Trials@uspto.gov
571-272-7822

Paper No. 8
Entered January 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

TELECOMMUNICATIONS SYSTEMS INC.,
Patent Owner.

Case IPR2015-00194
Patent 8,682,362 B2

Before MICHAEL R. ZECHER, PETER P. CHEN, and CHARLES J. BOUDREAU, *Administrative Patent Judges.*

BOUDREAU, *Administrative Patent Judge*.

DECISION
Termination of the Proceeding
37 C.F.R. § 42.72

I. DISCUSSION

On January 13, 2015, the parties filed a Joint Motion (Paper 5) to terminate this proceeding pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, a true copy of a written settlement agreement from a related matter (Ex. 1025), and a Joint Request (Paper 6) to have that settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties indicated in their Joint Motion that termination of this proceeding concerning U.S. Patent No. 8,682,362 B2 ("the '362 patent") is appropriate because an agreement has been reached regarding a dispute with respect to related U.S. Patent No. 6,985,748 B2 ("the '748 patent"). Paper 5, 2–3. The parties further indicated that a joint stipulation for dismissal with prejudice of the co-pending district court litigation involving the '748 patent was filed on January 8, 2015, and that said joint stipulation was entered by the Court on January 9, 2015. *Id*. at 2. The parties did not identify any other related district court litigations involving the '748 patent or the '362 patent.

Under 35 U.S.C. § 317(a), "[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." As the parties indicate in their Joint Motion, this proceeding is in its early stages. Paper 5, 2–3. Patent Owner, Telecommunication Systems Inc., has not filed a Preliminary Response, and we have not instituted a review.

Further, under 37 C.F.R. § 42.74(b), "[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a

true copy shall be filed with the Board before termination of the trial." As the parties have filed the written settlement agreement, and the co-pending district court litigation was dismissed with prejudice, we determine that it is appropriate to terminate this proceeding without rendering a Final Decision as to the patentability of claims 1–25 of the '362 patent. *See* 37 C.F.R. §§ 42.72–.74.

II. ORDER

Accordingly, it is:

ORDERED that the parties' Joint Request that the settlement agreement (Ex. 1025) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

ORDERED that the parties' Joint Motion to terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

For PETITIONER:

Joseph Micallef
Jeffrey Kushan
Sidley Austin LLP
jmicallef@sidley.com
sidleymsintercarriercommIPR@sidley.com

For PATENT OWNER:

Timothy Devlin
Xiyan Zhang
Devlin Law Firm LLC
tdevlin@devlinlawfirm.com
xzhang@devlinlawfirm.com