

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPRINT SPECTRUM L.P., CELLCO PARTNERSHIP D/B/A
VERIZON WIRELESS, and AT&T MOBILITY LLC,

Petitioners

v.

ADAPTIX, INC.

Patent Owner

U.S. Patent No. 8,934,375 B2
Case IPR2016-00824

**SPRINT SPECTRUM L.P., CELLCO PARTNERSHIP D/B/A VERIZON
WIRELESS, AT&T MOBILITY LLC AND ADAPTIX, INC.’S
JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Mail Stop “PATENT BOARD”
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box. 1450
Alexandria, Virginia 22313-1450

Pursuant to 35 U.S.C. § 317(a), Petitioners Sprint Spectrum L.P., Cellco Partnership d/b/a Verizon Wireless, and AT&T Mobility LLC (collectively, “Petitioners”) and Patent Owner Adaptix, Inc. (“Adaptix”) (collectively, the “Parties”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,934,375 (“the ’375 Patent”). The filing of this request was authorized by Andrew Kellogg, Supervisory Paralegal, Patent Trial and Appeal Board, via e-mail dated September 26, 2016.

Petitioners filed their Petition for *Inter Partes* Review on March 30, 2016. Adaptix filed a preliminary response on July 11, 2016. *See* Paper No. 8. On September 20, 2016, the Board instituted trial as to only claims 2, 4, 6, 8, 18, 20, 22, and 24 of the ’375 patent. *See* Paper No. 9. The Board did not institute trial as to claims 5, 7, 11, 13, 14, 21, 23, 27, 29, and 30. *Id.*

The Parties have settled their dispute with respect to the ’375 patent and have reached agreement to terminate this *Inter Partes* Review.

AT&T Mobility LLC

The Settlement Agreement between AT&T Mobility LLC and Adaptix has been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b). *See* Exhibit 2003.

There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. As stated in 35 U.S.C. § 317(a), because AT&T Mobility LLC and Adaptix request this termination as to Petitioner AT&T Mobility LLC, no estoppel under 35 U.S.C. § 315(e) shall attach to AT&T Mobility LLC.

Cellco Partnership d/b/a Verizon Wireless

The Release Agreement between Cellco Partnership d/b/a Verizon Wireless and Adaptix has been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b). *See*, Exhibit 2004.

There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. As stated in 35 U.S.C. § 317(a), because Cellco Partnership d/b/a Verizon Wireless and Adaptix request this termination as to Petitioner Cellco Partnership d/b/a Verizon Wireless, no estoppel under 35 U.S.C. § 315(e) shall attach to Cellco Partnership d/b/a Verizon Wireless.

Sprint Spectrum L.P.

This Joint Motion, together with the Joint Motion to Terminate IPR 2016-00823, constitutes Sprint Spectrum L.P.'s and Adaptix's written agreement to terminate this proceeding, which is hereby filed with this Office.

There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. As stated in 35 U.S.C. § 317(a), because Sprint Spectrum L.P. and Adaptix request this termination as to Petitioner Sprint Spectrum L.P., no estoppel under 35 U.S.C. § 315(e) shall attach to Sprint Spectrum L.P.

The '375 Patent is the subject of one other instituted IPR—IPR2016-00823, which the parties are seeking to contemporaneously terminate by joint motion. There are no current or contemplated pending litigation proceedings involving the '375 Patent.

Therefore, Petitioners and Adaptix respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 8,934,375, Case No. IPR2016-00824.

Respectfully submitted,

Date: November 2, 2016

/Robert C. Hilton/
Robert C. Hilton
Registration No.: 47,649
Firm: McGuireWoods LLP
Telephone No.: (214) 932-6400
Fax. No.: (214) 932-6499

**Attorney for Petitioner Sprint Spectrum
L.P.**

Date: November 2, 2016

/David L. Cavanaugh/
David L. Cavanaugh
Registration No.: 36,476

Firm: Wilmer Cutler Pickering Hale and
Dorr LLP
Telephone No.: (202) 663-6000
Fax. No. : (202) 663-6363

**Attorney for Petitioner Cellco
Partnership d/b/a Verizon Wireless**

Date: November 2, 2016

/Douglas M. Kubehl/
Douglas M. Kubehl
Registration No.: 41,915
Firm: Baker Botts L.L.P.
Telephone No.: (214) 953-6486
Fax. No.: (214) 661-4486

**Attorney for Petitioner AT&T Mobility
LLC**

Date: November 2, 2016

/Amedeo F. Ferraro/
Amedeo F. Ferraro
Registration No. 37,129
MARTIN & FERRARO, LLP
17383 Sunset Boulevard, Suite 250
Los Angeles, California 90272
Telephone: (310) 286-9800
Facsimile: (310) 286-2795

Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Joint Motion to Terminate Proceeding for *Inter Partes* Review of U.S. Patent No. 8,934,375 was served on November 2, 2016 via electronic mail to the attorneys of record for the Petitioner:

<p style="text-align: center;"><u>Lead Counsel</u> David L. Cavanaugh (Reg. No. 36,476) Wilmer Hale LLP 60 State St. Boston, MA, 01945 Phone: (202) 663-6025 Fax: (202) 663-6363 david.cavanaugh@wilmerhale.com</p>	<p style="text-align: center;"><u>Back-up Counsel</u> Larissa B. Park (Reg. No. 59,051) Wilmer Hale LLP 60 State St. Boston, MA, 01945 Phone: (202) 663-6025 Fax: (202) 663-6363 larissa.park@wilmerhale.com</p>
<p style="text-align: center;"><u>Back-up Counsel</u> Robert Hilton (Reg. No. 47,649) George Davis (Reg. No. 68,205) McGuire Woods LLP 2000 McKinney Avenue, Suite 1400, Dallas, TX, 75201 RHilton@mcguirewoods.com GDavis@mcguirewoods.com</p>	<p style="text-align: center;"><u>Back-up Counsel</u> Douglas Kubehl (Reg. No. 41,915) Kurt Pankratz (Reg. No. 46,977) Jennifer Tempesta (Reg. No. 59,021) Baker Botts LLP 30 Rockefeller Plaza New York, NY 10112 doug.kubehl@bakerbotts.com kurt.pankratz@bakerbotts.com jennifer.tempesta@bakerbotts.com</p>

Date: November 2, 2016

/Amedeo F. Ferraro/

Amedeo F. Ferraro
Registration No. 37,129
MARTIN & FERRARO, LLP
17383 Sunset Boulevard, Suite 250
Los Angeles, California 90272
Telephone: (310) 286-9800
Facsimile: (310) 286-2795