

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

REMBRANDT WIRELESS TECHNOLOGIES, LP,

Patent Owner.

Case IPR2020-00034

U.S. Patent No. 8,023,580

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 37 C.F.R. § 42.71 and 35 U.S.C. § 317**

Pursuant to 37 C.F.R. § 42.71(a) and 35 U.S.C. § 317(a), Petitioner Apple Inc. (“Petitioner”) and Patent Owner Rembrandt Wireless Technologies, L.P. (“Patent Owner”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate the following *Inter Partes* Review Proceeding in its entirety:

IPR Case No.	Patent No.
IPR2020-00034	8,023,580

The parties notified the Patent and Trial Appeal Board of the parties’ settlement on March 23, 2020 and received authorization to file this Motion to Terminate on the same day. In support of the Motion to Terminate Proceeding, the parties state as follows:

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner and Patent Owner have filed herewith a true copy of the confidential settlement agreement. There are no collateral agreements. Because the settlement agreement is confidential, the parties respectfully request that it be treated as business confidential information, be kept separate from the underlying patent file, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This *inter partes* review has not been instituted. Petitioner filed its petition for *inter partes* review on November 5, 2019, Patent Owner filed a preliminary

response on February 13, 2020, Petitioner filed a reply to the preliminary response on March 4, 2020, and Patent Owner filed a sur-reply on March 9, 2020.

The parties have settled their dispute and the parties to the district court litigation have filed a joint motion to dismiss the suit as to all claims of U.S. Patent No. 8,023,580 (*Rembrandt Wireless Technologies, LP v. Apple Inc.*, 2:19-cv-00025 (E.D. Tex.)). The suit has now been dismissed. The parties also agreed to terminate this *inter partes* review. The parties also agreed to terminate a second *inter partes* review proceeding relating to the same patent, namely IPR2020-00033, and are simultaneously filing a corresponding motion in that case. The parties' Settlement Agreement has been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Wherefore, Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate Case Number IPR2020-00034 in its entirety and grant the request to treat the settlement agreement between the parties as business confidential information.

Petitioner and Patent Owner are available at the Board's convenience to discuss these related matters in more detail or answer any additional questions raised by this joint motion.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 was served in its entirety by causing the aforementioned document to be electronically mailed, pursuant to the parties' agreement to the following attorneys of record for the Patent

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Dated: March 30, 2020

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