

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLEARWIRE CORPORATION and CLEAR WIRELESS LLC
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC
Patent Owner

Case IPR2013-00306
Patent 5,590,403

Before HOWARD B. BLANKENSHIP, JONI Y. CHANG, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

JUDGMENT
Termination of Proceeding
37 C.F.R. § 42.73

On March 7, 2013, the parties filed a joint motion to terminate the instant proceeding pursuant to a settlement agreement. Paper 24. The parties also filed a true copy of their written settlement agreement, made in connection with the termination of the instant proceeding, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 1020. Additionally, the parties submitted a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 25.

The Board instituted the instant *inter partes* review of US Patent No. 5,590,403 (“the ’403 patent”) on October 22, 2013. Paper 12. Although a patent owner response has been filed (Paper 22), Petitioner has not filed a reply and no final hearing has been held.

In their joint motion to terminate, the parties indicate that they have settled their dispute, and reached agreement to terminate the instant proceeding. Paper 24, 2. Under the terms of their agreement, the parties and their affiliates, which include Sprint Nextel Corporation (the parent company of Petitioner), also are required to dismiss with prejudice all claims and counterclaims asserted in the related litigations. *Id.* at 9. Apple and T-Mobile will remain as defendants in other related litigations that involve the ’403 patent. *Id.* They could have, but did not, file a petition for *inter partes* review of the ’403 patent. *Id.* And there is no pending motion for joinder of another *inter partes* review with the instant proceeding. *Id.*

The parties urge the Board to terminate this instant proceeding with respect to both Petitioner and Patent Owner. *Id.* at 3. The parties submit that termination is appropriate because the issues raised during the trial have not been briefed fully and the Board has not yet decided the merits of the

proceeding. *Id.* Petitioner indicates that it will no longer participate even if the Board does not terminate the instant proceeding. *Id.* at 3. That means Petitioner would not file a reply to the patent owner response, nor conduct any cross-examination of Patent Owner’s expert witness. *Id.* at 3-4. Any future motions filed by Patent Owner also would be unopposed. *Id.* at 7.

According to the parties, Congress intended the Board to act as an adjudicator, not as an examining official, to resolve quickly patent disputes between the parties in an *inter partes* review. *Id.* at 6 (citing Statement of Sen. Kyl, 157 congressional Record S1376, daily ed. March 8, 2001 (“Among the reforms that are expected to expedite these proceedings are *the shift from an examinational to an adjudicative model . . .*” (emphasis added by the parties))). The parties maintain that proceeding to a final written decision under 35 U.S.C. § 317(a) in the instant proceeding would seem contrary to legislative intent. *Id.* at 7.

Upon consideration of the parties’ contentions, we agree with the parties that terminating the instant proceeding with respect to both Petitioner and Patent Owner, at this early juncture, promotes efficiency and minimizes unnecessary costs. Based on the facts of this case, it is appropriate to enter judgment¹ without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the joint motion to terminate IPR2013-00306 is *granted*;

¹ A *judgment* means a final written decision by the Board, or a *termination of a proceeding*. 37 C.F.R. § 42.2.

FURTHER ORDERED that the instant proceeding is hereby *terminated* as to all parties, including Petitioner and Patent Owner; and

FURTHER ORDERED that the parties' joint request that the settlement and agreement be treated as business confidential information kept separate from the patent file, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*.

PETITIONERS:

Tawni L. Wilhelm (Lead Counsel)
Albert F. Harris III (Back-up Counsel)
SHOOK, HARDY & BACON L.L.P.
twilhelm@shb.com
afharris@shb.com

PATENT OWNER:

John R. Kasha (Lead Counsel)
KASHA LAW LLC
john.kasha@kashalaw.com

Craig Steven Jepson (Back-up Counsel)
REED & SCARDINO LLP
cjepson@reedscardino.com