

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.
Petitioner

v.

UNWIRED PLANET, LLC
Patent Owner

Case IPR2014-00037
Patent 7,203,752

Before MICHAEL W. KIM, JENNIFER S. BISK, BARBARA A. PARVIS, and
GEORGE R. HOSKINS, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Motion to Terminate
35 U.S.C. § 315(d); 37 C.F.R. § 42.72

On October 8, 2013, Google filed a petition challenging claims 25-29 of U.S. Patent No. 7,203,752 (“the ’752 patent”) in this proceeding. Paper 1. The next day Google filed a petition in CBM2014-00006 challenging the same claims. CBM2014-00006, Paper 1. We instituted trial in both proceedings. In CBM2014-00006 we instituted a review on the following grounds: (1) claims 25-29 as directed to non-statutory subject matter under 35 U.S.C. § 101; (2) claim 26 as failing to have written description support in the specification under 35 U.S.C. § 112, ¶ 1; (3) claim 25 as being obvious over Havinis ’931 and Leonhardt; and (4) claim 25 as being obvious over Landgren and Leonhardt. CBM2014-00006, Paper 11. In this proceeding, we instituted a review solely on claim 25 as anticipated by Havinis ’102. Paper 9.

On May 13, 2014, Google filed a Motion to Terminate this proceeding under 35 U.S.C. § 315(d) without issuing a final written decision under 35 U.S.C. § 318(a). Paper 14 (“Motion”); *see also* 37 C.F.R. § 42.72. Unwired Planet filed a response. Paper 18 (“Response”). Unwired Planet stated that it “does not oppose termination of the IPR,” but stated that we should deem the Motion to Terminate an abandonment of Google’s IPR under 37 C.F.R. § 42.73(b)(4) and issue a final written decision against Google. Response 1.

On June 11, 2014, a conference call was held between counsel for both parties and the panel in this proceeding. Google’s counsel stated that if termination without a final written decision is not available as a remedy, Google would like to continue the proceeding. Unwired Planet’s counsel stated that it does, in fact, oppose termination unless such termination is accompanied by a final written decision.

Based on these representations, we decline to interpret Google’s Motion to Terminate as abandonment under § 42.73(b)(4) as suggested by Unwired Planet.

We also decline to interpret Unwired Planet's Response as an agreement to termination. Finally, we decline to terminate this proceeding without a final written decision as requested by Google. Google has not pointed us to any case, which was terminated for reasons other than that the parties filed a joint request for termination under 35 U.S.C. §§ 317(a) or 327(a) (*see, e.g.*, IPR2013-00197, Paper 25), or where the Board is unable to determine obviousness (IPR2013-00036, Paper 65). We conclude that it is not appropriate, in this circumstance, to exercise our discretion under § 315(d) to terminate this proceeding without a final written decision over Unwired Planet's objections.

Accordingly,

ORDERED that Google's Motion to Terminate is **DENIED**.

FOR PETITIONER:

Michael V. Messinger
Joseph E. Mutschelknaus
STERNE, KESSLER, GOLDSTEIN, & FOX P.L.L.C.
mikem-PTAB@skgf.com
jmutsche-PTAB@skgf.com

FOR PATENT OWNER:

Timothy E. Bianchi
Thomas C. Reynolds
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
tbianchi@slwip.com
treynolds@slwip.com
SLW-PTAB@slwip.com