

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMX, LLC and Dell Inc.,
Petitioner,

v.

ChriMar Systems, Inc.,
Patent Owner.

Case IPR2016-00569
Patent 8,942,107 B2

Before KARL D. EASTHOM, GREGG I. ANDERSON, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

MOTION TO TERMINATE PETITIONER AMX, LLC

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 317(a), Petitioner AMX, LLC and Patent Owner, ChriMar Systems, Inc., jointly request that the Board terminate Petitioner AMX, LLC from this proceeding. AMX and Chrimar have reached a settlement that resolves their dispute concerning the patent at issue in this proceeding. Petitioner Dell Inc. is not a party to the settlement and will remain a petitioner in this proceeding.

II. STATEMENT OF MATERIAL FACTS

1. U.S. Patent No. 8,942,107 (“the 107 patent”) is the subject of this proceeding and is one of four patents asserted against AMX in Civil Action 6:2015-cv-00164 pending before the United States District Court for the Eastern District of Texas.

2. On August 10, 2016, the Board instituted an *inter partes* review on claims 1, 5, 31, 43, 53, 58, 70, 72, 75, 83, 84, 103, 104, 111, 123, and 125 of the 107 patent. (Paper 19 at 31.) Patent Owner’s response is due November 22, 2016. (Paper 23 at 1.)

3. On November 2, 2016, AMX and Chrimar reached a settlement that resolves their dispute with respect to several patents, including the 107 patent. Dell is not a party to the settlement agreement. In accordance with 37 C.F.R. § 42.74(b), AMX and Chrimar submit a true and correct copy of the settlement agreement as Exhibit 1041 with the designation “Board Only.”¹ Pursuant to the settlement

¹ Together with this motion, the parties file a joint motion requesting that the Board

agreement, the parties have agreed to seek termination of AMX from this proceeding.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

Termination of Petitioner AMX from this proceeding is proper. The proceeding is in a relatively early stage, Patent Owner has yet to file a response, and the Board has not yet decided the merits of this proceeding. As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), AMX and Chrimar have provided a true and correct copy of their settlement agreement (Exhibit 1041), and there is no other agreement, oral or written, between AMX and Chrimar made in connection with, or in contemplation of, the termination of AMX from this proceeding. This agreement settles all litigation, including this proceeding, between AMX and Chrimar with respect to the 107 patent. Accordingly, the Board should terminate Petitioner AMX from this proceeding.

November 3, 2016

Respectfully submitted,

/Brent A. Hawkins/
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Attorney for Petitioner

/Justin S. Cohen/
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Attorney for Patent Owner

treat Exhibit 1041 as business confidential information, keep it separate from the files of the involved patent, and make it available only to the entities and under the conditions identified in 37 C.F.R. § 42.74(c).

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CERTIFICATE OF SERVICE

I certify that I sent a copy of the foregoing MOTION TO TERMINATE PETITIONER AMX, LLC on November 3, 2016 by electronic mail to the attorneys of record for the Patent Owner at the following e-mail addresses:

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/Hersh H. Mehta/
Hersh H. Mehta (Reg. 62,336)