

Entered: March 22, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT LLC,
Patent Owner.

Case IPR2019-00411
U.S. Patent No. 8,213,970

**JOINT MOTION TO DISMISS THE PETITION
PURSUANT TO 37 C.F.R. §§ 42.71 AND 42.74**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Apple Inc. (“Petitioner”) and Patent Owner AGIS Software Development, LLC (“Patent Owner”) (collectively, “the Parties”) jointly request termination of the *inter partes* review of U.S. Patent No. 8,213,970 (“’970 patent”), Case No. IPR2019-00411.

Pursuant to 37 C.F.R. §§ 42.5 and 42.71, 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018).

This proceeding is still in its preliminary stages. A Petition for *inter partes* review was filed on December 7, 2018 (Paper No. 1), and the Board has not yet issued a decision on institution. The Parties have settled their dispute and respectfully submit that dismissal of the Petition is proper here.

The ’970 patent was the subject of a District Court action in the Eastern District of Texas, captioned *AGIS Software Development LLC v. Apple, Inc.*, Civil Action No. TXED-2-17-cv-00516, which action has been dismissed (Dkt. #87, Mar. 14, 2019). Dismissal of the Petition here would promote efficiency and minimize unnecessary costs.

The ’970 patent is also the subject of district court cases (1) *AGIS Software Development LLC v. Huawei Device USA Inc.*, 2:17-cv-00513 (E.D.

Tex.) (dismissed); (2) *AGIS Software Development LLC v. HTC Corporation*, 2:17-cv-00514 (E.D. Tex.) (stayed); (3) *AGIS Software Development LLC v. LG Electronics, Inc.*, 2:17-cv-00515 (E.D. Tex.) (stayed); (4) *AGIS Software Development LLC v. ZTE Corporation, et al.*, 2:17-cv-00517 (E.D. Tex.) (dismissed); (5) *AGIS Software Development LLC v. Apple Inc.*, 2:17-cv-00516 (E.D. Tex.) (dismissed); and (6) *ZTE (USA) Inc. v. AGIS Software Development LLC et al.*, 4:18-cv-06185 (N.D. Cal.) (pending). The '970 patent is also the subject of IPR2018-00821 entitled *Apple Inc. v. AGIS Software Development LLC* (institution denied); IPR2018-01079 entitled *Google LLC et al. v. AGIS Software Development LLC* (pending); and IPR2019-00485 entitled *HTC Corporation et al. V. AGIS Software Development LLC* (pending).

The Parties executed a binding Confidential Settlement Agreement to terminate this proceeding effective March 11, 2019. The Settlement Agreement is submitted concurrently herewith. In accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a joint request that the Confidential Settlement Agreement be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). A true and correct copy of the Settlement Agreement is submitted with

that Request as Confidential Exhibit 1022.

Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Both Petitioner and Patent Owner support termination of the proceeding.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board dismiss this proceeding in its entirety.

Respectfully submitted,

Dated: March 22, 2019

By: / Matthew J. Moore /

Matthew J. Moore (Reg. No. 42,012)
Jonathan M. Strang (Reg. No. 61,724)
Robert Steinberg (Reg. No. 33,144)
Latham & Watkins LLP
555 Eleventh Street, NW, Ste. 1000
Washington, DC 20004-1304
Tel.: 202.637.2200
matthew.moore@lw.com
jonathan.strang@lw.com
bob.steinberg@lw.com

Lisa K. Nguyen (Reg. No. 58,018)
Latham & Watkins LLP
140 Scott Drive
Menlo Park, CA 94025
Tel.: 650.470.4848
lisa.nguyen@lw.com

Counsel for Petitioner

By: / Vincent J. Rubino, III /

Vincent J. Rubino, III (Reg. No. 68,594)
Alfred R. Fabricant (*pro hac vice* to be filed)
Peter Lambrianakos (Reg. No. 58,279)
Enrique W. Iturralde (Reg. No. 72,883)
BROWN RUDNICK LLP
7 Times Square
New York, NY 10036
212.209.4800
vrubino@brownrudnick.com
afabricant@brownrudnick.com
plambrianakos@brownrudnick.com
eiturralde@brownrudnick.com

Counsel for Patent Owner

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.