

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

Case No. IPR2020-01157

U.S. Patent No. 7,274,933

Joint Motion to Terminate Proceedings

I. INTRODUCTION

Petitioner Dell Inc. (“Dell”) and Patent Owner 3G Licensing S.A. (“3G”) have reached a settlement as to all the disputes in this proceeding. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Dell and 3G (the Parties) jointly move to terminate the present *inter partes* review proceeding.

II. STATEMENT OF FACTS

Dell and 3G have reached a Settlement and License Agreement (“Agreement”) to resolve the Parties’ disputes at issue in this proceeding. The Agreement settles this proceeding. Pursuant to the Agreement, Dell will no longer be participating in IPR2020-1157 and there are no remaining Petitioners for this IPR. The Agreement also settles the Parties’ dispute in related District Court litigation: *Sisvel Int’l S.A. v. Dell, Inc.*, C.A No. 1:19-cv-01247-LPS (D. Del.). The Parties are filing a joint motion to dismiss the litigation. No litigation or other proceeding between the parties involving the ’933 patent or any related patent is contemplated in the foreseeable future.

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Agreement is in writing, and a true and correct copy is being filed as Exhibit 1034. The Agreement is being filed electronically with access to “Board Only.” A “Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate

to treat the Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

III. TERMINATION IS APPROPRIATE

First, termination is proper under 35 U.S.C. § 317(a) because the parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding[.]” 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). Under § 317(a), a decision on the merits is something beyond a decision instituting trial or a decision offering preliminary guidance. In this proceeding, no decision on the merits has been made; the present motion is being submitted prior to oral argument and a decision. Accordingly, the Parties are entitled to terminate these proceedings under upon joint request.

Second, the Parties have reached a settlement as to all the disputes in this proceeding. A true copy of the Agreement is filed concurrently herewith. *See* Confidential Exhibit 1034. No other such agreements, written or oral, exist between or among the Parties relating to this proceeding. The Parties thus satisfy the requirements of 35 U.S.C. § 317(b).

Third, “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” 77 Fed. Reg. 48,756, 48,768 (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.” *Id.* (citing 35 U.S.C. §§317(a)). Termination would save significant further expenditure of resources by the Parties and the Board. Termination as requested would also further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage future settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

IV. CONCLUSION

For the foregoing reasons, the Parties respectfully request that the Board terminate this *inter partes* review.

DATED: December 10, 2021

Respectfully Submitted,

/Brian M. Buroker/

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