

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LENOVO (UNITED STATES) INC.
Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner

U.S. PATENT NO. 10,425,817

Case IPR2024-00702

JOINT MOTION TO TERMINATE PROCEEDING

Pursuant to 35 U.S.C. § 317(a), Petitioner Lenovo (United States) Inc. (“Petitioner”) and Patent Owner Telefonaktiebolaget LM Ericsson (“Patent Owner”) (collectively, “the Parties”) have resolved their dispute and jointly request termination of IPR2024-00702 under 35 U.S.C. § 317(a).

I. STATEMENT OF FACTS

The Parties have executed a confidential settlement agreement (“Settlement Agreement”) to resolve all present disputes and to avoid any additional disputes regarding U.S. Patent No. 10,425,817 (“the ’817 Patent”), including this *inter partes*

review (IPR) proceeding. The Parties are filing currently with this joint motion: (i) the Settlement Agreement resolving, *inter alia*, the present *inter partes* review proceeding (Exhibit 1025); and (ii) a “Joint Request To File Settlement Agreement As Business Confidential Information” under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

A. Brief Explanation

Termination is appropriate in this case because the Parties have resolved all of their disputes relating to the '817 Patent, as set forth in the confidential Resolution Document. See Exhibit 1025.

Petitioners and Patent Owner each support termination of the proceeding. Termination of this *inter partes* review is appropriate because the Board has not yet

“decided the merits of the proceeding.” 35 U.S.C. § 317(a). The parties have not completed briefing in this proceeding, an oral hearing has not yet been conducted, and the Board has not issued a final decision.

B. Related Litigation

The ’817 Patent was at issue in *Certain Mobile Phones, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-1375 (Oct. 11, 2023); and *Telefonaktiebolaget LM Ericsson v. Lenovo (US) Inc. et al.*, C.A. No. 5:23-cv-00569 (E.D.N.C. Oct. 11, 2023), but the Parties are in the process of dismissing those litigations. There is no other active litigation involving the ’817 Patent.

C. Related Proceedings Before the Office

The ’817 Patent is not subject to any other related proceedings before the Office.

II. STATEMENT OF RELIEF REQUESTED

Due to the resolution of all of the Parties’ disputes relating to the patent that is the subject of this IPR proceeding, the Parties jointly request termination of IPR2024-00702 under 35 U.S.C. § 317(a). The requested relief is appropriate because the Parties have resolved all of their disputes in this proceeding relating to the ’817 Patent. A true copy of the document resolving the disputes related to the ’817 Patent is filed concurrently herewith. See Exhibit 1025; 37 CFR § 42.74(b).

Further, a termination of this proceeding will promote efficiency and conserve the Board's and the parties' resources.

III. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR of the '817 Patent.

Dated: April 8, 2025

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a complete copy of the foregoing document as served on April 8, 2025 on counsel of record for the Patent Owner via email to the following address:

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