

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC.,

Petitioner

v.

CHRIMAR SYSTEMS, INC.,

Patent Owner.

Case No. IPR2016-01151

U.S. Patent No. 9,019,838

JOINT MOTION TO TERMINATE THE PROCEEDING

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 317(a), Petitioner, Dell Inc., 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 Dell 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 6:15-cv-00639 pending before the United States District Court for the Eastern District of Texas.

2. On December 6, 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 9 at 2.) Patent Owner’s response is due on February 21, 2017. (Paper 10 at 6.)

3. On January 12, 2017, 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 1024 with the designation “Parties and Board

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Only.”¹ Pursuant to the settlement agreement, the parties have agreed to seek termination of this proceeding.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

Termination of this proceeding is proper. The proceeding is in a relatively early stage, Patent Owner has not filed its 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 1024), 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).

¹ Together with this motion, the parties file a joint motion requesting that the Board treat Exhibit 1024 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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January 13, 2017

Respectfully submitted,

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