

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY LIMITED,
Petitioner

v.

MOBILE IRON, INC.,
Patent Owner

Case IPR2020-01604
U.S. Patent No. 8,359,016

JOINT MOTION TO TERMINATE PROCEEDING

Mail Stop “PATENT BOARD”

Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313

PETITIONER'S UPDATED EXHIBIT LIST

| <i>Exhibit #</i> | <i>Description</i> |
|-------------------------|---|
| 1001 | U.S. Patent No. 8,359,016 to Lindemann et al. (“’016 patent”) |
| 1002 | Declaration of David Goldschlag, Ph.D. in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,359,016 (“Goldschlag Decl.”) |
| 1003 | Prosecution History of U.S. Patent No. 8,359,016 (“Prosecution History”) |
| 1004 | U.S. Patent No. 7,409,208 to Clare <i>et al.</i> (“Clare”) |
| 1005 | U.S. Patent No. 8,578,366 to Ricci (“Ricci”) |
| 1006 | U.S. Patent Pub. No. 2005/0257209 to Adams <i>et al.</i> (“Adams”) |
| 1007 | U.S. Patent Pub. No. 2008/0052138 to Marsh <i>et al.</i> (“Marsh”) |
| 1008 | Complaint for Patent Infringement, <i>MobileIron, Inc. v. BlackBerry Corporation</i> , Case No. 3:20-cv-02877-JCS (N.D.C.A.), filed April 27, 2020. |
| 1009 | First Amended Complaint for Patent Infringement, <i>MobileIron, Inc. v. BlackBerry Corporation</i> , Case No. 3:20-cv-02877-JCS (N.D.C.A.), filed June 29, 2020. |
| 1010 | U.S. Patent Pub. No. 2009/0254753 to De Atley <i>et al.</i> (“De Atley”) |
| 1011 | MobileIron and Good Technology Announce Settlement of Litigation (Dec. 1, 2015), available at: https://www.mobileiron.com/en/company/press-room/press-releases/mobileiron-and-good-technology-announce-settlement-litigation |
| 1012 | U.S. Provisional Appl. No. 61/323,696 to Ricci (“Ricci provisional”) |
| 1013 | Microsoft Computer Dictionary, Fifth Edition (2002). |
| 1014 | Curriculum Vitae of David Goldschlag, Ph.D. |

| <i>Exhibit #</i> | <i>Description</i> |
|-------------------------|---|
| 1015 | Joint Stipulation and Proposed Order to Stay, <i>Good Tech. Corp. v. MobileIron, Inc.</i> , Case No. 5:12-cv-5826-PSG (N.D.C.A.), filed Oct. 19, 2015. |
| 1016 | License and Settlement Agreement between Good Technology and MobileIron, Inc. (PROTECTIVE ORDER MATERIAL) |
| 1017 | Press Release, iPhone App Store Downloads Top 10 Million in First Weekend (2008) available at: https://www.apple.com/newsroom/2008/07/14iPhone-App-Store-Downloads-Top-10-Million-in-First-Weekend/ |
| 1018 | First Look: BlackBerry App World Open for Business, PCWorld (2009), available at: https://www.pcworld.com/article/162349/rim_blackberry_app_world_first_look.html |
| 1019 | Kristof Kimbler, App Store Strategies for Service Providers, K2K Interactive Ltd. (2010) |
| 1020 | Rachel Metz, Review: BlackBerry App World simple, light on apps, Associated Press (2009), available at: https://phys.org/news/2009-04-blackberry-app-world-simple-apps.html |
| 1021 | U.S. Patent Pub. No. 2010/0157989 to Krzyzanowski <i>et al.</i> (“Krzyzanowski”) |
| 1022 | U.S. Patent Pub. No. 2010/0088367 to Brown <i>et al.</i> (“Brown”) |
| 1023 | U.S. Patent Pub. No. 2008/0201225 to Maharajh (“Maharajh”) |
| 1024 | U.S. Patent Pub. No. 2011/0010759 to Adler (“Adler”) |
| 1025 | U.S. Patent Pub. No. 2007/0111726 to Lambert (“Lambert”) |
| 1026 | U.S. Patent No. 5,703,942 to Pinard <i>et al.</i> (“Pinard”) |
| 1027 | BREW: Bring wireless services to life, Qualcomm Incorporated (2008) |

| <i>Exhibit #</i> | <i>Description</i> |
|-------------------------|--|
| 1028 | What is a Mobile Identification Number?,Techopedia, available at: https://www.techopedia.com/definition/8378/mobile-identification-number-min |
| 1029 | Indexing in Databases, GeeksforGeeks (2019) available at: https://www.geeksforgeeks.org/indexing-in-databases-set-1/ |
| 1030 | U.S. Patent No. 6,347,312 to Byrne <i>et al.</i> (“Byrne”) |
| 1031 | Amrita Shukla et al., Role of LDAP in Enterprise, Innovations in E-Learning, Instruction Technology, Assessment, and Engineering Education (2007) |
| 1032 | List of Android Smartphones – Wikipedia, available at: https://en.wikipedia.org/wiki/List_of_Android_smartphones |
| 1033 | U.S. Patent No. 5,551,073 to Sammarco (“Sammarco”) |
| 1034 | Definition of runtime environment, PCMag Encyclopedia, available at: https://www.pcmag.com/encyclopedia/term/runtime-environment |
| 1035 | John C. Rigdon, Dictionary of Computer and Internet Related Terms, First Edition, Eastern Digital Resources, (2016) |
| 1036 | Apple iPhone App Store, available July 19, 2008, available at: https://web.archive.org/web/20080719044956/http://www.apple.com/iphone/appstore |
| 1037 | Settlement Agreement (CONFIDENTIAL) |

Petitioner and Patent Owner (collectively “Parties”) hereby jointly move for an order terminating the preliminary proceeding initiated by the petition for *inter partes* review filed on September 17, 2020, directed to Patent No. 8,359,016 (“the challenged patent”) and assigned case number IPR2020-01604.

Patent Owner has yet to file a preliminary response. The Board has yet to issue a decision to institute trial.

I. REASONS WHY TERMINATION IS APPROPRIATE

The Board emailed the Parties on March 3 & 10, 2021, to authorize this filing of a “Joint Motion To Terminate.” Termination is proper because the Parties are jointly requesting termination, this IPR proceeding is still in its early stages, and the Board has not yet “decided the merits of the proceeding.” *Samsung Electronics Co., Ltd. et al v. Neodron Ltd.*, IPR2020-01682, Paper 14, 3 (February 18, 2021); *see also Samsung Electronics Co., Ltd. v. Fundamental Innovation Systems Int’l*, IPR2018-00605, Paper 10, 2 (PTAB July 16, 2018) (noting that 35 U.S.C. § 317 “does not govern settlement prior to institution,” but explaining that “it is appropriate to dismiss the proceedings pursuant to 37 C.F.R. § 42.71(a)”). Accordingly, termination is appropriate here.

The parties are filing herewith as Exhibit 1037, a true copy of settlement agreement entered between the Parties and executed on February 22, 2021. *See* 37 C.F.R. § 42.74(c). The settlement agreement was entered into in contemplation of

terminating this proceeding. This settlement agreement is the only agreement or understanding between Petitioner and Patent Owner made in connection with, or in contemplation of terminating this proceeding. *See* 37 C.F.R. § 42.74(b). A request is being filed herewith to treat this agreement as “business confidential information” and to keep it separate from the files of the involved patent. *See* 37 C.F.R. § 42.74(c).

The Parties understand that if the Board terminates this IPR proceeding, no estoppel under 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d)(1) will attach to Petitioner. The Parties understand that if the Board terminates this petition for *inter partes* review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

The lawsuit between Patent Owner and Petitioner involving the challenged patent here has been dismissed. The parties do not contemplate any litigation or proceeding involving the challenged patent in the foreseeable future.

II. NO FUTURE PARTICIPATION BY PETITIONER

Petitioner will not be participating further in this proceeding.

III. CONCLUSION

The parties have settled all disputes relating to the challenged patent. This *inter partes* review is in an early stage, and the Board has not entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request the Board to terminate this proceeding in its entirety.

Respectfully Submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned certifies that true and correct copies of the foregoing
JOINT MOTION TO TERMINATE PROCEEDING and **Exhibit 1037** were
served in their entireties electronically via e-mail on March 11, 2021, on the
following counsel for Patent Owner:

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Respectfully Submitted,

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