

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 IPR2019-00523
U.S. Patent No. 9,445,251

**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. 9,445,251 (“’251 patent”), Case No. IPR2019-00523.

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 January 3, 2019 (Paper No. 2), 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 ’251 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 ’251 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 '251 patent is also the subject of IPR2018-00817 entitled *Apple Inc. v. AGIS Software Development LLC* (institution denied); IPR2018-01084 entitled *Google LLC et al. v. AGIS Software Development LLC* (institution denied); IPR2018-01083 entitled *Google LLC v. AGIS Software Development LLC* (institution denied); IPR2018-01082 entitled *Google LLC v. AGIS Software Development LLC* (institution denied); IPR2018-01081 entitled *Google LLC v. AGIS Software Development LLC* (institution denied); and IPR2019-00524 entitled *Apple Inc. 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 1031.

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

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