

UNITED STATES PATENT & TRADEMARK OFFICE

BEFORE THE PATENT TRIAL & APPEAL BOARD

NEC CORPORATION (JAPAN)
Petitioner

v.

ADAPTIX, INC.
Patent Owner

INTER PARTES REVIEW NO. 2016-01097

U.S. PATENT NO. 8,934,445

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner NEC Corporation (Japan) (“NEC”) and Patent Owner Adaptix, Inc. (“Adaptix”) (collectively, “the Parties”) hereby jointly request termination of the instant proceeding pursuant to 37 C.F.R. §§ 42.5(a), 42.71(a), and 42.72.

The Board authorized the Parties to file this motion in an email dated August 8, 2016.

Termination of this proceeding is proper. As the Office Patent Trial Practice Guide recognizes, “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). In this case, the parties have settled their disputes relating to U.S. Patent No. 8,934,445 (“the ’445 patent”), the review of which forms the basis for this proceeding. The Board has not decided whether to institute *Inter Partes* Review. As such, termination of the proceeding at this early stage will conserve the Board’s resources. Therefore, it is respectfully submitted that the Board should exercise its authority under 37 C.F.R. §§ 42.5(a), 42.71(a) and 42.72 and terminate this proceeding.

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Settlement is in writing, and a true copy of the Settlement is submitted as Exhibit 1025. The Parties’ are separately and concurrently moving, pursuant to 37 C.F.R. § 42.74(c), to have the Settlement treated as business confidential information. Pursuant to the August 8, 2016 email from the Board, the Parties hereby certify that there are no collateral

agreements or understandings made in connection with, or in contemplation of, the termination of the *Inter Partes* Review.

In its August 8, 2016 email, the Board also directed the parties to direction by the Board, required the Parties to “update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future.” *See, e.g.*, IPR2014-00018, Paper 26 at 2 (July 28, 2014). The Parties provide this information below.

Petitioner NEC was not served with a complaint alleging infringement of the ’445 patent. There are no pending proceedings between the Parties involving the ’445 patent. The Parties do not contemplate any litigation or proceeding involving the ’445 patent in the foreseeable future.

As to other parties, there were three district court actions in which Adaptix had asserted the ’445 Patent: *Adaptix, Inc. v. Alcatel-Lucent USA, Inc., et al.*, Case No. 6-15-cv-00604 (E.D. Tex.) (filed June 25, 2015; dismissed July 27, 2016); *Adaptix, Inc. v. Alcatel-Lucent USA, Inc. et al.*, Case No. 6-15-cv-00041 (E.D. Tex.) (filed Jan. 13, 2015; dismissed July 27, 2016); *Adaptix, Inc. v. Ericsson, Inc., et al.*, Case No. 6-15-cv-00042 (E.D. Tex.) (filed Jan. 13, 2015; dismissed Apr. 8, 2016). None remain pending. Three other petitions for *Inter Partes* Review

relating to the district court actions (IPR2016-01030, IPR2016-00997, and IPR2016-00619) were filed. Each of these IPR proceedings has also been terminated.

Respectfully submitted,

August 10, 2016
Date

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on the 10th day of August, 2016, a complete and entire copy of the foregoing Joint Motion to Terminate Proceeding and the exhibit referred to therein were served on the Patent Owner by email to:

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Adaptix-ipr@nelbum.com

August 10, 2016
Date

/s/ Nicholas J. Kim
Nicholas J. Kim (Reg. No. 57,344)