UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.
Petitioner

v.

OPENTV, INC.
Patent Owner

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Case CBM2016-00066
Patent 7,055,169

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JOINT MOTION TO TERMINATE PROCEEDING

INTRODUCTION

Petitioner Apple Inc., Patent Owner parent Kudelski S.A., and third party RPX Corporation have made five agreements that, taken together, resolve all underlying disputes between the parties, including this proceeding. In an Order dated July 18, 2016 (Paper 6), the Board authorized the parties to file upon completion of a settlement a joint motion to terminate and a joint request to file settlement agreement as business confidential information. As required by the Board, the parties are submitting true copies of the five agreements along with this joint motion to terminate and a joint request to file settlement agreement as business confidential information:

- Patent License Agreement between Apple and Kudelski (Ex. 2001)

- Patent License Agreement between Kudelski and RPX (Ex. 2002)

- Letter Agreement between Kudelski, RPX, and Apple (Ex. 2003)

- Letter Agreement No. 2 between Kudelski and Apple (Ex. 2004)

- Agreement between Apple and RPX (Ex. 1011)

Both parties have access to the Patent License Agreement between Apple and Kudelski; the Letter Agreement between Kudelski, RPX, and Apple; and the Letter Agreement No. 2 between Kudelski and Apple, but each of the other agreements preclude one of the parties from disclosing it to the other of the parties. Specifically, the Patent License Agreement between Kudelski and RPX cannot be

shared with Petitioner. Also, the Agreement between Apple and RPX cannot be shared with Patent Owner. The parties have thus agreed to file those two agreements as "available only to Board," and to waive service of the agreements on each other. Indeed, it would be contrary to the intent of the parties and the express confidentiality provision of those two agreements for Petitioner or Patent Owner to have access to all of them.

The parties jointly certify that aside from the five agreements the parties are filing, there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. Although other agreements exist, none of them relates to the termination of this proceeding.

STATUS OF PROCEEDINGS

The following are the only proceedings either between the parties in the United States or that involve the subject patent.

District Court Case	U.S. Patent Nos.	Status
OpenTV, Inc. et al. v. Apple Inc., Case No. 3:14-cv-01622 (N.D. Cal.)	5,689,799 5,884,033 5,566,287 6,985,586 7,900,229	The parties have filed a joint motion to dismiss this litigation.
OpenTV, Inc. et al. v. Apple Inc., Case No. 5:15-cv-02008 (N.D. Cal.)	6,148,081 6,233,736 7,055,169 7,644,429 7,725,740	The parties have filed a joint motion to dismiss this litigation.
Time Warner Cable Inc. v. OpenTV, Inc., Case No. 3:16-cv-02433 (N.D. Cal.)	5,907,322 6,530,082 6,678,463 6,895,595 6,985,586 7,055,169 7,243,139 7,536,704 7,669,212	The Complaint was not served, and a notice of voluntary dismissal was filed August 2, 2016.
Yahoo! Inc. v. Kudelski SA et al., Case No. 5:16-cv-00349 (N.D. Cal.)	6,148,081 6,233,736 6,758,754 7,028,327 7,055,169 7,243,139 7,409,437 7,444,656 7,752,642 7,900,229	This case was dismissed with prejudice on May 27, 2016 in view of a settlement between the parties.

OpenTV, Inc. et al. v. Verizon Commc'ns, Inc. et al., Case No. 6:15-cv-00951 (E.D. Tex.)	6,018,768 6,233,736 6,678,463 7,055,169 7,243,139 7,900,229 RE40,334	This case was dismissed with prejudice on March 17, 2016 in view of a settlement between the parties.
OpenTV Inc. v. Netflix, Inc., Case No. 1:12-cv-01733 (D. Del.)	6,018,768 6,233,736 7,055,169 7,409,437 7,490,346 7,949,722 8,107,786	This case was transferred to N.D. Cal. (see Case No. 3:14-cv-01525 below) and later dismissed without prejudice on February 11, 2015 in view of a settlement between the parties.
OpenTV Inc. v. Netflix, Inc., Case No. 3:14-cv-01525 (N.D. Cal.)	6,018,768 6,233,736 7,055,169 7,409,437 7,490,346 7,949,722 8,107,786	This case was dismissed without prejudice on February 11, 2015 in view of a settlement between the parties.
OpenTV Inc. et al. v. Netflix, Inc., Case No. 3:14-cv-01723 (N.D. Cal.)	6,018,768 6,233,736 7,055,169 7,305,691 7,409,437 7,490,346 7,644,429 7,949,722 8,107,786 8,332,268 8,621,541	This case was dismissed without prejudice on February 11, 2015 in view of a settlement between the parties.

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