UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) Inc.,

Petitioner,

v.

WSOU Investments LLC D/B/A Brazos Licensing and Development,

Patent Owner.

Case No. IPR2023-00498

U.S. Patent No. 8,767,614

JOINT MOTION TO TERMINATE PROCEEDINGS

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner ZTE (USA), Inc. ("Petitioner") and Patent Owner WSOU Investments LLC D/B/A Brazos Licensing and Development ("Patent Owner") jointly request that this *inter partes* review proceeding involving U.S. Patent No. 8,767,614 ("the '614 patent") be terminated based on an agreement between Petitioner and Patent Owner ("the Parties").

Patent Owner and Petitioner have entered into an agreement which resolves the disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 8,767,614. Petitioner and Patent Owner have settled their dispute regarding the '614 patent, including both this proceeding and Patent Owner's assertion of the '614 Patent in the related district court litigation, *WSOU Investments LLC v. ZTE Corporation et al.*, 6:22-cv-00136 (W.D. Tex.). Petitioner and Patent Owner submit a true copy of that confidential agreement in its entirety, filed herewith. Petitioner and Patent Owner further submit a true copy of a confidential release signed by the Parties, filed herewith. The Parties do not anticipate any further litigation between them concerning the '614 patent. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceeding.

II. REASONS FOR GRANTING THE MOTION

Generally, 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*, *e.g.*, Consolidated Trial Practice Guide, 86 (Nov. 2019). The Board's policy is in accord with the governing statute, which states that "An inter partes review instituted under this chapter ***shall be terminated*** with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." 35 U.S.C. § 317(a). The Board has not decided the merits of this proceeding.

The Board authorized filing of the instant motion on August 16, 2023. The Board required that: (1) the Joint Motion must update the Board concerning the status of any related litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office involving the subject patent; and (2) the Joint Motion also must include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceeding. Guidance as to the content of a motion to terminate is also provided in *Apotex Cop. v. Alcon Research, Ltd.*, IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is

appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id*. at 2. This motion satisfies each of the above requirements.

A. Brief Explanation of Why Termination is Appropriate

Good cause exists to terminate this proceeding because the Parties have settled their dispute regarding the ’614 patent and the Board has not determined the merits of the proceeding. Terminating this proceeding thus serves the interests of judicial economy as well as the mutual interests of the Parties.

Termination is appropriate because oral argument has not been held, and the Board has not decided the merits of the proceeding, i.e., a final written decision has not been issued. Under 35 U.S.C. § 317(a), this proceeding “shall be terminated” because the Parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” The Parties have resolved their disputes and executed an agreement which contemplates requesting termination of this proceeding and dismissing the Parties’

related proceeding regarding the ’614 patent in *WSOU Investments LLC v. ZTE Corporation et al.*, 6:22-cv-00136 (W.D. Tex.).

B. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigation is related to the ’614 patent and the Parties:

- *WSOU Investments LLC v. ZTE Corporation et al.*, 6:22-cv-00136 (W.D. Tex.)

The ’614 patent is also the subject of concurrent litigation between Patent Owner and Oneplus Technology, (“Oneplus”) in the Western District of Texas: *WSOU Investments, LLC d/b/a Brazos Licensing and Development v. Oneplus Technology (Shenzhen Co., Ltd.)*, Case No. 6:20-cv-00953 (W.D. Tex.) (“the Oneplus Litigation”). Petitioner is not a party to the Oneplus Litigation. A Jury Trial is set for March 11, 2024 for the Oneplus Litigation.

C. Related Proceedings Currently Before the Office

The parties are not aware of any related proceedings currently before the Office.

III. AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties’ agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and correct copy is being filed concurrently

herewith[1]. The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat this agreement as business confidential information and keep it separate from the files of the ’614 patent. The Parties certify that there are no other agreements or understanding, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

IV. CONCLUSION

For all these reasons, the Parties respectfully request termination of this proceeding.

Dated: August 21, 2023

Respectfully submitted,

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[1] The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to “Parties and Board.”

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Joint Motion to Terminate Proceedings** was served on August 21, 2023, via email directed to counsel of record for the Patent Owner at the following:

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Dated: August 21, 2023

By: /Daniel E. Doku/
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, L.L.P.