements Be Treated as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b)” is being filed concurrently with this motion.

(2) Related Litigation.

The '828 Patent is subject to pending lawsuits entitled *Intellectual Ventures II LLC v. T-Mobile USA, Inc. et al.*, Case No. 2:17-cv-661-JRG (E.D. Tex.) and *Intellectual Ventures II LLC v. Sprint Spectrum L.P. et al.*, Case No. 2:17-cv-662-JRG (E.D. Tex.) in which T-Mobile USA, Inc., T-Mobile U.S., Inc., and Sprint Spectrum L.P.,<sup>1</sup> respectively, are defendants (the “Litigation”).

(3) Related Proceedings Before the Office.

In addition to IPR2018-01773, Petitioner and Patent Owner are aware of the following now-terminated *inter partes* review proceedings involving the '828 Patent: *Ericsson Inc. v. Intellectual Ventures II, LLC*, IPR2018-01694 (P.T.A.B.);

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<sup>1</sup> Nextel Operations, Inc. (“Nextel”) is also a named defendant in the Litigation.

Nextel has merged with SprintCom, Inc., and no longer exists.

and *Nokia of America Corporation v. Intellectual Ventures II LLC*, IPR2018-01641 (P.T.A.B.).

(4) Status of Related Litigation and Proceedings Before the Office.

The Litigation was dismissed on June 24, 2019, pursuant to a joint stipulation between the parties. *See Intellectual Ventures II LLC v. Sprint Spectrum L.P. et al.*, Case No. 2:17-cv-662-JRG, Dkt. 546 (E.D. Tex., June 24, 2019). The Board has instituted trial in all of the above-referenced *inter partes* review proceedings.

### III. Argument

The Board should terminate this *inter partes* review 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 § 317(a), an *inter partes* review “shall” be terminated upon a 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 § 317(a).

Second, the parties have reached a settlement as to all the disputes in this proceeding. True copies of the applicable settlement agreements are filed concurrently herewith. *See Exs. 1011 & 1012*. 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). 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 this 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 these reasons, Petitioner and Patent Owner respectfully request termination of this *inter partes* review of the '828 patent.

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