

IPR2018-01820
Patent No. 7,956,736

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IPDATATEL, LLC; ALULA HOLDINGS, LLC; AND
RESOLUTION PRODUCTS, LLC;
Petitioner,
v.
ICN ACQUISITION, LLC,
Patent Owner

Case No. IPR2018-01820
Patent No. 7,956,736

Filed and Served: July 3, 2019

JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Patent Owner ICN Acquisition, LLC and Petitioners ipDataTel, LLC; Alula Holdings, LLC; and Resolution Products, LLC jointly request termination of this *inter partes* review (“IPR”) concerning U.S. Patent No. 7,956,736 (“the “Patent-in-Review”) with respect to both Patent Owner and Petitioners. On July 2, 2019, the Board authorized the Parties to file this joint motion to terminate.

The Parties have agreed to settle their dispute and have reached a written agreement (the “Settlement Agreement”) to terminate this IPR, subject to the Board’s approval. The Petitioners are filing, confidentially, a true and correct copy of the Settlement Agreement contemporaneously herewith as Exhibit 1048. There are no collateral agreements or understandings in connection with, or in contemplation of, the termination of this proceeding. The Petitioners are also filing a joint request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the Patent-in-Review, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). It is understood that the Settlement Agreement as filed shall be available only to (1) a Government agency on written request to the Board; or (2) any person upon written request to the Board to make the Settlement Agreement available, along with the fee specified in 37 C.F.R. § 42.15(d) and on a showing of good cause. The parties represent that they have complied with all requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

The Petitioners filed their petition on September 28, 2018, and Patent Owner filed a preliminary response on January 18, 2019. The Board instituted review on all claims of the Patent-in-Review on April 17, 2019. The Patent Owner's response is due July 10, 2019.

Termination of this proceeding is proper because the proceeding is in its early stages. The Board has only recently instituted trial, and Patent Owner has not yet filed its Patent Owner Response. Thus, the Board has not yet "decided the merits of the proceeding before the request for termination is filed." 35 U.S.C. § 317(a); Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding."); *see also Oracle Corp. v. Community United IP, LLC*, Case No. CBM2013-00015, Paper No. 13 (PTAB Jul. 25, 2013) (citing, 77 Fed. Reg. 48768 (Aug. 14, 2012)).

The Parties were also involved in litigation before the United States District Court for the Southern District of Texas under the caption *Alarm.com Incorporated and ICN Acquisition, LLC v. ipDataTel*, Civil Action No. 4:18-cv-02108, which concerned the Patent-in-Review. The parties are contemporaneously seeking dismissal of that lawsuit.

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For the reasons described above, the Parties respectfully request termination
of this proceeding.

Dated: July 3, 2019

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on July 3, 2019, I caused a true and correct copy of the Joint Motion to Terminate to be served via email, as a PDF attachment, to counsel for the Patent Owner, as follows:

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Dated: July 3, 2019

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