UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC,
Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS, LLC,
Patent Owner

Case IPR2017-00295
Patent 8,711,885

JOINT MOTION TO TERMINATE PROCEEDING

PURSUANT TO 35 U.S.C. § 317

Pursuant to the Board's Order dated February 23, 2017, this Joint Motion To Terminate the Proceeding is being resubmitted with an unredacted copy of the settlement agreement, letter agreement, and term sheet between the parties as exhibits hereto. As explained further in this motion, and in the concurrently filed Joint Request To Treat Settlement Documents As Business Confidential Information, the parties respectfully request the Board to keep the settlement agreement, letter agreement, and term sheet as business confidential information and separate from the files of the involved patents under 37 CFR § 42.74(c).

The Board previously authorized the filing of a joint motion to terminate this and other identified IPR cases on February 8, 2017. Previously, Petitioner met and conferred with Patent Owner, and Patent Owner does not oppose this Motion to Terminate or otherwise object to Petitioner moving to dismiss the Petition and terminate the above-captioned IPR. In fact, Patent Owner joins this motion. Further, all parties agree that Patent Owner will not be prejudiced by the dismissal and that the dismissal will "secure the just, speedy, and inexpensive resolution" to the above-captioned IPR. *See* 37 C.F.R. § 42.1(b). Petitioner and Patent Owner hereby move for dismissal of the pending Petition and termination of the above-captioned IPR.

I. Good Cause Exists To Dismiss The Petition And Terminate The Above-Captioned IPR

Not only is this Motion to Terminate unopposed, but there are a number of other factors that weigh in favor of dismissing the pending Petition and terminating this IPR proceeding. First, the above-captioned IPR is in its preliminary phase, no preliminary response has been filed, and the Board has yet to reach the merits and issue a decision on institution. In similar circumstances involving IPRs in such an early juncture, the Board has previously granted motions to dismiss using its authority under at least 37 C.F.R. §§ 42.5(a) and 42.71(a). *See, e.g., Apple Inc. v. Ericsson Inc.*, IPR2015-01905, Paper 7, (PTAB January 29, 2016) (granting unopposed motion to dismiss for twelve IPR petitions); *Celltrion, Inc. v. Cenetech, Inc*., IPR2015-01733, Paper 12, (PTAB October 6, 2015) (granting unopposed motion to dismiss petition); *Under Armour, Inc. v. Adidas AG*, IPR2015-01531, Paper 8, (PTAB September 21, 2015) (granting unopposed motion to dismiss petition); *Samsung Electronics Co. LTD v. Nvidia Corporation*, IPR2015-01270, Paper 11 (PTAB December 9, 2015) (dismissing Petition even over the patent owner's objection).

Second, dismissal of the Petition in the above-captioned IPR will preserve the Board's resources and the parties' resources while also epitomizing the Patent Office's policy of "secur[ing] the just, speedy, and inexpensive resolution" to the above-captioned IPR. *See* 37 C.F.R. § 42.1(b). Here, the requested dismissal

would relieve the Board of the substantial time and resources required to consider the merits, issue an institution decision, and proceed through trial (if instituted). Likewise, even if Petitioner abandons the above-captioned IPR (regardless of whether this Motion to Dismiss is granted), granting this Motion to Dismiss would relieve the Patent Owner of the substantial expense in preparing responses, presenting expert testimony, and participating in an oral hearing. As such, it would be entirely proper for the Board to dismiss the pending Petition "at this early juncture[] to promote efficiency and minimize unnecessary costs." *Samsung*, IPR2015-01270, Paper 11 at p. 4.

Lastly, dismissal of the Petition and termination of the above-captioned IPR is a just and fair resolution. Again, all parties here agree that Patent Owner will not be prejudiced by the dismissal. Moreover, the parties and the Board will benefit from preserving resources that would otherwise be expended if this Motion is denied.

II. Identification of Parties

This IPR petition is related to a lawsuit filed in the Eastern District of Texas (*Personalized Media Communications, LLC. v. Samsung Electronics America, Inc., et al.,* Civil Action No. 2:15-cv-01754). On February 2, 2017, the parties filed a Stipulation of Dismissal of the lawsuit and the Court dismissed the action on February 3, 2017. All parties involved in the ligation are as follows:

PERSONALIZED MEDIA COMMUNICATIONS, LLC,

SAMSUNG ELECTRONICS CO., LTD., and

SAMSUNG ELECTRONICS AMERICA, INC.

U.S. Patent No. 8,711,885 was also asserted in *Personalized Media Communications, LLC v. Top Victory Electronics (Taiwan) Co. Ltd. et al.,* C.A. No. 2:15-cv-1206 (E.D. Tex.), which has been terminated, and *Personalized Media Communications, LLC v. Funai Electric Co., Ltd. et al.*, C.A. No. 2:16-cv-105 (E.D. Tex.), which is pending.

III. Identification and Status of Related Proceedings Before the USPTO

The following IPR petitions are related to the current IPR petition and/or the related litigation:

Case IPR2017-00288, Patent 7,747,217

Case IPR2017-00289, Patent 7,752,649

Case IPR2017-00290, Patent 7,752,649

Case IPR2017-00291, Patent 7,752,650

Case IPR2017-00292, Patent 7,856,649

Case IPR2017-00293, Patent 8,675,775

Case IPR2017-00294, Patent 8,711,885

Case IPR2017-00295, Patent 8,711,885

The current status of each of these IPR petitions is "Pending". Each is prior to institution and prior to any patent owner preliminary response. Motions to dismiss are being filed concurrently with respect to each petition. The parties agree that neither party would be prejudiced by dismissal of this and the related IPR petitions.

Other USPTO proceedings involving U.S. Patent No. 7,752,649 include IPR2017-00141 and IPR-2017-00142 (terminated), and IPR2016-00753 (trial instituted). Other USPTO proceedings involving U.S. Patent No. 7,752,650 include IPR2017-00143 (terminated).

IV. Request to Keep Separate

Petitioner and Patent Owner are jointly submitting a settlement agreement, letter agreement, and term sheet herewith, as exhibits, and hereby request that the settlement agreement, letter agreement, and term sheet be treated as business confidential information and kept separate from the files. This request is filed in accordance with 37 CFR § 42.74(c).

V. Conclusion

For at least these reasons, Petitioner and Patent Owner jointly and respectfully request that the Board grant this motion to dismiss the pending Petition and terminate the above-captioned IPR.

Respectfully submitted,

Date: 2/24/2017

/Thomas A. Rozylowicz/

Thomas A. Rozylowicz, Reg. No. 50,620
Fish & Richardson P.C.

Date: February 23, 2017

/Dmitry Kheyfits/

Dmitry Kheyfits, Reg. No. 57,244
Kheyfits P.C.

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on February 24, 2017, a complete and entire copy of this Joint Motion to Terminate Proceeding was provided via email to the Patent Owner by serving the correspondence email address of record as follows:

Dmitry Kheyfits
Andrey Belenky
Kheyfits P.C
1140 Avenue of the Americas, 9th Fl.
New York, New York 10036

Thomas J. Scott, Jr.
Personalized Media Communications, LLC
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190

Email: dkheyfits@kheyfits.com

/Diana Bradley/

Diana Bradley
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(858) 678-5667