

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

TRACBEAM, LLC,

Patent Owner.

Patent No. 7,525,484

Inter Partes Review No. IPR2015-01697

**TRACBEAM, LLC AND APPLE INC.'S
JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(A)**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 & 42.74, TracBeam, LLC (“Patent Owner”) and Apple Inc. (“Petitioner”) jointly move for termination of the *inter partes* review of U.S. Patent No. 7,525,484 (“the ’484 Patent”) in the above-captioned Case No. IPR2015-01697. This Joint Motion was authorized by the Board pursuant to its e-mail dated April 1, 2016.

Petitioner filed its petition for *inter partes* review of the ’484 Patent on August 12, 2015 (Paper 2). Patent Owner filed a preliminary response on November 23, 2015 (Paper 6). On February 17, 2016, the Board issued its Institution Decision (Paper 8). The parties have since settled their dispute, and agreed to terminate this *inter partes* review of the ’484 Patent.

The parties’ Settlement and License Agreement has been made in writing and was executed by Patent Owner on March 11, 2016, and by Petitioner on March 14, 2016. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement and License Agreement is being submitted concurrently herewith as Exhibit 1011. The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review, and that the Settlement and License Agreement reflects the final settlement and resolution of all disputes between Patent Owner and Petitioner regarding this *inter partes* review.

Submitted concurrently herewith is a request by Patent Owner and Petitioner that the Settlement and License Agreement be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

On August 8, 2014, Patent Owner filed a patent infringement lawsuit against Petitioner, alleging infringement of the '484 Patent and three other patents (U.S. Patent Nos. 7,298,327, 8,032,153, and 7,764,231). The lawsuit is captioned *TracBeam, LLC v. Apple Inc.*, Case No. 6:14-cv-680 (E.D. Tex.) (“the *Apple* lawsuit”). The *Apple* lawsuit is in the process of being dismissed with prejudice, and there is no litigation contemplated in the foreseeable future between Patent Owner and Petitioner in view of the Settlement and License Agreement.

While there are three other still-pending IPR proceedings between Patent Owner and Petitioner (on the three other patents in suit in the *Apple* lawsuit¹), the

¹ In Case No. IPR2015-01695, the Board instituted *inter partes* review of U.S. Patent No. 7,298,327 on February 8, 2016. In Case No. IPR2015-01701, the Board instituted *inter partes* review of U.S. Patent No. 8,032,153 on February 8, 2016. In Case No. IPR2015-01703, the Board instituted *inter partes* review of U.S. Patent No. 7,764,231 on February 19, 2016.

parties are concurrently seeking to jointly terminate those proceedings as well pursuant to the Settlement and License Agreement.

The '484 Patent is the subject of pending litigation and IPR proceedings not involving Petitioner here. In *TracBeam, LLC v. T-Mobile US, Inc. et al.*, Case No. 6:14-cv-678 (E.D. Tex.) (“the *T-Mobile* lawsuit”), TracBeam has asserted the '484 Patent against certain entities that are unrelated to Petitioner. The '484 Patent is currently the subject of *inter partes* review in Case Nos. IPR2015-01708 and IPR2015-01711, based upon August 11, 2015 petitions filed by T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson, which were granted on February 8, 2016. Those same petitioners recently filed another petition for *inter partes* review of the '484 Patent on March 8, 2016, and their petition in Case No. IPR2016-00728 is pending. Again, Petitioner here is not involved in any of the above-described proceedings (*i.e.*, the pending *T-Mobile* lawsuit or in Case Nos. IPR2015-01708, IPR2015-01711, and IPR2016-00728).

No other petitioners remain in this *inter partes* review, and no final written decision on the merits has been entered. For at least these reasons, termination of this *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a). Should this joint motion to terminate be denied, Petitioner would not continue to participate in this proceeding.

As stated in 35 U.S.C. § 317(a) and 37 C.F.R. § 42.73(d), because Patent Owner and Petitioner jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to the Petitioner.

Dated: April 5, 2016

Respectfully submitted,

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