

Paper No. _____
Filed: August 19, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

OPENTV, INC.
Patent Owner

Case IPR2016-00971
Patent 6,148,081

**JOINT REQUEST TO FILE SETTLEMENT AGREEMENT
AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT
TO 35 U.S.C. § 317(b)**

INTRODUCTION

Petitioner and Patent Owner previously filed a Joint Motion to Terminate along with five agreements that, taken together, resolved all underlying disputes between the parties, including this proceeding. In an Order dated August 10, 2016 (Paper 10), the Board ordered the Patent Owner to file a true copy of a writing that reflects an agreement or understanding between Petitioner and Patent Owner made in connection with on in contemplation of termination of this proceeding. During a call with the Board on August 9, 2016, the Board instructed the parties that it was unnecessary to file a new Joint Motion to Terminate with the writing, but indicated that the writing needed to reference the Order. As required by the Board, the parties are submitting a true copy of the writing between Petitioner and Patent Owner (Ex. 2005), which references the Order. The parties have agreed to waive service of the writing on each other.

RELIEF REQUESTED

If requested, the rules permit the parties to have any filed settlement agreement treated as business confidential information and kept separate from the files of the involved patent. 37 C.F.R. § 42.74(c). Indeed, the statute requires it.

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved

patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

35 U.S.C. § 317(b).

Pursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b), Petitioner and Patent Owner jointly request that the Office treat the writing (Exhibit 2005) as business confidential information, that the writing be kept separate from the file of the involved patent, and that the writing be made available only to Federal Government agencies on written request, or to other persons only on a showing of good cause.

Respectfully submitted,

Dated: August 19, 2016

By: /Joshua L. Goldberg/
Joshua L. Goldberg
Reg. No. 59,369

Counsel for OpenTV, Inc.

By: /Mark Miller/
Mark Miller
Reg. No. 31,401

Counsel for Apple Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317(b)** was served via e-mail on counsel of record for the Petitioner on August 19, 2016 at the following addresses:

Ryan K. Yagura
ryagura@omm.com
Brian M. Cook
bcook@omm.com
John Kevin Murray
kmurray2@omm.com
Xin-Yi Zhou
vzhou@omm.com
Anne E. Huffsmith
ahuffsmith@omm.com
Mark E. Miller
markmiller@omm.com

Dated: August 19, 2016

By: /Bradley J. Moore/
Bradley J. Moore
Legal Assistant

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP