

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH CORPORATION,

Patent Owner

Case: IPR2023-01271

U.S. Patent No. 7,283,839

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW
UNDER 37 C.F.R. 42.72**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

UPDATED LIST OF EXHIBITS

Exhibit ("Ex.")	Description
1001	U.S. Patent No. 7,283,839 ("839")
1002	File History of U.S. Patent No. 7,283,839 ("839FH")
1003	Declaration of Dr. Madisetti in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,283,839 ("Madisetti")
1004	(Reserved)
1005	U.S. Patent No. 8,020,105 ("Lemay")
1006	U.S. Patent No. 7,765,263 ("Alfke")
1007	P.C.T. Patent App. Publication No. W.O. 2003/056789 ("Maguire")
1008	U.S. Patent Publication No. 2002/0152220 ("Kang")
1009	Network Working Group, Internet Engineering Task Force (IETF), Request For Comments (RFC): 2822, Internet Message Format (2001) ("RFC2822")
1010	Declaration of Nathaniel E. Frank-White dated April 26, 2023
1011	U.S. Patent No. 6,359,877 ("Rathonyi")
1012	U.S. Patent Publication No. 2003/0229672 ("Kohn")
1013	U.S. Patent Publication No. 2003/0220978 ("Rhodes")
1014	U.S. Patent Publication No. 2005/0275633 ("Varanda")
1015	U.S. Patent Publication No. 2004/0137884 ("Engstrom")
1016	P.C.T. Patent App. Publication No. W.O. 2004/056137 ("Nielson")
1017	U.S. Patent Publication No. 2001/0021649 ("Kinnunen")

Exhibit ("Ex.")	Description
1018	Network Working Group, Internet Engineering Task Force (IETF), Request For Comments (RFC): 2779, Instant Messaging / Presence Protocol Requirements (2000) ("RFC2779")
1019	3GPP Technical Specification 24.011 version 5.2.0, Point-to-Point (PP) Short Message Service (SMS) Support on Mobile Radio Interface (2003)
1020	3GPP Technical Specification 23.140 version 6.4.0, Multimedia Messaging Service (MMS); Functional Description; Stage 2 (2003)
1021	Wireless Application Protocol (WAP), MMS Encapsulation Protocol version Jan. 5, 2002 (2002) ("WAP MMS Encapsulation Protocol")
1022	Network Working Group, Internet Engineering Task Force (IETF), Request For Comments (RFC): 1889, RTP: A Transport Protocol for Real-Time Applications (1996) ("RFC1889")
1023	U.S. Patent Publication No. 2005/0193345 ("Klassen")
1024	U.S. Patent No. 7,383,307 ("Kirkland")
1025	U.S. Patent Publication No. 2004/0097248 ("Schmidt")
1026	U.S. Patent No. 6,333,973 ("Smith")
1027	Joint Claim Construction and Prehearing Statement, <i>Pantech Corp. et al. v. LG Electronics Inc. et al.</i> , Case 5:22-cv-00113-RWS-JBB (E.D. Texas), Dkt. No. 118.
1028	Docket Navigator "Time to Trial" report for Judge Robert W. Schroeder
1029	Claim Construction Expert Report of Charles Mauro CHFP Concerning Certain Terms of U.S. Patent Nos. 7,283,839 And

Case IPR2023-01271

Patent No. 7,283,839

Joint Motion to Terminate *Inter Partes* Review Under 37 C.F.R. 42.72

Exhibit ("Ex.")	Description
	9,575,631, <i>Pantech Corp. et al. v. LG Electronics Inc. et al.</i> , Case 5:22-cv-00113-RWS-JBB (E.D. Texas) (June 23, 2023).
1030	Third Amended Docket Control Order, <i>Pantech Corp. et al. v. LG Electronics Inc. et al.</i> , Case 5:22-cv-00113-RWS-JBB (E.D. Texas), Dkt. No. 98.
1031	USCourts.gov "U.S. District Court – Judicial Caseload Profile" for Eastern District of Texas
1032-1034	(Reserved)
1035	Declaration of Jonathan Bradford
1036-1300	Reserved
1301	Settlement Agreement (Confidential)

I. INTRODUCTION

Pursuant to 37 C.F.R. 42.72, Pantech Corporation (“Patent Owner”) and LG Electronics Inc. (“Petitioner”), by and through their respective counsel of record, jointly request dismissal and termination of the petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 7,283,839 in IPR2023-01271.

On August 13, 2024, the Parties informed the Board via email that the Parties entered into a confidential settlement agreement that resolves all underlying disputes between the Parties with respect to the ’839 patent and requested authorization to file a motion to terminate the petition with respect to both the Patent Owner and the Petitioner and a motion to keep the agreement confidential and separate from the file of the ’839 patent. As set forth in an email dated August 13, 2024, the Board authorized the filing of the requested motion to terminate this petition and motion to keep the agreement confidential and separate. Accordingly, the Parties jointly request termination of the present proceeding.

II. ARGUMENT

IPR proceedings “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); *see also id.* (“If no petitioner remains in the inter partes review, the Office

may terminate the review....”).

A. Termination is Appropriate

Petitioner and Patent Owner have entered into a written confidential agreement that fully resolves this matter. The Parties are concurrently filing a copy of the agreement as Exhibit 1301 along with a motion to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1301 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1301 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The parties “may terminate the proceeding . . . unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, 4 (November 2019); *see also* 35 U.S.C. § 317(a). The Board has not decided the merits of this proceeding. This proceeding is still in its early stages. Petitioner

has yet to file its Reply. The parties have now settled their dispute and have reached agreement to terminate the Petition.

Public policy favors terminating the present petition for IPR. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 86 (Nov. 2019).

B. Status of Related Litigation

This *Inter Partes* Review is related to *Pantech Corp. v. LG Electronics Inc.*, 5:23-cv-00091-RWS-JBB (E.D. Tex.). That proceeding has also been resolved.

C. Identification and Status of Related Proceedings Before the USPTO

LG filed its petition for *Inter Partes* Review (Paper No. 1) on August 11, 2023,

Case IPR2023-01271

Patent No. 7,283,839

Joint Motion to Terminate *Inter Partes* Review Under 37 C.F.R. 42.72

the Board issued a Decision to Institute (Paper No. 8) on March 8, 2024, and Pantech filed its Objections to Evidence (Paper No. 10) on March 22, 2024 and its Patent Owner's Response on June 7, 2024 (Paper No. 14). No other substantive papers have been filed since Institution. The Parties have now resolved their dispute and reached agreement to terminate this proceeding. Additionally, there are no other pending USPTO proceedings regarding the '839 patent. And the Parties do not anticipate further litigation between them concerning the '839 patent. The parties are also concurrently filing similar motions to terminate proceedings with respect to all of the IPRs pending between the parties, including this proceeding—namely, IPR2023-01267 through -01273.

The USPTO can conserve its resources by terminating now, removing the need for the Board to further consider the arguments and to render a Final Decision. Therefore, the Parties respectfully request termination of this *Inter Partes* Review of the '839 patent.

Dated: August 16, 2024

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Case IPR2023-01271

Patent No. 7,283,839

Joint Motion to Terminate *Inter Partes* Review Under 37 C.F.R. 42.72

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Case IPR2023-01271

Patent No. 7,283,839

Joint Motion to Terminate *Inter Partes* Review Under 37 C.F.R. 42.72

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that a true and correct copy of this **JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW UNDER 37 C.F.R. 42.72** was served by electronic mail to the attorneys of record, at the following addresses:

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Respectfully submitted,

Date: August 16, 2024

By: /James L. Davis, Jr./

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