UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner

v.

NONEND INVENTIONS, N.V.,
Patent Owner

PTAB Case No. IPR2016-00223
Patent No. 7,590,752 B2

JOINT MOTION TO TERMINATE

PURSUANT TO 35 U.S.C § 317 AND 37 C.F.R. § 42.74

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Microsoft Corporation ("Microsoft" or "Petitioner") and Patent Owner Nonend Inventions, N.V. ("Nonend") jointly move to terminate the present *inter partes* review proceeding with respect to both the Petitioner and Patent Owner, in light of the parties' resolution of their dispute relating to U.S. Patent No. 7,590,752 B2 ("the '752 patent") and the executed written agreement regarding the parties' resolution.

Termination with respect to Petitioner and Patent Owner Nonend is appropriate in the instant proceeding because the dispute between the parties has been resolved. The petition was accorded a Nov. 20, 2015 filing date and this proceeding is at a sufficiently early stage.

As required by 35 U.S.C. § 317(b), the parties are filing, concurrently herewith, a true copy of their executed written agreement as Exhibit 1069. The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the agreement be treated as confidential business information and kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a motion to treat the settlement agreement as confidential business information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

The applicable statute, provides that 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) (emphasis added). Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding. Indeed, the Office Patent Trial Practice Guide provides:

> N. Settlement. 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.

The Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14 2012).

Notably, the IPR petition was filed on Nov. 20, 2015 and thus this proceeding is at a sufficiently early stage where no motions or actions are outstanding and the Board has not invested significant resources in this proceeding. Patent Owner's Preliminary Response is due March 9, 2016 and has not been filed yet. The due date for the Board's institution decision is June 9, 2016. Therefore, the Office has not decided the merits of the proceeding. No public interest factors

militate against termination of this proceeding with respect to both Petitioner and Patent Owner in light of the circumstances of this proceeding.

Under 35 U.S.C. § 317(a), because Petitioner Microsoft and Patent Owner Nonend request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioner Microsoft.

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated with respect to both Petitioner and Patent Owner.

Dated: January 26, 2016

Respectfully submitted,

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CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

The undersigned hereby certifies that the above-captioned **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C § 317 AND 37 C.F.R. § 42.**74 and supporting materials have been served in its entirety this 26th Day of January 2016 on the following parties via electronic mail:

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