

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.,¹
Patent Owner.

Case IPR2018-01719 (Patent 7,158,627 B1)²
Case IPR2019-00051 (Patent 6,775,269 B1)
Case IPR2019-00052 (Patent 6,775,269 B1)
Case IPR2019-00272 (Patent 7,602,710 B2)
Case IPR2019-00273 (Patent 7,602,710 B2)
Case IPR2019-00395 (Patent 6,950,441 B1)
Case IPR2019-00396 (Patent 6,950,441 B1)

METASWITCH NETWORKS LTD. and
METASWITCH NETWORKS CORPORATION,
Petitioner,

v.

¹ The Patent Owner Mandatory Notices in each of the following seven cases indicate that Sonus Networks, Inc. does business as “Ribbon Communications Operating Company” and is 100% owner by Ribbon Communications Inc. *See, e.g.*, IPR2018-01719 Paper 3.

² This Order applies to each of the listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this heading style in any subsequent papers.

IPR2018-01719 (Patent 7,158,627 B1)
IPR2019-00051 (Patent 6,775,269 B1)
IPR2019-00052 (Patent 6,775,269 B1)
IPR2019-00272 (Patent 7,602,710 B2)
IPR2019-00273 (Patent 7,602,710 B2)
IPR2019-00395 (Patent 6,950,441 B1)
IPR2019-00396 (Patent 6,950,441 B1)
IPR2019-00795 (Patent 7,460,536 B1)
IPR2019-00796 (Patent 7,460,536 B1)

RIBBON COMMUNICATIONS OPERATING COMPANY, INC.,³
Patent Owner.

Case IPR2019-00795 (Patent 7,460,536 B1)
Case IPR2019-00796 (Patent 7,460,536 B1)

Before GEORGIANNA W. BRADEN, BARBARA A. PARVIS,
DANIEL N. FISHMAN, STACEY G. WHITE, JON M. JURGOVAN,
KIMBERLY McGRAW, JESSICA C. KAISER, and
JOHN D. HAMANN, *Administrative Patent Judges*.⁴

PER CURIAM.

ORDER
Termination of the Proceedings
35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.71(a), 42.72, and 42.74

³ Patent Owner's Mandatory Notices in each of the following two cases indicates that Ribbon Communications Operating Company, Inc. is 100% owned by Ribbon Communications Inc. *See, e.g.*, IPR2019-00795, Paper 4.

⁴ This is not an expanded panel of the Board. It is a listing of all Judges on the panels of the above-listed proceedings.

IPR2018-01719 (Patent 7,158,627 B1)
IPR2019-00051 (Patent 6,775,269 B1)
IPR2019-00052 (Patent 6,775,269 B1)
IPR2019-00272 (Patent 7,602,710 B2)
IPR2019-00273 (Patent 7,602,710 B2)
IPR2019-00395 (Patent 6,950,441 B1)
IPR2019-00396 (Patent 6,950,441 B1)
IPR2019-00795 (Patent 7,460,536 B1)
IPR2019-00796 (Patent 7,460,536 B1)

On June 5, 2019, the parties filed an authorized Joint Motion to Terminate Proceeding pursuant to 35 U.S.C. § 317 in each of the above-captioned cases. IPR2018-01719, Paper 8 (“Mot.”)⁵; IPR2019-00051, Paper 14; IPR2019-00052, Paper 14; IPR2019-00272, Paper 8; IPR2019-00273, Paper 8; IPR2019-00395, Paper 7; IPR2019-00396, Paper 7; IPR2019-00795, Paper 6; IPR2019-00796, Paper 6. In addition, in each case, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner filed a copy of a Settlement and Cross-License Agreement (*see, e.g.*, Ex. 1021), along with a Joint Request to Keep Settlement Agreement Confidential (*see, e.g.*, Paper 9) requesting that the agreements be kept separate from the patent file in each of the above captioned cases and be treated as business confidential information. The parties represent that the filed exhibit is a true copy of the Settlement and Cross-License Agreement and that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings. Mot. 1. The parties indicate that terminations of the proceedings are appropriate because a settlement has been reached disposing of these and related disputes and all related settlement agreements have been filed. Mot. 1–2.

⁵ Further citations are to IPR2018-01719 as representative, except as otherwise noted herein.

IPR2018-01719 (Patent 7,158,627 B1)
IPR2019-00051 (Patent 6,775,269 B1)
IPR2019-00052 (Patent 6,775,269 B1)
IPR2019-00272 (Patent 7,602,710 B2)
IPR2019-00273 (Patent 7,602,710 B2)
IPR2019-00395 (Patent 6,950,441 B1)
IPR2019-00396 (Patent 6,950,441 B1)
IPR2019-00795 (Patent 7,460,536 B1)
IPR2019-00796 (Patent 7,460,536 B1)

The above-identified cases are all in the preliminary stages, and only five of the above-identified nine cases (i.e., IPR2018-01719, IPR2019-00051, IPR2019-00052, IPR2019-00272, IPR2019-00273) have instituted *inter partes* review. A final decision on the merits of each proceeding has not yet been made. Under these circumstances, we determine that it is appropriate to terminate each case without rendering a decision on institution or final written decision. 37 C.F.R. § 42.74. Therefore, the Joint Motions to Terminate are *granted*. This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

As requested by the parties, the Settlement and Cross-License Agreement filed in each case will be treated as business confidential and kept separate from the patent file. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties' requests that the Settlement and Cross-License Agreement in each of the above-captioned cases be treated as business confidential information, to be kept separate from the patent file, are *granted*;

FURTHER ORDERED that the Settlement and Cross-License Agreements (IPR2018-01719, Ex. 1021; IPR2019-00051, Ex. 1022; IPR2019-00052, Ex. 1022; IPR2019-00272, Ex. 1018; IPR2019-00273,

IPR2018-01719 (Patent 7,158,627 B1)
IPR2019-00051 (Patent 6,775,269 B1)
IPR2019-00052 (Patent 6,775,269 B1)
IPR2019-00272 (Patent 7,602,710 B2)
IPR2019-00273 (Patent 7,602,710 B2)
IPR2019-00395 (Patent 6,950,441 B1)
IPR2019-00396 (Patent 6,950,441 B1)
IPR2019-00795 (Patent 7,460,536 B1)
IPR2019-00796 (Patent 7,460,536 B1)

Ex. 1018; IPR2019-00395, Ex. 1019; IPR2019-00396, Ex. 1021; IPR2019-00795, Ex. 1011; and IPR2019-00796, Ex. 1011) shall be treated as business confidential information and shall be kept separate from the pertinent file consistent with 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the Joint Motions to Terminate are *granted*; and

FURTHER ORDERED that the above-identified proceedings are *terminated* due to settlement.

IPR2018-01719 (Patent 7,158,627 B1)
IPR2019-00051 (Patent 6,775,269 B1)
IPR2019-00052 (Patent 6,775,269 B1)
IPR2019-00272 (Patent 7,602,710 B2)
IPR2019-00273 (Patent 7,602,710 B2)
IPR2019-00395 (Patent 6,950,441 B1)
IPR2019-00396 (Patent 6,950,441 B1)
IPR2019-00795 (Patent 7,460,536 B1)
IPR2019-00796 (Patent 7,460,536 B1)

For PETITIONER:

Joshua Griswold
David Conrad
Craig Deutsch
Ricardo Bonilla
FISH & RICHARDSON P.C.
griswold@fr.com
conrad@fr.com
deutsch@fr.com
rbonilla@fr.com

For PATENT OWNER:

Chad Walters
Kurt Pankratz
Jamie Lynn
BAKER BOTTS L.L.P.
chad.walters@bakerbotts.com
kurt.pankratz@bakerbotts.com
jamie.lynn@bakerbotts.com