

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

BELL NORTHERN RESEARCH, LLC,
Patent Owner.

Patent No. 8,416,862 B2

Inter Partes Review No. IPR2021-01590

**JOINT MOTION TO DISMISS PURSUANT TO 35 U.S.C. § 317 AND
37 C.F.R. §§ 42.72 AND 42.7**

Pursuant to 37 C.F.R. 42.71(a), Petitioner and Patent Owner jointly request dismissal of the petition for *inter partes* review of U.S. Patent No. 8,416,862 B2 (the "'862 Patent") in IPR2021-01590. On January 13, 2022, the parties informed the Board of a settlement agreement between Petitioner and Patent Owner via e-mail and requested authorization to file a joint motion to dismiss the petition with respect to both the Patent Owner and Petitioner in accordance with 37 C.F.R. § 42.20(b). As set forth in an email dated January 18, 2022, the Board authorized the filing of the requested joint motion to dismiss this petition. Accordingly, Petitioner and Patent Owner jointly request dismissal of the present proceeding, which is proper for at least the following reasons.

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The parties are concurrently filing a copy of the settlement agreement as Exhibit 2001 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b). The undersigned represents that Exhibit 2001 represents a true and accurate copy of the agreement between the parties ("Confidential Settlement Agreement") that resolves the present proceeding. The parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The parties "may terminate the proceeding . . . unless the Board has already decided the merits of the proceeding." Consolidated Office Patent Trial Practice

Guide, 4 (November 2019). This proceeding is still in its preliminary phase and the Board has yet to issue a decision on institution. The parties have now settled their dispute and have reached agreement to terminate the petition. The USPTO can conserve its resources by terminating now, removing the need for the Board to further consider the arguments, to issue an Institution Decision, and to render a Final Decision.

Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts favor settlement of litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir.) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit similarly favors settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide states that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 86 (November 14, 2019).

The parties have settled the pending district court litigation regarding the '862 Patent, *Bell Northern Research, LLC v. Apple Inc.*, Case No. 6:21-cv-00833 (W.D. Tex.). Termination of this proceeding would avoid further unnecessary legal costs.

With respect to other pending litigation or proceedings involving the '862 Patent, Patent Owner identifies the following related matters:

U.S. District Court Cases

- *Bell Northern Research, LLC v. TCL Technology Group Corporation et al.*, Case No. 2:21-cv-07323 (C.D. Cal.)
 - Complaint filed September 13, 2021, Defendants have yet to respond to Complaint
- *Bell Northern Research, LLC v. Lenovo Group Ltd. et al.*, Case No. 6:21-cv-00847 (W.D. Tex.)
 - Complaint filed August 13, 2021, parties have settled their dispute and are in the process of seeking dismissal
- *Bell Northern Research, LLC v. Oneplus Technology (Shenzhen) Co. Ltd. et al.*, Case No. 3:21-cv-02293 (N.D. Tex.)
 - Complaint filed September 27, 2021, parties have settled their dispute and are in the process of seeking dismissal

PTAB Proceedings

- *Oneplus Technology (Shenzhen) Co. Ltd. v. Bell Northern Research, LLC*, Case No. IPR2022-00048 (PTAB)
 - Petition filed October 19, 2021, parties have settled their dispute and are in the process of seeking dismissal

ITC Investigations

- *In the Matter of Certain Electronic Devices Having Wireless Communication Capabilities and Components Thereof*, Inv. No. 337-TA-1284 (ITC)
 - Complaint filed on September 24, 2021, with Initial Determination issued on November 17, 2021, with all parties other than TCL Electronics Holdings Limited, BLU Products, Inc., and HMD Global Oy (and related entities) having settled their disputes and in the process of seeking dismissal

Other than the above pending matters, Patent Owner states that there is no other pending litigation or proceeding involving the '862 Patent. Patent Owner further states that there is no other litigation or proceeding involving the '862 Patent contemplated in the foreseeable future.

For the reasons set forth above, the parties respectfully request dismissal of the petition for *inter partes* review of U.S. Patent No. 8,416,862 B2 (IPR2021-01590).

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