

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH WIRELESS, LLC,

Patent Owner

Case: IPR2023-01272

U.S. Patent No. 9,065,486

**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. 9,065,486 ("’486")
1002	File History of U.S. Patent No. 9,065,486 ("’486 FH)
1003	Declaration of Dr. Bertrand Hochwald in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,065,486 ("Hochwald")
1004	Declaration of Friedhelm Rodermund in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,065,486 ("Rodermund")
1005	U.S. Patent No. 7,260,770 ("Stewart")
1006	R1-01-1014, "A New Hybrid-ARQ Scheme Using Incremental Redundancy," submitted by Motorola for 3GPP Meeting R1-ah-22010 (Nov 5-7, 2001) ("Motorola")
1007	R1-01-1047, "Overview of Proposed Schemes for Incremental Redundancy," submitted by Ericsson for 3GPP Meeting R1-ah-22010 (Nov 5-7, 2001) ("3GPP-Summary")
1008	3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Multiplexing and channel coding (FDD) (Release 5) (3GPP TS 25.212 version 5.1.0)
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1015	U.S. Patent No. 6,356,601 ("Chen")
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1017	File History of U.S. Patent No. 8,074,143
1018	File History of U.S. Patent No. 8,359,520
1019	File History of U.S. Patent No. 8,788,920
1020	[Reserved]
1021	[Reserved]
1022	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.
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1024	USCourts.gov "U.S. District Court – Judicial Caseload Profile" for Eastern District of Texas
1025	The Authoritative Dictionary of IEEE Standard Terms, 7 th Edition
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1027	U.S. Patent Application Publication No. 2005/0094667 ("Dahlman-667")
1028	U.S. Patent No. 7,372,837 ("Kinjo")
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1031	U.S. Patent No. 6,760,365 ("Demir")
1032	E.P. Patent No. 1209856 ("Miya")
1033	U.S. Patent No. 6,754,253 ("Guey")
1034	U.S. Patent No. 6,760,600 ("Nickum")
1035	U.S. Patent No. 6,515,980 ("Bottomley")
1036	3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Multiplexing and channel coding (FDD) (3GPP TS 25.212 version 3.5.0 Release 1999)
1037	Ghosh et al., "Incremental Redundancy (IR) Schemes for W-CDMA HS-DSCH"
1038	U.S. Patent No. 6,744,744 ("Tong")
1039	U.S. Patent No. 7,170,849 ("Arivoli")
1040	U.S. Patent Application Publication No. 2004/0037224 ("Choi")
1041	U.S. Patent No. 7,286,540 ("Kim-540")
1042	U.S. Patent No. 7,362,733 ("Kim-733")
1043	Frenger et. al., "Performance Comparison of HARQ with Chase Combining and Incremental Redundancy for HSDPA"
1044	U.S. Patent No. 6,671,851 ("Moulsley")
1045	R1-01-1014 Metadata
1046	U.S. Patent No. 8,074,143 ("143 patent")

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1047	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.
1048	Declaration of Jonathan Bradford
1049- 1050	Reserved
1051	Webpage, available at https://archive.org/legal/affidavit.php
1052	Internet Archive Capture, available at https://web.archive.org/web/20020126155238/http://www.3gpp.org:80/TB/home.htm
1053	Internet Archive Capture, available at https://web.archive.org/web/20020926134824/http://www.3gpp.org:80/
1054	Internet Archive Capture, available at https://web.archive.org/web/20021015011140/http://www.3gpp.org:80/TB/RAN/RAN1/RAN1.htm
1055	Internet Archive Capture, available at https://web.archive.org/web/20020806041024/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/
1056	Internet Archive Capture, available at https://web.archive.org/web/20020403145941/http://www.3gpp.org:80/ftp/tsg_ran/WG1_RL1/R1_Ad_Hocs/HSDPA_Ad_Hoc/
1057	Excel file "work_plan_3gpp_020926.xls," retrieved from https://web.archive.org/web/20060625054352/http://www.3gpp.org/ftp/Information/WORK_PLAN/older_versions/work_plan_3gpp_020926.zip (work_plan_3gpp_020926.xls in work_plan_3gpp_020926.zip)

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1058	Webpage, available at ftp.3gpp.org/Specs
1059	Internet Archive Capture, available at https://web.archive.org/web/20020806115924/http://www.3gpp.org/Default.htm
1060	Internet Archive Capture, available at https://web.archive.org/web/20020802092436/http://www.3gpp.org/specs/specs.htm
1061	Internet Archive Capture, available at https://web.archive.org/web/20020806054349/http://www.3gpp.org/specs/numbering.htm
1062	Internet Archive Capture, available at https://web.archive.org/web/20020806092102/http://www.3gpp.org/specs/titles-numbers.htm
1063	Word file entitled "3GPP specifications - List of all specification numbers and titles," retrieved from https://web.archive.org/web/20071101043800/http://www.3gpp.org/specs/3GPP-Spec-Titles.zip (3GPP-Spec-Titles.doc in 3GPP-Spec-Titles.zip)
1064	Internet Archive Capture, available at https://web.archive.org/web/20021015011140/http://www.3gpp.org/TB/RAN/RAN1/RAN1.htm
1065	Internet Archive Capture, available at https://web.archive.org/web/20021022011153/http://www.3gpp.org/TB/RAN/RAN1/specs.htm
1066	Internet Archive Capture, available at https://web.archive.org/web/20020628215611/http://www.3gpp.org/ftp/specs/archive/

Exhibit ("Ex.")	Description
1067	Internet Archive Capture, available at https://web.archive.org/web/20020701091801/http://www.3gpp.org:80/ftp/specs/archive/25_series/
1068	Internet Archive Capture, available at https://web.archive.org/web/20020912200940/http://www.3gpp.org:80/ftp/Specs/archive/25_series/25.212/
1069	Internet Archive Capture, available at https://web.archive.org/web/20020803112613/http://www.3gpp.org/ftp/Specs/latest/
1070	Internet Archive Capture, available at https://web.archive.org/web/20020804015202/http://www.3gpp.org/ftp/Specs/latest/Rel-5/
1071	Internet Archive Capture, available at https://web.archive.org/web/20020812090150/http://www.3gpp.org:80/ftp/Specs/latest/Rel-5/25_series/
1072	Internet Archive Capture, available at https://web.archive.org/web/20051103081215/http://list.3gpp.org/scripts/wa.exe?SUBED1=3gpp_tsg_ran_wg1&A=1
1073	Webpage, available at https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_AH/HSDPA_Ad_Hoc/Docs/Zips/
1074	R1-01-1014, retrieved from https://list.etsi.org/scripts/wa.exe?A3=ind0110&L=3GPP_TSG_RAN_WG1&E=base64&P=2072790&B=-----_%3D_NextPart_000_01C15C16.5D43E0D0&T=application%2Foctet-stream;%20name=%22R1-01-1014.zip%22&N=R1-01-1014.zip&attachment=q&X=6DEE3DFAFC65AFF81C&Y=friedhelm.rodernund%40iotecc.com (R1-01-1014.doc in R1-01-1014.zip)

Exhibit ("Ex.")	Description
1075	Webpage, available at https://list.etsi.org/scripts/wa.exe?A2=3GPP_TSG_RAN_WG1;84332eeb.0110&S=
1076	Webpage, available at https://web.archive.org/web/20010518052528/http://list.etsi.org/
1077	Internet Archive Capture, available at https://web.archive.org/web/20020604215730/http://list.etsi.org:80/
1078	Internet Archive Capture, available at https://web.archive.org/web/20050824015238/http://www.3gpp.org:80/ftp/tsg_ran/WG1_RL1/
1079	Internet Archive Capture, available at https://web.archive.org/web/20051123162134/http://www.3gpp.org:80/ftp/tsg_ran/WG1_RL1/
1080	Internet Archive Capture, available at https://web.archive.org/web/20011223090820/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/R1_Ad_Hocs/
1081	Internet Archive Capture, available at https://web.archive.org/web/20020619173234/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/R1_Ad_Hocs/
1082	Internet Archive Capture, available at https://web.archive.org/web/20020415205129/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/R1_Ad_Hocs/HSDPA_Ad_Hoc/Docs/
1083	Internet Archive Capture, available at https://web.archive.org/web/20040519152539/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/R1_Ad_Hocs/HSDPA_Ad_Hoc/Docs/Zips/

Exhibit ("Ex.")	Description
1084	R1-01-1014 in R1-01-1014.zip, retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_AH/HSDPA_Ad_Hoc/Docs/Zips/R1-01-1014.zip
1085	Webpage, available at https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_AH/HSDPA_Ad_Hoc/Report
1086	R1-01-1081 in R1-01-1105.zip, retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_AH/HSDPA_Ad_Hoc/Report/R1-01-1105.zip
1087	R1-01-1081, in R1-01-1081.zip, retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_AH/HSDPA_Ad_Hoc/Docs/Zips/R1-01-1081.zip
1088	Redline comparing disclosures of R1-01-1014 and R1-01-1081
1089	U.S. Patent No. 7,210,089
1090	U.S. Patent App. No. 10/193,144
1091	R1-01-1047, in R1-01-1047.zip, retrieved https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_AH/HSDPA_Ad_Hoc/Docs/Zips/R1-01-1047.zip
1092	Webpage, available at https://www.3gpp.org/ftp/Specs/archive/25_series/25.212
1093	Webpage, available at https://www.etsi.org/deliver/etsi_ts/125200_125299/125212/05.01.00_60/
1094	ETSI TS 125 212 V5.1.0 (2002-06), retrieved from https://www.etsi.org/deliver/etsi_ts/125200_125299/125212/05.01.00_60/ts_125212v050100p.pdf

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1095	Internet Archive Capture, available at https://web.archive.org/web/20020202222234/http://etsi.org/getastandard/home.htm
1096	Internet Archive Capture, available at https://web.archive.org/web/20020202222234/http://etsi.org/getastandard/home.htm
1097	Internet Archive Capture, available at https://web.archive.org/web/20020912200940/http://www.3gpp.org/ftp/Specs/archive/25_series/25.212/
1098	3GPP TS 25.212 V5.1.0 (2002-06), retrieved from https://www.3gpp.org/ftp/Specs/archive/25_series/25.212/25212-510.zip (25212-510.doc in 25212-510.zip)
1099	Internet Archive Capture, available at https://web.archive.org/web/20020626102256/http://www.3gpp.org/TB/ran/ran1/specs.htm
1100	Kumar, Ratnam V. Raja, "Development of a CDMA system with RAKE receiver for the third generation wireless communication systems," 2002 IEEE International Conference on Personal Wireless Communications, December 15-17, 2002
1101	Webpage, available at https://ieeexplore.ieee.org/abstract/document/1177299
1102	Webpage, available at https://www.3gpp.org/ftp/Specs/archive/25_series/25.222
1103	Webpage, available at https://www.etsi.org/deliver/etsi_ts/125200_125299/125222/03.08.00_60/

Exhibit ("Ex.")	Description
1104	ETSI TS 125 222 V3.8.0 (2002-03), retrieved from https://www.etsi.org/deliver/etsi_ts/125200_125299/125222/03.08.00_60/ts_125222v030800p.pdf
1105	Internet Archive Capture, available at https://web.archive.org/web/20020613173206/http://webapp.etsi.org:80/key/key.asp?full_list=y
1106	Internet Archive Capture, available at https://web.archive.org/web/20020531000359/http://www.3gpp.org:80/ftp/specs/archive/25_series/25.222/
1107	Internet Archive Capture, available at https://web.archive.org/web/20020225110409/http://www.3gpp.org:80/TB/ran/ran1/specs.htm
1108	Webpage, available at https://www.etsi.org/deliver/etsi_ts/125200_125299/125212/03.05.00_60/
1109	ETSI TS 125.212 V3.5.0 (2000-12), retrieved from https://www.etsi.org/deliver/etsi_ts/125200_125299/125212/03.05.00_60/ts_125212v030500p.pdf
1110	Internet Archive Capture, available at https://web.archive.org/web/20011020025720/http://etsi.org/getastandard/home.htm
1111	Internet Archive Capture, available at https://web.archive.org/web/20011124215727/http://www.3gpp.org/ftp/Specs/archive/25_series/25.212/
1112	Internet Archive Capture, available at https://web.archive.org/web/20020111012800/http://www.3gpp.org:80/ftp/Specs/archive/25_series/25.212/

Exhibit ("Ex.")	Description
1113	3GPP TS 25.212 V3.5.0. (2000-12), in 25212-350.zip, retrieved from https://www.3gpp.org/ftp/Specs/archive/25_series/25.212/25212-350.zip
1114	Internet Archive Capture, available at https://web.archive.org/web/20020802173135/http://www.3gpp.org/ftp/Specs/
1115	Internet Archive Capture, available at https://web.archive.org/web/20020806031707/http://www.3gpp.org/ftp/Specs/archive/
1116	Internet Archive Capture, available at https://web.archive.org/web/20020701091801/http://www.3gpp.org/ftp/specs/archive/25_series/
1117	Internet Archive Capture, available at https://web.archive.org/web/20020531003232/http://www.3gpp.org/ftp/specs/latest/Rel-6/25_series/
1118	Internet Archive Capture, available at https://web.archive.org/web/20020812090150/http://www.3gpp.org/ftp/Specs/latest/Rel-5/25_series/
1119	TS 25.222 V3.8.0 (2002-03), in 25222-380.zip, retrieved from https://www.3gpp.org/ftp/Specs/archive/25_series/25.222/25222-380.zip
1120	Transcript of November 1, 2023 Call with the Board
1121-1199	(Reserved)
1200	Proposed Protective Order
1201	Declaration of Hojun Suh (Confidential)

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1202	Declaration of Soo Hong (Confidential)
1203	U.S. Patent No. 9,313,809
1204	U.S. Patent No. 9,575,631
1205	U.S. Patent No. 9,854,545
1206	U.S. Patent No. 10,869,247
1207	(Reserved— <i>See</i> Ex. 1001)
1208	U.S. Patent No. 9,136,924
1209	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 182 (Order Regarding LGE’s Motion for Disqualification) (Public Version)
1210	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 1 (<i>Pantech</i> Complaint)
1211	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 60-1 (Second Declaration of Jamie B. Beaber in Support of Plaintiff’s Opposition to Defendants’ Motion to Disqualify Mayer Brown) (Confidential)
1212	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 40 (Defendants’ Motion to Disqualify Mayer Brown LLP) (Public Version)
1213	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 40 (Magistrate Order Regarding LGE’s Motion for Disqualification) (Public Version)
1214	<i>In re LG Electronics Inc. and LG Electronics U.S.A., Inc.</i> , Case No. 23-148 (Fed. Cir.), Dkt. 8-1 (LG Electronics Inc. and LG Electronics U.S.A., Inc.’s Petition For Writ Of Mandamus) (Public Version)

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1215	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 15-28 (<i>Jenam Agreement</i>) (Confidential)
1216	<i>Pantech Corp. v. LG Electronics Inc.</i> , Case No. 5:22-cv-00113 (E.D. Tex.), Dkt. 56 (Plaintiffs' Opposition to Defendants' Motion to Disqualify Mayer Brown LLP) (Public Version)
1217	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:14-cv-00982 (E.D. Tex.), Dkt. 1 (<i>CCE 982 Complaint</i>)
1218	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:13-cv-00508 (E.D. Tex.), Dkt. 1 (<i>CCE 508 Complaint</i>)
1219	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:13-cv-00507 (E.D. Tex.), Dkt. 442-6 (<i>CCE Infringement Contentions for U.S. Patent No. 6,819,923</i>)
1220	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:14-cv-00982 (E.D. Tex.), Dkt. 147-9 (<i>CCE Infringement Contentions for U.S. Patent No. 8,848,556</i>)
1221	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 1 (<i>Core Wireless 911 Complaint</i>)
1222	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00912 (E.D. Tex.), Dkt. 1 (<i>Core Wireless 912 Complaint</i>)
1223	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 13 (<i>Core Wireless 911/912 Consolidation Order</i>)
1224	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 363 (<i>Core Wireless Proposed Joint Pretrial Order</i>)
1225	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 232 (<i>Core Wireless Appearance of Jamie B. Beaber</i>)

Exhibit ("Ex.")	Description
1226	<i>Mobile Tele. Tech. v. LG Electronics, Inc.</i> , No. 2:13-cv-00947 (E.D. Tex.), Dkt. 20 (MTT Complaint)
1227	U.S. Patent No. 8,713,476
1228	U.S. Patent No. 6,978,143
1229	U.S. Patent No. 6,477,151
1230	U.S. Patent No. 8,848,556
1231	U.S. Patent No. 6,091,717
1232	U.S. Patent No. 8,055,820
1233	U.S. Patent No. 7,764,966
1234	U.S. Patent No. 7,804,850
1235	U.S. Patent No. 8,434,020
1236	U.S. Patent No. 6,094,426
1237	U.S. Patent No. 7,215,962
1238	U.S. Patent No. 5,809,428
1239	U.S. Patent No. 6,266,321
1240	U.S. Patent No. 6,778,521
1241	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:13-cv-00507 (E.D. Tex.), Dkt. 442-1 (CCE Infringement Contentions)
1242	<i>Mobile Tele. Tech. v. LG Electronics, Inc.</i> , No. 2:13-cv-00947 (E.D. Tex.) Docket Sheet

Exhibit ("Ex.")	Description
1243	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:16-cv-00365 (E.D. Tex.), Dkt. 2 (CCE 365 Complaint)
1244	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:13-cv-00508 (E.D. Tex.) Docket Sheet Excerpt
1245	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:14-cv-00982 (E.D. Tex.) Docket Sheet Excerpt
1246	<i>Cellular Comm's. Equip. v. LG Electronics, Inc.</i> , 6:16-cv-00365 (E.D. Tex.), Docket Sheet Excerpt
1247	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.) Docket Sheet Excerpt
1248	LGE Emails (Confidential – Privileged)
1249	<i>Jenam Tech, L.L.C. v. LG Electronics, Inc.</i> , No. 4:19-cv-00249 (E.D. Tex.), Dkt 1 (<i>Jenam</i> Complaint)
1250	<i>Jenam Tech, L.L.C. v. LG Electronics, Inc.</i> , No. 4:19-cv-00249 (E.D. Tex.) Docket Sheet Excerpt
1251	LGE-Pantech Emails from 2021-04-01 to 2021-05-06 (Translated) (Confidential)
1252	LGE-Mayer Brown Emails on 2015-06-04 (Confidential)
1253	CCE Production Metadata (Confidential)
1254	LGE-Mayer Brown Emails from 2015-09-09 to 2015-11-06 (Confidential)
1255	CCE Source Code Production Data (Confidential)
1256	LGE-Mayer Brown Emails from 2020-01-24 to 2020-01-29 (Confidential)

Case IPR2023-01272

Patent No. 9,065,486

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

Exhibit ("Ex.")	Description
1257	<i>Jenam</i> Production Metadata (Confidential)
1258	<i>Pantech</i> Preliminary Infringement Contentions of U.S. Patent No. 9,575,631
1259	<i>Pantech</i> Preliminary Infringement Contentions of U.S. Patent No. 9,854,545
1260	<i>Pantech</i> Preliminary Infringement Contentions of U.S. Patent No. 9,313,809
1261	<i>Pantech</i> Preliminary Infringement Contentions of U.S. Patent No. 9,065,486
1262	<i>Pantech</i> Preliminary Infringement Contentions of U.S. Patent No. 9,136,924
1263	U.S. Patent No. 6,775,548
1264	U.S. Patent No. 5,946,320
1265	IPR2023-01271 – Request for Extension
1266	2023-12-26 Dkt. 30 Mandamus Order
1267- 1299	(Reserved)
1300	Petitioner's Offered Sotera Stipulation
1301	Settlement Agreement (Confidential)

I. INTRODUCTION

Pursuant to 37 C.F.R. 42.72, Pantech Wireless, LLC (“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. 9,065,486 in IPR2023-01272.

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 ’486 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 ’486 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. Patent Owner has yet to file its Patent Owner Response. 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.*, No. 5:22-cv-00113-RWS (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. 2) on August 11, 2023, the Board issued a Decision to Institute (Paper No. 25) on April 9, 2024, and Pantech filed its Objections to Evidence (Paper No. 27) on April 23, 2024. 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 '486 patent. And the Parties do not anticipate further litigation between them concerning the '486 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 '486 patent.

Dated: August 16, 2024

Respectfully submitted,

/James L. Davis, Jr./

/Amanda Bonner/

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Case IPR2023-01272

Patent No. 9,065,486

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

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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

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