

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.

Petitioner

v.

PERSONALIZED MEDIA COMMUNICATIONS LLC

Patent Owner

Case No.: IPR2016-00753

Patent No.: 7,752,649

For: Signal Processing Apparatus and Methods

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

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Patent Trial and Appeal Board

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317(a), Petitioner Apple Inc. (“Apple”) and Patent Owner Personalized Media Communications, LLC (“PMC”) (collectively, the “Parties”) jointly request termination of this inter partes review (IPR) of U.S. Pat. 7,752,649 (the “’649 Patent”), Case No. IPR2016-00753. In accordance with 37 C.F.R. § 42.20(b), the parties sought and received authorization from the Board to file this motion on March 3, 2017. Paper 18.

I. GOOD CAUSE EXISTS TO DISMISS THE PETITION AND TERMINATE THE ABOVE-CAPTIONED IPR

The Parties have resolved their disputes with regard to the ’649 Patent. The Parties’ agreement with regard to the ’649 Patent is memorialized in the document filed concurrently herewith as Confidential Exhibit 1029. Termination of this proceeding is proper because the IPR is in its early stages. The Board has not “decided the merits of the proceeding before the request for termination is filed.” *See* 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 (“The Board expects that a proceeding will terminate after filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”). Though this IPR has been instituted and Patent Owner has filed its Patent Owner Response, Petitioner has not yet filed its Reply, and the Board has not yet decided the merits of the proceeding at the time this motion for termination is filed. The Parties submit that dismissal of the Petition in the above-captioned IPR will preserve the Board’s and the parties’ resource and relieve the Board of the substantial time and resources required to

consider the merits and to issue an institution decision. *See* 37 C.F.R. § 42.1(b). Lastly, dismissal of the Petition and termination of the above-captioned IPR is a just and fair resolution.

II. IDENTIFICATION OF PARTIES

This IPR Petition is related to a lawsuit filed in the Eastern District of Texas, *Personalized Media Communications LLC. V. Apple Inc.*, Case No. 2:15-cv-01366 (EDTX). The Parties have resolved their disputes with regard to the '649 Patent in that district court litigation and have filed a joint stipulation of dismissal of all of the Parties' claims and counterclaims that specifically relate to the '649 Patent. The district court case has been stayed pending resolution of the *inter partes* review of U.S. Patent Nos. 8,559,635 and 8,191,091. *See* Dkt. No. 355.

U.S. Patent No. 7,752,649 was also asserted in *Personalized Media Communications, LLC v. Top Victory Electronics (Taiwan) Co. Ltd. et al.*, C.A. No. 2:15-cv-1206 (E.D. Tex.), which has been terminated; *Personalized Media Communications, LLC v. Funai Electric Co., Ltd. et al.*, C.A. No. 2:16-cv-105 (E.D. Tex.), which is pending; and *Personalized Media Communications, LLC v. Samsung Electronics America, Inc., et al.*, Civil Action No. 2:15-cv-01754, which has been dismissed.

III. RELATED PROCEEDINGS BEFORE THE USPTO

Petitions for IPR of the '649 Patent was also filed in *Vizio, Inc. v.*

Personalized Media Communications, LLC, IPR2017-00141, -00142 and in *Samsung Electronics Co., Ltd. v. Personalized Media Communications, LLC*, IPR2017-00289 and IPR2017-00290. The parties in these IPRs jointly filed motions to terminate. The Board granted the parties' joint motions and terminated these IPRs.

In addition to the foregoing, the following IPR petitions are related to the current IPR petition and/or the related litigation: IPR2016-00754 (U.S. Patent No. 8,559,635) (Trial Instituted); Case No. IPR2016-00755 (U.S. Patent No. 8,191,091 (Trial Instituted)); and IPR2016-01520 (U.S. Patent No. 8,559,635 (Trial Instituted)). The Parties are unaware of any other matter before the USPTO that would be affected by the termination of this proceeding.

IV. CONCLUSION

For all of these reasons, the Parties respectfully request that the Board terminate this IPR.

Date: March 9, 2017

Respectfully submitted,

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APPENDIX - PETITIONER'S EXHIBIT LIST

Exhibit No.	Description
1001	Declaration of Charles Neuhauser Under 37 C.F.R. § 1.68 in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 7,752,649.
1002	U.S. Patent No. 7,752,649 to Harvey, et al.
1003	U.S. Patent No. 4,789,895 to Mustafa, et al.
1004	U.S. Patent No. 4,215,369 to Iijima.
1005	U.S. Patent No. 4,536,791 to Campbell, et al.
1006	U.S. Patent No. 4,302,775 to Widergren, et al.
1007	U.S. Patent No. 4,694,490 to Harvey, et al.
1008	<i>Personalized Media Communications LLC v. Zynga, Inc.</i> , C.A. No. 2:12-cv-68-JRG-RSP, 2013 WL 4630447 (E.D.T.X. Aug. 28, 2013).
1009	U.S. Patent Appl. No. 08/449,097: 8/27/1996 Non-Final Rejection.
1010	U.S. Patent Appl. No. 08/449,097: 1/27/1997 Applicant Arguments and Remarks Made in an Amendment.
1011	U.S. Patent Appl. No. 08/449,097: 4/2/1998 Non-Final Rejection.
1012	U.S. Patent Appl. No. 08/449,097: 10/2/1998 Amendment.
1013	U.S. Patent Appl. No. 08/449,097: 4/6/1999 Claims.
1014	U.S. Patent Appl. No. 08/449,097: 12/2/2009 Ex Parte Quayle Action.
1015	U.S. Patent Appl. No. 08/449,097: 2/1/2010 Notice of Allowance.
1016	U.S. Patent Appl. No. 08/449,097: 2/1/2010 Index of Claims.
1017	Continuity Data of U.S. Patent Appl. No. 07/096,096.
1018	Intel P8748H/P8749H/8048AH/8035AHL/8049AH/8039AHL/8050AH/8040AHL HMOS Single-Component -Bit Microcontroller Datasheet, Aug. 1989, Section 1, pp. 27-39.
1019	Plaintiff's Disclosures Under P.R. 3-1, <i>Personalized Media Communications, LLC. v. Apple Inc.</i> , C.A. No. 2:15-cv-01366-JRG-RSP (E.D.T.X. Nov. 24, 2015).
1020	Plaintiff's Identification of Claim Terms Requiring Construction, <i>Personalized Media Communications, LLC. v. Apple Inc.</i> , C.A. No. 2:15-cv-01366-JRG-RSP (E.D.T.X. Jan. 27, 2016).

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