

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

SONY INTERACTIVE ENTERTAINMENT LLC  
Petitioner

v.

MOTIVA PATENTS, LLC  
Patent Owner

---

Case No. IPR2019-01134  
U.S. Patent No. 8,159,354

---

**JOINT MOTION TO TERMINATE THE PETITION  
FOR *INTER PARTES* REVIEW OF U.S. PATENT 8,159,354  
UNDER 37 C.F.R. 42.71(A)**

## **I. INTRODUCTION**

Pursuant to 37 C.F.R. 42.71(a), Petitioner Sony Interactive Entertainment LLC and Patent Owner Motiva Patents, LLC jointly request termination of the petition for *Inter Partes* Review of U.S. Patent 8,159,354 in IPR2019-01134. On July 30, 2019, the parties informed the Board of a settlement agreement between Petitioner and its affiliates and Patent Owner via e-mail and requested authorization to file a joint motion to terminate the petition with respect to both the Patent Owner and Petitioner. As set forth in an e-mail dated July 31, 2019, the Board authorized the filing of the requested joint motion to terminate this petition. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

## **II. ARGUMENT**

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

**A. Brief Explanation as to Why Termination Is Appropriate**

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The parties are concurrently filing a copy of the settlement agreement as Exhibit 1027 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b). The undersigned represents that Exhibit 1027 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding. The parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

Termination of this petition for IPR is appropriate as the Board has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). This proceeding is still in its preliminary phase, no preliminary response has been filed, and the Board has yet to issue a decision on institution. The parties have now settled their dispute and have reached agreement to terminate the petition. The USPTO can conserve its resources through terminating now, removing the need for the Board to further consider the arguments, to issue an Institution Decision, and to render a Final Decision.

Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines*,

*Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Ending this petition for IPR early promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680 (Aug. 14, 2012).

## **B. Identification of Parties and Status of Litigation**

This petition for *Inter Partes* review is related to a lawsuit filed in the District Court for the Eastern District of Texas, captioned as *Motiva Patents, LLC v. Sony Corporation et al.*, Case No. 9:18-cv-00180 (“District Court Litigation”), which names Sony Corporation and Sony Interactive Entertainment Inc. as defendants

(“Sony Defendants”). On July 31, 2019, the parties filed a *Joint Motion for Dismissal With Prejudice of the Sony Defendants* in the District Court Litigation.

The ’354 Patent is also asserted in other lawsuits filed in the District Court for the Eastern District of Texas including, *Motiva Patents, LLC v. HTC Corporation*, Case No. 9:18-cv-00179 and *Motiva Patents, LLC v. Facebook Technologies, LLC f/k/a Oculus VR, LLC*, Case No. 9:18-cv-00178. These cases are still pending.

### **C. Identification and Status of Related Proceedings Before the USPTO**

Petitioner also filed a petition for *Inter Partes* Review of related U.S. Patent 9,427,659 (“’659 Patent Proceeding”). *Sony Interactive Entertainment LLC v. Motiva Patents LLC*, Case No. IPR2019-01150. The parties are concurrently requesting termination of the ’659 Patent Proceeding.

### **III. CONCLUSION**

Therefore, the parties respectfully request termination of the petition for *Inter Partes* Review of U.S. Patent 8,159,354 (IPR2019-01134).

Respectfully submitted,

BY: /s/ Abran J. Kean  
Abran J. Kean, Reg. No. 58,540

*COUNSEL FOR PETITIONER*

BY: /s/ Matthew J. Antonelli  
Matthew J. Antonelli, Reg. No. 45,973

*COUNSEL FOR PATENT OWNER*

**CERTIFICATE OF SERVICE ON PATENT OWNER**  
**UNDER 37 C.F.R. § 42.6**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on August 14, 2019 the foregoing *JOINT MOTION TO TERMINATE THE PETITION FOR INTER PARTES REVIEW OF U.S. PATENT 8,159,354 UNDER 37 C.F.R. 42.71(A)* was served via electronic filing with the Board and via Electronic Mail on the following counsel of record for Patent Owner:

Matthew J. Antonelli (Reg. No. 45,973)  
ANTONELLI, HARRINGTON & THOMPSON LLP  
4306 Yoakum Blvd., Ste. 450  
Houston, TX 77006  
matt@ahtlawfirm.com

Larry D. Thompson, Jr. (Reg. No. 43,952)  
ANTONELLI, HARRINGTON & THOMPSON LLP  
4306 Yoakum Blvd., Ste. 450  
Houston, TX 77006  
larry@ahtlawfirm.com

Zachariah S. Harrington (Reg. No. 44,742)  
ANTONELLI, HARRINGTON & THOMPSON LLP  
4306 Yoakum Blvd., Ste. 450  
Houston, TX 77006  
zac@ahtlawfirm.com

Michael D. Ellis (Reg. No. 72,628)  
ANTONELLI, HARRINGTON & THOMPSON LLP  
4306 Yoakum Blvd., Ste. 450  
Houston, TX 77006  
michael@ahtlawfirm.com

/s/ Abran J. Kean  
Abran J. Kean, Reg. No. 58,540

*COUNSEL FOR PETITIONER*