

Paper No. _____
Filed: August 4, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

OPENTV, INC.
Patent Owner

Case IPR2016-01004
Patent 7,055,169

JOINT MOTION TO TERMINATE PROCEEDING

INTRODUCTION

Petitioner Apple Inc., Patent Owner parent Kudelski S.A., and third party RPX Corporation have made five agreements that, taken together, resolve all underlying disputes between the parties, including this proceeding. In an Order dated July 18, 2016 (Paper 6), the Board authorized the parties to file upon completion of a settlement a joint motion to terminate and a joint request to file settlement agreement as business confidential information. As required by the Board, the parties are submitting true copies of the five agreements along with this joint motion to terminate and a joint request to file settlement agreement as business confidential information:

- Patent License Agreement between Apple and Kudelski (Ex. 2001)
- Patent License Agreement between Kudelski and RPX (Ex. 2002)
- Letter Agreement between Kudelski, RPX, and Apple (Ex. 2003)
- Letter Agreement No. 2 between Kudelski and Apple (Ex. 2004)
- Agreement between Apple and RPX (Ex. 1117)

Both parties have access to the Patent License Agreement between Apple and Kudelski; the Letter Agreement between Kudelski, RPX, and Apple; and the Letter Agreement No. 2 between Kudelski and Apple, but each of the other agreements preclude one of the parties from disclosing it to the other of the parties. Specifically, the Patent License Agreement between Kudelski and RPX cannot be

shared with Petitioner. Also, the Agreement between Apple and RPX cannot be shared with Patent Owner. The parties have thus agreed to file those two agreements as “available only to Board,” and to waive service of the agreements on each other. Indeed, it would be contrary to the intent of the parties and the express confidentiality provision of those two agreements for Petitioner or Patent Owner to have access to all of them.

The parties jointly certify that aside from the five agreements the parties are filing, there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding. Although other agreements exist, none of them relates to the termination of this proceeding.

STATUS OF PROCEEDINGS

The following are the only proceedings either between the parties in the United States or that involve the subject patent.

District Court Case	U.S. Patent Nos.	Status
<i>OpenTV, Inc. et al. v. Apple Inc.</i> , Case No. 3:14-cv-01622 (N.D. Cal.)	5,689,799 5,884,033 5,566,287 6,985,586 7,900,229	The parties have filed a joint motion to dismiss this litigation.
<i>OpenTV, Inc. et al. v. Apple Inc.</i> , Case No. 5:15-cv-02008 (N.D. Cal.)	6,148,081 6,233,736 7,055,169 7,644,429 7,725,740	The parties have filed a joint motion to dismiss this litigation.
<i>Time Warner Cable Inc. v. OpenTV, Inc.</i> , Case No. 3:16-cv-02433 (N.D. Cal.)	5,907,322 6,530,082 6,678,463 6,895,595 6,985,586 7,055,169 7,243,139 7,536,704 7,669,212	The Complaint was not served, and a notice of voluntary dismissal was filed August 2, 2016.
<i>Yahoo! Inc. v. Kudelski SA et al.</i> , Case No. 5:16-cv-00349 (N.D. Cal.)	6,148,081 6,233,736 6,758,754 7,028,327 7,055,169 7,243,139 7,409,437 7,444,656 7,752,642 7,900,229	This case was dismissed with prejudice on May 27, 2016 in view of a settlement between the parties.

<p><i>OpenTV, Inc. et al. v. Verizon Commc'ns, Inc. et al.</i>, Case No. 6:15-cv-00951 (E.D. Tex.)</p>	<p>6,018,768 6,233,736 6,678,463 7,055,169 7,243,139 7,900,229 RE40,334</p>	<p>This case was dismissed with prejudice on March 17, 2016 in view of a settlement between the parties.</p>
<p><i>OpenTV Inc. v. Netflix, Inc.</i>, Case No. 1:12-cv-01733 (D. Del.)</p>	<p>6,018,768 6,233,736 7,055,169 7,409,437 7,490,346 7,949,722 8,107,786</p>	<p>This case was transferred to N.D. Cal. (see Case No. 3:14-cv-01525 below) and later dismissed without prejudice on February 11, 2015 in view of a settlement between the parties.</p>
<p><i>OpenTV Inc. v. Netflix, Inc.</i>, Case No. 3:14-cv-01525 (N.D. Cal.)</p>	<p>6,018,768 6,233,736 7,055,169 7,409,437 7,490,346 7,949,722 8,107,786</p>	<p>This case was dismissed without prejudice on February 11, 2015 in view of a settlement between the parties.</p>
<p><i>OpenTV Inc. et al. v. Netflix, Inc.</i>, Case No. 3:14-cv-01723 (N.D. Cal.)</p>	<p>6,018,768 6,233,736 7,055,169 7,305,691 7,409,437 7,490,346 7,644,429 7,949,722 8,107,786 8,332,268 8,621,541</p>	<p>This case was dismissed without prejudice on February 11, 2015 in view of a settlement between the parties.</p>

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.