

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner

v.

VOIP-PAL.COM, INC.,  
Patent Owner

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IPR2023-00649  
Patent No. 10,880,721

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**JOINT MOTION TO TERMINATE**

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board on June 8, 2023, Petitioner Google LLC (“Petitioner”) and Patent Owner VoIP-Pal.com, Inc. (“Patent Owner”) jointly request termination of this proceeding, IPR2023-00649, directed to U.S. Patent No. 10,880,721. Petitioner and Patent Owner are concurrently filing requests to terminate related proceedings involving this patent and a related patent, U.S. Patent No. 8,630,234, specifically IPR2023-00647, IPR2023-00648, and IPR2023-00650.

Petitioner and Patent Owner have settled their dispute regarding U.S. Patent Nos. 8,630,234 and 10,880,721, including both this proceeding and Patent Owner’s assertion of U.S. Patent Nos. 8,630,234 and 10,880,721 in the related district court litigations, *VoIP-Pal.com, Inc. v. Google, LLC*, Case No. 3-22-cv-05419 (N.D. Cal.) and *VoIP-Pal.com, Inc. v. Google, LLC*, Case No. 3:22-cv-03199 (N.D. Cal.). The parties do not anticipate further litigation between them concerning U.S. Patent Nos. 8,630,234 and 10,880,721. The following related proceedings are currently before the Board: IPR2022-01231, -01232, -01234, -01235; IPR2022-01390, -01391, -01392, -01393; IPR2023-00638, -00639, -00640, -00641.

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the U.S. Patent Nos. 8,630,234 and 10,880,721 and the proceeding is still at an early stage (*i.e.*, the Board has not yet issued an institution decision or ruled on Google’s motion for joinder). Terminating the

proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

A true and correct copy of the parties' settlement agreement will be filed as Exhibit 1032, along with a joint motion to treat the settlement agreement as business confidential information.

Respectfully submitted,

June 12, 2023

By: /Naveen Modi/  
Naveen Modi (Reg. No. 46,224)  
Counsel for Petitioner

By: /Lewis E. Hudnell, III/  
Lewis E. Hudnell, III (Reg. No. 51,185)  
Counsel for Patent Owner

## **CERTIFICATE OF SERVICE**

I hereby certify that on June 12, 2023, I caused a true and correct copy of the foregoing Joint Motion to Terminate to be served on the Patent Owner at the following correspondence address of record:

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