

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,

Petitioner,

v.

PANTECH CORPORATION,

Patent Owner

Case: IPR2023-01273

U.S. Patent No. 9,136,924

**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. 9,136,924 ("924")
1002	File History of U.S. Patent No. 9,136,924 ("924FH")
1003	Declaration of Dr. Bertrand Hochwald in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,136,924 ("Hochwald")
1004	Declaration of Friedhelm Rodermund in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,136,924 ("Rodermund")
1005	U.S. Patent App. Pub. 2011/0274188 ("Sayana")
1006	U.S. Provisional App. No. 61/331,818 ("Sayana-Prov")
1007	International Patent App. Pub. WO2010/050689 ("Lee-689")
1008	LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical layer procedures (3GPP TS 36.213 version 8.8.0 Release 8) ("TS36.213")
1009	LTE; Evolved Universal Terrestrial Radio Access (E-UTRA); Physical channels and modulation (3GPP TS 36.211 version 8.8.0 Release 8) ("TS36.211")
1010	U.S. Patent App. Pub. 2013/0064129 ("Koivisto")
1011	R1-102630, "Refinements of Feedback and Codebook Design," submitted by Ericsson for 3GPP Meeting WG1 #61 (May 10-14, 2010) ("Ericsson")
1012	U.S. Patent App. Pub. 2011/0249713 ("Hammarwall")
1013	U.S. Patent App. Pub. 2011/0305263 ("Jongren")
1014	U.S. Patent App. Pub. 2011/0034192 ("Lim")

Exhibit ("Ex.")	Description
1015	Third Amended Docket Control Order, <i>Pantech Corporation et al. v. LG Electronics Inc. et al.</i> , No. 5:22-cv-00113-RWS-JBB Dkt 98 (E.D. Tex.)
1016	Docket Navigator "Time to Trial" report for Judge Robert W. Schroeder
1017	Expert Report of Todor Cooklev, Ph.D. [Claim Construction] dated June 23, 2023
1018	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.
1019	Redline Comparison between U.S. Patent App. Pub. 2011/0274188 and U.S. Provisional App. No. 61/331,818
1020	International Patent App. Pub. WO2009/025619 ("Göransson-619")
1021	U.S. Patent No. 9,078,236 ("Chun")
1022	U.S. Patent No. 9,247,420 ("Jung")
1023	U.S. Patent No. 9,083,411 ("Li")
1024	U.S. Patent No. 7,369,511 ("Utsunomiya")
1025	U.S. Patent No. 8,649,456 ("Xia")
1026	Sesia, Stefania et al. LTE - The UMTS Long Term Evolution: From Theory to Practice. United Kingdom, Wiley, 2011.
1027	Hui, Lin, and Wang Wen Bo. "Coordinated Beamforming technology in TD-LTE-Advanced system." 2010 International Conference on Communications and Mobile Computing. Vol. 2. IEEE, 2010.

Exhibit ("Ex.")	Description
1028	USCourts.gov "U.S. District Court – Judicial Caseload Profile" for Eastern District of Texas
1029	Declaration of Jonathan Bradford
1030-1050	Reserved
1051	Webpage, available at https://archive.org/legal/affidavit.php
1052	Internet Archive Capture, available at https://web.archive.org/web/20110509054716/http://3gpp.org/Specification-Groups
1053	Internet Archive Capture, available at https://web.archive.org/web/20090802220720/http://www.3gpp.org/
1054	Internet Archive Capture, available at https://web.archive.org/web/20130812132958/http://3gpp.org/RAN1-Radio-layer-1
1055	Internet Archive Capture, available at https://web.archive.org/web/20080917042036/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/
1056	Internet Archive Capture, available at https://web.archive.org/web/20080803190713/http://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_55/
1057	Webpage, available at https://www.3gpp.org/ftp/Specs
1058	Internet Archive Capture, available at https://web.archive.org/web/20130110164645/http://www.3gpp.org/specifications

Exhibit ("Ex.")	Description
1059	Internet Archive Capture, available at https://web.archive.org/web/20081201021150/http://www.3gpp.org/S pecification-Numbering
1060	Internet Archive Capture, available at https://web.archive.org/web/20081207063329/http://www.3gpp.org/ftp/Specs/html-info/36-series.htm
1061	Internet Archive Capture, available at https://web.archive.org/web/20080612010911/http://www.3gpp.org/ftp/Specs/html-info/TSG-WG--r1.htm
1062	Internet Archive Capture, available at https://web.archive.org/web/20081201145114/http://www.3gpp.org/ftp/specs/html-info/36213.htm
1063	Internet Archive Capture, available at https://web.archive.org/web/20140326211003/http://3gpp.org/DynaR eport/TSG-WG--R1.htm
1064	Internet Archive Capture, available at https://web.archive.org/web/20140217112636/http://www.3gpp.org/DynaReport/36-series.htm
1065	Internet Archive Capture, available at https://web.archive.org/web/20140326220443/http://3gpp.org/DynaR eport/36213.htm
1066	Internet Archive Capture, available at https://web.archive.org/web/20140326193752/http://3gpp.org/DynaR eport/36211.htm
1067	3GPP TS 36.211 V8.1.0 (2007-11), retrieved from https://web.archive.org/web/20140724150608/http://www.3gpp.org/ftp/Specs/archive/36_series/36.211/36211-810.zip (36211-810.doc in 36211-810.zip)

Exhibit ("Ex.")	Description
1068	Internet Archive Capture, available at https://web.archive.org/web/20141014200927/http://www.3gpp.org/ftp/Specs/latest/Rel-8/
1069	Internet Archive Capture, available at https://web.archive.org/web/20080706152214/http://www.3gpp.org/ftp/Specs/latest/Rel-8/36_series/
1070	Reserved
1071	Internet Archive Capture, available at https://web.archive.org/web/20190529145715/https://list.etsi.org/scripts/wa.exe?SUBED1=3gpp_tsg_ran_wg1&A=1
1072	Webpage, available at https://www.3gpp.org/ftp/Specs/archive/36_series/36.213
1073	Webpage, available at https://www.etsi.org/deliver/etsi_ts/136200_136299/136213/08.08.00_60/
1074	ETSI TS 136 213 V8.8.0 (2009-10), retrieved from https://www.etsi.org/deliver/etsi_ts/136200_136299/136213/08.08.00_60/ts_136213v080800p.pdf
1075	Internet Archive Capture, available at http://web.archive.org/web/20081201081622/http://www.3gpp.org/ftp/specs/archive/36_series/36.213/
1076	Internet Archive Capture, available at http://web.archive.org/web/20140601044332/http://www.3gpp.org:80/ftp/specs/archive/36_series/36.213
1077	3GPP TS 36.213 V8.8.0 (2009-09), retrieved from https://www.3gpp.org/ftp/specs/archive/36_series/36.213/36213-880.zip (36213-880.doc in 36213-880.zip)

Exhibit ("Ex.")	Description
1078	Internet Archive Capture, available at https://web.archive.org/web/20081113150830/http://www.3gpp.org/ftp/Specs/
1079	Internet Archive Capture, available at https://web.archive.org/web/20081013132648/http://www.3gpp.org/ftp/Specs/archive/
1080	Internet Archive Capture, available at https://web.archive.org/web/20081012223857/http://www.3gpp.org/ftp/specs/archive/36_series/
1081	Internet Archive Capture, available at https://web.archive.org/web/20140601044332/http://www.3gpp.org:80/ftp/specs/archive/36_series/36.213
1082	Internet Archive Capture, available at https://web.archive.org/web/20081201231313/http://www.3gpp.org/ftp/Specs/latest
1083	Internet Archive Capture, available at https://web.archive.org/web/20081208085335/http://www.3gpp.org:80/ftp/Specs/latest/Rel-8/
1084	Internet Archive Capture, available at https://web.archive.org/web/20081209045248/http://www.3gpp.org/ftp/Specs/latest/Rel-8/36_series/
1085	A. Müller and P. Frank, "Cooperative Interference Prediction for Enhanced Link Adaptation in the 3GPP LTE Uplink," 2010 IEEE 71st Vehicular Technology Conference (VTC), Taipei, Taiwan, 2010, pp. 1-5, doi: 10.1109/VETECS.2010.5493598, May 16-19, 2010
1086	Webpage, available at https://ieeexplore.ieee.org/document/5493598

Exhibit ("Ex.")	Description
1087	Webpage, available at https://www.3gpp.org/ftp/Specs/archive/36_series/36.211
1088	Webpage, available at https://www.etsi.org/deliver/etsi_ts/136200_136299/136211/08.08.00_60/
1089	ETSI TS 136 211 V8.8.0 (2009-10), retrieved from https://www.etsi.org/deliver/etsi_ts/136200_136299/136211/08.08.00_60/ts_136211v080800p.pdf
1090	Webpage, available at https://web.archive.org/web/20170404095635/http://webapp.etsi.org/key/key.asp?full_list=y
1091	Internet Archive Capture, available at https://web.archive.org/web/20140801181746/http://3gpp.org/ftp/specs/archive/36_series/36.211/
1092	Internet Archive Capture, available at http://web.archive.org/web/20081201192809/http://www.3gpp.org/ftp/Specs/archive/36_series/36.211/
1093	3GPP TS 36.211 V8.8.0 (2009-09), retrieved from https://www.3gpp.org/ftp/specs/archive/36_series/36.211/36211-880.zip (36211-880.doc in 36211-880.zip)
1094	Internet Archive Capture, available at https://web.archive.org/web/20081201152358/http://www.3gpp.org/ftp/specs/html-info/36211.htm
1095	Internet Archive Capture, available at https://web.archive.org/web/20140315022717/http://www.3gpp.org:80/DynaReport/36211.htm
1096	Jae-Hyuk Lee, Jun-Ho Baek, Seung-Hoon Hwang and Byoung-Jo Choi, "On the selection of training sequence code pair for MIMO

Exhibit ("Ex.")	Description
	technology in 3GPP GERAN system," 2010 The 12th International Conference on Advanced Communication Technology (ICACT), Phoenix Park, February 7-10, 2010, pp. 537-540
1097	Webpage, available at https://ieeexplore.ieee.org/document/5440406
1098	Yanguang Liu, Wenjing Li, Heng Zhang and Weihao Lu, "Graph based automatic centralized PCI assignment in LTE," The IEEE symposium on Computers and Communications, Riccione, June 22-25, 2010, pp. 919-921, doi: 10.1109/ISCC.2010.5546812
1099	Webpage, available at https://ieeexplore.ieee.org/document/5546812
1100	Webpage, available at http://3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Docs/
1101	3GPP R1-102630, retrieved from https://list.etsi.org/scripts/wa.exe?A3=ind1005A&L=3GPP_TSG_RAN_WG1&E=base64&P=85459760&B=--_007_E4CE3BC64C3AB6488038754A0E419DE11C0173F846ESES_SCMS0365e_&T=application%2Fzip-compressed;%20name=%22R1-102630.zip%22&N=R1-102630.zip&attachment=q&XSS=3 (R1-102630_refinements_of_fb_and_cb_design.doc in R1-102630.zip)
1102	Webpage, available at https://list.etsi.org/scripts/wa.exe?A2=3GPP_TSG_RAN_WG1;a370e470.1005A&S=
1103	Internet Archive Capture, available at https://web.archive.org/web/20100326093131/http://list.etsi.org/
1104	Internet Archive Capture, available at https://web.archive.org/web/20120309181952/http://list.etsi.org:80/

Exhibit ("Ex.")	Description
1105	Internet Archive Capture, available at https://web.archive.org/web/20140328154821/http://3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Docs/
1106	R1-102630, retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Docs/R1-102630.zip (R1-102630_refinements_of_fb_and_cb_design.doc in R1-102630.zip)
1107	Draft Report of 3GPP TSG RAN WG1 #61 v0.1.0 (Montreal, Canada, 10th – 14th May, 2010), retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Report/Draft_ReportWG1%2361_v010.zip (Draft_ReportWG1#61_v010.doc in Draft_ReportWG1%2361_v010.zip)
1108	Webpage, available at https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Report
1109	Excel file "Tdoclist_RAN1#61(May_2010).xls," retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Report/Draft_ReportWG1%2361_v010.zip
1110	R1-103333, retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Docs/R1-103333.zip (R1-103333_refinements_of_fb_and_cb_design.doc in R1-103333.zip)
1111	Redline comparing disclosures of R1-102630 and R1-103333.
1112	Patent Application No. 13/698,419
1113	Excel file "3gppRAN1_61.xls," retrieved from https://www.3gpp.org/ftp/tsg_ran/WG1_RL1/TSGR1_61/Report/Final_ReportWG1%2361_v300.zip
1114	Transcript of November 1, 2023 Call with the Board

Exhibit ("Ex.")	Description
1115-1199	(Reserved)
1200	Proposed Protective Order
1201	Declaration of Hojun Suh (Confidential)
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	U.S. Patent No. 9,065,486
1208	(Reserved—See Ex. 1001)
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)

Exhibit ("Ex.")	Description
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)
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>)

Exhibit ("Ex.")	Description
1223	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 13 (<i>Core Wireless</i> 911/912 Consolidation Order)
1224	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 363 (<i>Core Wireless</i> Proposed Joint Pretrial Order)
1225	<i>Core Wireless Licensing v. LG Electronics, Inc.</i> , No. 2:14-cv-00911 (E.D. Tex.), Dkt. 232 (<i>Core Wireless</i> Appearance of Jamie B. Beaber)
1226	<i>Mobile Tele. Tech. v. LG Electronics, Inc.</i> , No. 2:13-cv-00947 (E.D. Tex.), Dkt. 20 (<i>MTT</i> 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

Exhibit ("Ex.")	Description
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
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)

Exhibit ("Ex.")	Description
1254	LGE-Mayer Brown Emails from 2015-09-09 to 2015-11-06 (Confidential)
1255	<i>CCE</i> Source Code Production Data (Confidential)
1256	LGE-Mayer Brown Emails from 2020-01-24 to 2020-01-29 (Confidential)
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

Case IPR2023-01273

Patent No. 9,136,924

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

Exhibit ("Ex.")	Description
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. 9,136,924 in IPR2023-01273.

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 ’924 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 ’924 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. 26) on April 9, 2024, and Pantech filed its Objections to Evidence (Paper No. 28) 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 '924 patent. And the Parties do not anticipate further litigation between them concerning the '924 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 '924 patent.

Dated: August 16, 2024

Respectfully submitted,

/James L. Davis, Jr./

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Case IPR2023-01273

Patent No. 9,136,924

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

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Case IPR2023-01273

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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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