

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

D-Link Systems, Inc.,

Petitioner,

v.

Chrimar Systems, Inc.

Patent owner,

Case: PTAB-IPR2017-00752

U.S. Patent No. 8,942,107

JOINT MOTION TO TERMINATE THE PROCEEDING

I. STATEMENT OF PRECISE RELIEF REQUESTED

Under 35 U.S.C. § 317(a), Petitioner, D-Link Systems, 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 D-Link Systems, Inc. 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. 8,942,107 (“the ’107 patent”) is the subject of this proceeding and is one of four patents asserted against Petitioner in Civil Action 6:15-cv-00653 pending before the United States District Court for the Eastern District of Texas.

2. On January 23, 2017, the Petitioner filed its Petition for *Inter Parte Review* on claims 1, 5, 31, 43, 70, 72, 74, 75, 83, 103, 104, 111, 123, and 125 of the ’107 patent (Paper 2) and concurrently filed a Motion for Joinder of IPR2016-01391 concerning the same patent (Paper 3).

3. The Board has not issued its Decision to Institute *Inter Parte Review* in this proceeding.

4. On March 20, 2017, the parties reached a settlement that resolves their dispute with respect to ChriMar Systems, Inc.'s patent portfolio, including the '107 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 1019 with the designation "Parties and Board 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, the Board has not issued its Decision to Institute *Inter Parte Review* in this proceeding and 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 1019), 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 '107

¹ Together with this motion, the parties file a joint motion requesting that the Board treat Exhibit 1019 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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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).

Respectfully submitted,

Date: March 30, 2017

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing motion is being served via electronic mail (e-mail) to Patent Owner counsels of record (Chrimar@tklaw.com).

Date: March 30, 2017

/Christine Rogers/
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