

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METASWITCH NETWORKS LTD. and
METASWITCH NETWORKS CORPORATION,
Petitioner,

v.

SONUS NETWORKS, INC. (d/b/a RIBBON COMMUNICATIONS
OPERATING COMPANY),
Patent Owner.

Case IPR2019-00395
Patent 6,950,441

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S UPDATED EXHIBIT LIST

METASWITCH-1001	U.S. Patent No. 6,950,441 to Kaczmarczyk, et al. (“the ‘441 patent”)
METASWITCH-1002	Excerpts from the Prosecution History of the ‘441 Patent (“Prosecution History”)
METASWITCH-1003	Declaration of Dr. Vishal Sharma (“Sharma”)
METASWITCH-1004	U.S. Patent No. 6,570,869 to Shankar et al. (“Shankar”)
METASWITCH-1005	U.S. Patent No. 7,336,649 to Huang (“Huang”)
METASWITCH-1006	U.S. Patent No. 6,614,781 to Elliott et al. (“Elliott”)
METASWITCH-1007	U.S. Patent No. 6,111,893 to Volftsun et al. (“Volftsun”)
METASWITCH-1008	Christian Huitema, An Architecture For Residential Internet Telephony Service, IEEE Internet Computing, June 1999(“Huitema”)
METASWITCH-1009	RESERVED
METASWITCH-1010	U.S. Patent No. 6,418,205 to Capers et al. (“Capers”)
METASWITCH-1011	U.S. Patent No. 6,052,448 to Janning (“Janning”)
METASWITCH-1012	U.S. Provisional Application 60/127,169 (“’169 Provisional”)
METASWITCH-1013	Declaration of Gerard P. Grenier re Huitema
METASWITCH-1014	Declaration of Gerard P. Grenier re Sestak
METASWITCH-1015	RESERVED

METASWITCH-1016	U.S. Patent No. 6,249,572 (“Brockman”)
METASWITCH-1017	M. Sestak et al., Traffic Monitoring in a Network of PBXs, GLOBECOM ’90: IEEE Global Telecommunications Conference and Exhibition (“Sestak”)
METASWITCH-1018	Media Gateway Control Protocol (MGCP), V1.0, The Internet Society (October, 1999) (“MGCP Specification”)
METASWITCH-1019	Settlement and Cross-License Agreement

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 & 42.74, Metaswitch Networks Ltd. and Metaswitch Networks Corporation (collectively “Petitioner”) and Sonus Networks, Inc. (d/b/a Ribbon Communications Operating Company) (“Patent Owner”) jointly move for termination of the *inter partes* review of U.S. Patent No. 6,950,441 (“the ‘441 Patent”) bearing Case No. IPR2019-00395. This Joint Motion was authorized by the Board pursuant to its e-mail dated June 4, 2019.

On December 5, 2018, Petitioner filed its Petition for Inter Partes Review (Paper 2). Patent Owner filed its preliminary response on April 10, 2019 (Paper 6). The Board has yet to issue an Institution Decision. The parties have now settled their dispute, and agreed to terminate this *inter partes* review of the ‘441 Patent.

Specifically, the parties have entered into an agreement entitled “Settlement and Cross-License Agreement.” This agreement is in writing and was executed by Patent Owner and Petitioner on May 29, 2019. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement and Cross-License Agreement is being submitted concurrently herewith as Confidential Exhibit 1019. The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.

Furthermore, the suit between the parties, captioned *Sonus Networks Inc. v. Metaswitch Networks Ltd. et al.*, 2:18-cv-00057 E.D. Texas, has been dismissed with prejudice. The ‘441 Patent is the subject of another IPR proceeding, No. IPR2019-00396, which the parties also seek to terminate.

No proceeding or litigation between Patent Owner and Petitioner is contemplated in the foreseeable future in view of the Settlement and Cross-License Agreement.

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

Finally, submitted concurrently herewith is a request by Patent Owner and Petitioner that the Settlement and Cross-License Agreement be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Dated: June 5, 2019

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on June 5, 2019, a complete and entire copy of this Joint Motion to Terminate Proceeding and Exhibit 1019 were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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