

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

OZMO LICENSING LLC,
Patent Owner.

U.S. Patent 9,264,991
Issue Date: February 16, 2016

Title: APPARATUS AND METHOD FOR INTEGRATING SHORT-RANGE
WIRELESS PERSONAL AREA NETWORKS FOR A WIRELESS LOCAL
AREA NETWORK INFRASTRUCTURE

Inter Partes Review No.: IPR2023-00193

JOINT MOTION TO TERMINATE THE PROCEEDING

I. INTRODUCTION

Petitioner and Patent Owner jointly submit this motion to terminate IPR2023-00193. 37 C.F.R. §§ 42.71(a), 42.72. The parties conferred at least on March 4, 2024, agreed to this motion, and further submitted to the Board a request to file this motion. On March 5, 2024, the Board authorized this joint motion.

The Board has discretion to grant this motion and terminate this review. 37 C.F.R. § 42.71(a); 35 U.S.C. § 317(a). The parties respectfully request that the Board terminate the proceeding for the good cause shown herein. Specifically, both parties seek to conserve and reallocate their resources.

Termination will achieve a just, speedy, and inexpensive resolution of the dispute. The trial phase has not concluded, the Board has not held oral argument, decided the merits of the IPR, and has not issued any final decision. Preservation of resources would be real and substantial for the Board and the parties.

II. ARGUMENT

Good cause exists to terminate this proceeding. The Parties seek to conserve and reallocate their resources. Neither party would be prejudiced by dismissal and the Board's subsequent termination of this matter. Additionally, the termination of this proceeding will not affect any other proceedings before the Board. The '991 Patent is not involved in any other instituted proceeding before the Board.

The Board has broad authority to terminate a petition under 37 C.F.R.

§§ 42.71(a) and 42.5(a), even at an advanced stage of the proceeding. *See, e.g., Google LLC v. Jawbone Innovations LLC*, IPR2022-00797, Paper 25 at 2-4 (Aug. 2, 2023) (terminating a proceeding where termination was jointly requested by the parties after completing all briefing where the “Board has not decided the merits,” nor “conducted an oral argument.”); *Amazon.com, Inc. v. Vocalife LLC*, IPR2021-01331, Paper 27 at 2-4 (Nov. 16, 2022) (terminating proceeding after briefing was completed upon the joint motion of the parties); *Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 at 4, 8-9 (Oct. 9, 2018) (“[T]he regulations expressly provide the Board with broad authority to dismiss a petition where appropriate” and dismissing, among other reasons, since it was an “inefficient use of the Board’s resources”); *Nevakar, Inc. v. Cipla LTD.*, IPR2019-01446, Paper 15 at 2 (Apr. 20, 2020) (terminating the instituted proceeding where ““the parties have decided not to proceed with this IPR”” and “a final written decision has not been entered”). Ending this petition for IPR promotes the Congressional goal of establishing a more efficient patent system. *See* Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012). The Board can conserve its resources by terminating now.

The parties are not aware of any example wherein the Board found that it could not—or would not—terminate a proceeding under the present circumstances.

For example, while one Board panel denied a joint motion to terminate, that Board noted that the parties, while seeking termination, requested that the Board first enter a pending motion to amend claims. *Blackberry Corp. et al. v. MobileMedia Ideas LLC*, IPR2013-00016, Paper 31 at 2-3 (Dec. 11, 2013). That is not the case here; there is no motion to amend the claims, nor would there be any other issue remaining for the Board to decide in this proceeding. The parties' joint request for dismissal and termination of the proceedings is voluntary and consistent with precedent.

The parties further confirm that, beyond conferring with Patent Owner regarding its joining in the filing of this motion, there are no agreements between the parties, written or otherwise.

Termination would save the Board and the parties the time and resources needed to take IPR2023-00193 through oral argument and final written decision.

III. CONCLUSION

The Board should terminate IPR2023-00193.

Dated: 06 March 2024

Respectfully submitted,

BY: / John M. Baird /
John M. Baird
Reg. No. 57,585
DUANE MORRIS LLP

BY: /Lawrence P. Cogswell III /
Lawrence P. Cogswell III, Ph.D.
Reg. No. 71,441
Hamilton, Brook, Smith & Reynolds, P.C.

Attorney for Petitioner

Attorney for Patent Owner

CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on the 6th March 2024, a complete and entire copy of this **Joint Motion To Terminate The Proceeding** was served via e-mail to Patent Owner by serving the following correspondence email addresses:

Lawrence P. Cogswell III, Ph.D. (lawrence.cogswell@hbsr.com)
Timothy J. Meagher (timothy.meagher@hbsr.com)
Ronald R. Demsher (ronald.demsher@hbsr.com)
Keith J. Wood (keith.wood@hbsr.com)
Daniel A. Fleisher (daniel.fleisher@hbsr.com)
Hamilton, Brook, Smith & Reynolds, P.C.

Respectfully submitted,

DUANE MORRIS LLP

BY: / John M. Baird /
John M. Baird
USPTO Reg. No. 57,585
DUANE MORRIS LLP
901 New York Avenue, NW,
Suite 700-East,
Washington, D.C. 20001
P: (202) 776-7819
F: (202) 379-9850
JMBaird@duanemorris.com

ATTORNEY FOR PETITIONER