

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION, AT&T SERVICES, INC., T-MOBILE
USA, INC.

Petitioners,

v.

WOODBURY WIRELESS LLC,
Patent Owner

Case No. IPR2025-00063
U.S. Patent No. 10,211,895

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R § 42.72**

Petitioners' Exhibit List

<i>Exhibit #</i>	<i>Description</i>
1001	U.S. Patent No. 10,211,895 (the “’895 Patent”)
1002	Select portions of prosecution history of the ’895 Patent (“File History”)
1003	Declaration of Petitioners’ Expert Dr. Mark Mahon
1004	U.S. Patent Application Publication 2005/0003865 (“Lastinger”)
1005	U.S. Pat. No. 7,907,971 (“Salo”)
1006	U.S. Pat. No. 9,408,220 (“Gore”)
1007	May 2005 IEEE Draft Specification
1008	January 2006 IEEE Draft Specification (MAC layer)
1009	U.S. Pat. No. 7,881,390 (“Sadowsky”)
1010	U.S. Pat. No. 7,881,390 Prosecution History Excerpts including IDS from January 30, 2006.
1011	U.S. Pat. 7,596,355 (“Li”)
1012	U.S. Pat. No. 8,649,322 (“Grandhi”)
1013	U.S. Patent No 8,498,346 (“Biswas”)
1014	WO20071088885
1015	January 2006 IEEE Draft Specification (PHY layer)
1016	Related Patents
1017	U.S. Pat. No. 9,178,577
1018	[This Exhibit Intentionally Omitted From This Petition]
1019	U.S. Pat. No. 7,590,078
1020	T-Mobile Infringement Contentions Cover, <i>Woodbury Wireless v. T-Mobile, USA, Inc.</i>
1021	Docket Control Order, <i>Woodbury Wireless v. T-Mobile, USA, Inc.</i>
1022	Settlement and License Agreement-Confidential Nokia
1023	Settlement and License Agreement-Confidential AT&T
1024	Settlement and License Agreement-Confidential T-Mobile

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, and the Board's authorization provided on March 31, 2025, Petitioners Nokia of America Corporation, AT&T Services, Inc. and T-Mobile USA, Inc. ("Petitioners") and Patent Owner Woodbury Wireless LLC ("Woodbury Wireless" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached settlement agreements and jointly request termination of *inter partes* review of U.S. Patent No. 10,211,895 ("the '895 Patent"), Case No. IPR2025-00063, with the United States Patent and Trademark Office.

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the parties relating to the '895 Patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review shall be terminated with respect to any petitioner upon the joint request of the petitioners and the patent owner, unless the Office has decided the merits of the proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, "no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner." *See id.* No other petitioners remain in this *inter partes* review, and no Final Written Decision on the merits has been entered. For at least these

reasons, termination of the *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a).

II. Legal Standard

35 U.S.C. § 317(a) provides that “[a]n *inter partes* review instituted under this chapter 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.” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. § 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that 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.” 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

III. Agreement in Writing Submitted to the Board

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties’ settlement agreements are being submitted as Exhibit 1022, Exhibit 1023 and Exhibit 1024. The settlement agreements are in writing and constitute the Parties’ entire understanding and agreement. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in a separate paper filed concurrently herewith, the Parties jointly

request that the settlement agreements be treated as business confidential information and be kept separate from the underlying patent file.

IV. Conclusion

Termination of the proceeding is a just and fair resolution. The Parties agree that neither Nokia, AT&T and T-Mobile nor Woodbury Wireless will be prejudiced by the termination of the IPR. Finally, the Parties will benefit from preserving resources that would otherwise be expended if this motion is denied. For at least the foregoing reasons, the Parties respectfully request that the Board terminate *Inter Partes* Review IPR2025-00063.

Respectfully submitted,

Dated: April 1, 2025

/Patrick D. McPherson/
Patrick D. McPherson
Reg. No. 46,255
PDMcpherson@duanemorris.com

DUANE MORRIS LLP
901 New York Ave., NW
Ste. 700 East
Washington, D.C. 20001
Tel: 202.776.7840

ATTORNEY FOR PETITIONER

/Jason M. Shapiro/
Jason M. Shapiro
Reg. No. 35,354
jshapiro@devlinlawfirm.com

Devlin Law Firm LLC
1526 Gilpin Avenue
Wilmington, DE 19806
Tel: 302-449-9010

*ATTORNEY FOR PATENT
OWNER*

CERTIFICATE OF SERVICE

I hereby certify that on April 1, 2025, a copy of Petitioners' Joint Motion to Terminate Proceedings was served by filing this document through the PTAC's System as well as delivering a copy via electronic mail upon the following:

Jason M. Shapiro
jshapiro@devlinlawfirm.com

Timothy Devlin
tdevlin@devlinlawfirm.com

Derek Dahlgren
ddahlgren@devlinlawfirm.com

dlflitparas@devlinlawfirm.com

/Patrick D. McPherson/
Patrick D. McPherson
Reg. No. 46,255
PDMcpherson@duanemorris.com

DUANE MORRIS LLP
901 New York Ave., NW
Ste. 700 East
Washington, D.C. 20001

Tel: 202.776.7800
ATTORNEY FOR PETITIONER