UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.
NOKIA OF AMERICA CORPORATION,

Petitioners,

v.

ACTIVE WIRELESS TECHNOLOGIES LLC,

Patent Owner.

Patent No. 10,785,764
Filing Date: August 10, 2017
Issue Date: September 22, 2020

Inventors: Chongming Zhang, Renmao Liu,
and Shohei Yamada
Title: INFORMATION CHANGE TRANSMISSION METHOD AND DEVICE FOR SINGLE-CELL MULTICAST SERVICE

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.5, 42.71(a), 42.72, AND 42.74

Case No. IPR2024-00986

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74, and the Board's authorization of March 6, 2025, Petitioners Nokia of America Corporation and Ericsson Inc. ("Petitioners") and Active Wireless Technologies LLC ("Patent Owner") jointly move to terminate the present *inter partes* review proceeding in light of Patent Owner and Petitioners' settlements of their disputes.

Petitioners and Patent Owner concurrently file a true and complete copy of the confidential settlement agreement between Petitioner Nokia of America Corporation and Active Wireless Technologies LLC in its entirety, filed herewith as Exhibit 2004.[1] Petitioners and Patent Owner further submit a true and complete copy of the confidential settlement agreement between Petitioner Ericsson Inc. and Active Wireless Technologies LLC, filed herewith as Exhibit 2005.[2] A joint request to treat the settlement materials (Confidential Exhibits 2004 and 2005) as business confidential information kept separate from the file of the involved patents pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

[1] The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to the "Board Only."

[2] The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to "Board Only."

STANDARD

An *inter partes* review proceeding "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). 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).

ARGUMENT

Termination of the present *inter partes* review proceedings is appropriate because (1) Petitioners and Patent Owner have settled their disputes and have agreed to terminate the proceeding, (2) the Office has not yet decided the merits of the proceeding, and (3) public policy favors the termination. *DTN, LLC v. Farms Technology, LLC*, IPR2018-01412, Paper 21, at *10-11 (P.T.A.B. June 14, 2019) (precedential).

First, the parties' settlement completely resolves the controversy between Patent Owner and Petitioners relating to U.S. Patent No. 10,785,764 B2 ("the '764

Patent"). *See* Confidential Exhibits 2004 and 2005.

Second, the Office has not decided the merits of the proceeding.

Third, public policy favors the termination. As recognized by the rules of practice before the Board:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements, the parties confirm that all other litigation between the parties to this IPR involving the '764 Patent has been resolved, including *Active Wireless Technologies LLC v. T-Mobile USA, Inc. and T-Mobile US, Inc., Ericsson Inc. and Nokia of North America Corporation (Intervenors)*, Case No. 2-23-cv-00261 (E.D. Tex.) and *Active Wireless Technologies LLC v. Verizon Communications, Inc. and Cellco Partnership d/b/a Verizon Wireless, Ericsson Inc. (Intervenor)*, Case No. 2-23-cv-00620 (E.D. Tex.). There are currently no other pending IPRs against the '764 Patent.

CONCLUSION

For the foregoing reasons, Petitioners and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

Dated: March 6, 2025

Respectfully submitted,

/s/ Kevin Anderson
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