

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMX, LLC,
Petitioner,

v.

ChriMar Systems, Inc.,
Patent Owner.

Case IPR2016-00573
Patent 9,019,838 B2

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

JOINT MOTION TO TERMINATE THE PROCEEDING

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 this proceeding. The parties have reached a settlement that resolves their dispute concerning the patent at issue in this proceeding. Given that AMX is the only Petitioner in this proceeding, the settlement effectively resolves all disputes, and this entire proceeding should be dismissed as to both Petitioner and Patent Owner.

II. STATEMENT OF MATERIAL FACTS

1. U.S. Patent No. 9,019,838 (“the 838 patent”) is the subject of this proceeding and is one of four patents asserted against Petitioner 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, 2, 7, 26, 29, 38, 40, 47, 55, and 69 of the 838 patent. (Paper 18 at 12.) Patent Owner’s response is due November 22, 2016. (Paper 22 at 1.)

3. On November 2, 2016, the parties reached a settlement that resolves their dispute with respect to several patents, including the 838 patent. In accordance with 37 C.F.R. § 42.74(b), the parties submit a true and correct copy of the settlement agreement as Exhibit 1041 with the designation “Parties and Board Only.”¹ Pursuant

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

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

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

Termination of 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), the parties have provided a true and correct copy of their settlement agreement (Exhibit 1041), and there is no other agreement, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. This agreement settles all litigation, including this proceeding, between the parties with respect to the 838 patent. Accordingly, the Board should terminate this proceeding. *See Sanofi-Aventis U.S. v. Genentech, Inc.*, IPR2015-01624, Paper 13 (P.T.A.B. Sep. 2, 2016) (terminating an *inter partes* review under similar circumstances).

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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November 3, 2016

Respectfully submitted,

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Attorney for Patent Owner

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CERTIFICATE OF SERVICE

I certify that I sent a copy of the foregoing JOINT MOTION TO TERMINATE THE PROCEEDING 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)