

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOBILE IRON, INC.
Petitioners

v.

BLACKBERRY LIMITED,
Patent Owner

Case IPR2020-01741
Patent 7,372,961

JOINT MOTION TO TERMINATE PROCEEDING

LIST OF EXHIBITS

Exhibit No.	Description of Document
1001	U.S. Patent No. 7,372,961 B2 to Scott A. Vanstone et al. (filed December 26, 2001, issued May 13, 2008)
1002	Declaration of Professor Michael Goodrich, Ph.D.
1003	Prosecution History for U.S. Patent Application No. 10/025,924, which issued as U.S. Patent No. 7,372,961
1004	Federal Information Processing (FIPS) Publication 186, <i>Digital Signature Standard (DSS)</i> (May 19, 1994)
1005	U.S. Patent 6,697,946 to Miyaji (PCT Application filed January 28, 1997, PCT Application published July 30, 1998, U.S. Patent issued February 24, 2004)
1006	“‘Pseudo-random’ Number Generation Within Cryptographic Algorithms: The DDS case,” by Mihir Bellare, et al. (published in Proceedings of the Annual International Cryptology Conference (CRYPTO), pp. 277-291, Springer, 1997, as a part of the <i>Lecture Notes in Computer Science (LNCS)</i> book series, volume 129).
1007	<i>LEDA: a Platform for Combinatorial and Geometric Computing</i> , by Kurt Mehlhorn & Stefan Näher, Cambridge University Press, 1999
1008	Original Complaint filed April 27, 2020 in <i>MobileIron, Inc. v. Blackberry Corp., et al.</i> , Case No. 3:20-cv-02877 (N.D. Cal.)
1009	First Amended Complaint filed June 29, 2020, in <i>MobileIron, Inc. v. Blackberry Corp., et al.</i> , Case No. 3:20-cv-02877 (N.D. Cal.)
1010	First Amended Complaint filed in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.), Facebook’s Exhibit 1033 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1011	Excerpts from Menezes et al., Handbook of Applied Cryptography (1997)

Exhibit No.	Description of Document
1012	Dkt. Entry 157, <i>Corrected</i> Final Ruling on Claim Construction/ <i>Markman</i> Hearing, filed April 5, 2019, entered April 11, 2019, in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.)
1013	Dkt. Entry 652, Civil Minutes entered February 13, 2020, in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.)
1014	Dkt. Entry 655, Sealed Minutes of Motion Hearing held February 27, 2020, before Judge George H. Wu, in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.)
1015	Dkt. Entry 656, Joint Request To Vacate Pretrial Conference and Trial Date, filed March 19, 2020, in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.)
1016	Dkt. Entry 657, Order dated March 24, 2020 Vacating Pretrial Conference and Trial Date, in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.)
1017	Dkt. Entry 673, In Chambers – Order dated July 23, 2020, in <i>BlackBerry Ltd. v. Facebook, Inc. et al.</i> , Case No. 2:18-cv-01844-GW-KS (C.D. Cal.)
1018	Petition for <i>Inter Partes</i> Review, filed by Facebook, Inc., et al. in <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1019	Paper No. 14, Decision entered November 5, 2019, in <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB Nov. 5, 2019)
1020	Excerpts from Schneier, <i>Applied Cryptography</i> (2d ed. 1996), Exhibit 1008 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1021	Rose, Re: “Card-shuffling” algorithms, USENET, sci.crypt, sciath h 10, 1993), Facebook’s Exhibit 1006 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1022	Excerpts from Rao, <i>Error Coding for Arithmetic Processors</i> (1974), Facebook’s Exhibit 1018 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1023	Excerpts from Floyd, <i>Essentials of Data Processing</i> (1987), Facebook’s Exhibit 1019 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)

Exhibit No.	Description of Document
1024	Declaration of Daniele Micchiancio
1025	Affidavit of Elizabeth Rosenberg
1026	Declaration of Sylvia Hall-Ellis, Ph.D, in Support of Petitioner's Petition for <i>Inter Partes</i> Review
1027	Excerpts from Blackberry's Supplemental Responses and Objections to Facebook's Interrogatories, Facebook's Exhibit 1033 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1028	Declaration of Dr. Jonathan Katz, Facebook's Exhibit 1002 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1029	Patent Owner's Preliminary Response filed in <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1030	Declaration of Markus Jakobsson, Exhibit 2001 filed by Patent Owner in <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1031	Excerpts from <i>Microsoft Computer Dictionary, Fourth Edition</i> , 1999
1032	Federal Information Processing (FIPS) Publication 186-2, <i>Digital Signature Standard (DSS)</i> (December 15, 1998)
1033	Federal Information Processing (FIPS) Publication 186-2, <i>Digital Signature Standard (DSS)</i> (January 27, 2000)
1034	John von Neumann, <i>Various Techniques Used in Connection with Random Digits</i> , Summary by G.E. Forsythe, National Bureau of Standards Applied Math Series, 12 (1951), pp 36-38, reprinted in von Neumann's Collected Works, 5 (1963), Pergamon Press pp 768-770, Facebook's Exhibit 1017 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1035	Excerpts from M.T. Goodrich and R. Tamassia, <i>Algorithm Design and Analysis</i> , Wiley, 2015

Exhibit No.	Description of Document
1036	Federal Information Processing (FIPS) Publication 186-3, <i>Digital Signature Standard (DSS)</i> (June 2009), Patent Owner's Exhibit 2003 from <i>Facebook, Inc., et al. v. BlackBerry Ltd.</i> , IPR2019-00923 (PTAB)
1037-1054	Not used.
1055	Settlement agreement.

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 October 2, 2020, directed to Patent No. 7,372,961 (“the challenged patent”) and assigned case number IPR2020-01741.

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

1. Reasons Why Termination Is Appropriate

The Board emailed the Parties on March 3, 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 1025, 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.

2. No Future Participation by Petitioner

Petitioner will not be participating further in this proceeding.

3. 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.

Date: March 9, 2021

Respectfully submitted,

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/Michael T. Hawkins/
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Fish & Richardson P.C.
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1), the undersigned certifies that on March 9, 2021 a copy of Joint Motion to Terminate Proceeding and its supporting exhibit were provided via email, to Patent Owner by serving the email correspondence addresses of record as follows:

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