

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

LIMESTONE MEMORY SYSTEMS LLC,
Patent Owner.

IPR2016-01561
U.S. Patent No. 6,233,181

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via PTAB E2E

Pursuant to 35 U.S.C. § 317(a), the Petitioner and Patent Owner jointly request termination of this *inter partes* review, which is directed to U.S. Patent No. 6,233,181.

Termination of this review is appropriate because the parties have resolved their dispute regarding U.S. Patent No. 6,233,181 and have reached an agreement to, among other things, terminate this review. Ex. 1021, Settlement Agreement (submitted as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)). “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765–66 (Aug. 14, 2012)).

The petition for review was filed on August 12, 2016. Patent Owner filed a preliminary response on November 23, 2016. The *inter partes* review was instituted on February 7, 2017. Patent Owner filed a response on May 9, 2017. Petitioner filed a reply to Patent Owner’s response on August 8, 2017. Termination at this juncture promotes efficiency, conserves Board resources and minimizes unnecessary costs.

On September 28, 2017, the parties advised the Board that they have reached a settlement, and sought authorization to file a joint motion to terminate the proceeding. The Board authorized the filing of a joint motion to terminate this

proceeding on October 10, 2017. Per the Board's authorization, a true copy of the parties' confidential written settlement agreement is being filed as an exhibit contemporaneously with this joint motion to terminate. The settlement agreement is being filed for access by the "Parties and Board Only." The parties desire that the settlement agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request for such is being filed contemporaneously.

Dated: October 18, 2017

Respectfully submitted,

/s/ John R. Hutchins
John R. Hutchins (Reg. No. 43,686)
Lead Counsel for Petitioner
Andrews Kurth Kenyon LLP
1500 K Street NW
Washington, DC 20005
T: 202.220.4200
F: 202.220.4201
jhutchins@andrewskurthkenyon.com

Rose Cordero Prey (pro hac vice)
rcordero@ andrewskurthkenyon.com)
Michael Zachary (pro hac vice)
mzachary@ andrewskurthkenyon.com

Nicholas T. Peters (Reg. No. 53,456)
Lead Counsel for Patent Owner
Fitch Even Tabin & Flannery LLP
120 South LaSalle Street, Suite 1600

Chicago, Illinois 60603
T: (312) 577-7000
F: (312) 577-7007
ntpete@fitcheven.com

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6, that a true and correct copy of JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW has been served on the Patent Owner's attorneys of record via email, on October 18, 2017 at the following addresses:

Nicholas T. Peters (Reg. No. 53,456)
Email: ntpete@fitcheven.com
Paul B. Henkelmann (Reg. No. 65,891)
Email: phenkelmann@fitcheven.com
David A. Gosse (Reg. No. 61,511)
Email: dgosse@fitcheven.com
FITCH EVEN TABIN & FLANNERY, LLP
120 South LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone: (312) 577-7000
Facsimile: (312) 577-7007
Email: LimestoneIPR@fitcheven.com

/s/ John R. Hutchins
John R. Hutchins (Reg. No. 43,686)
Lead Counsel for Petitioner