

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON
Patent Owner.

Case IPR2022-00338
Patent 8,995,357

JOINT MOTION TO TERMINATE PROCEEDING

APPLE LIST OF EXHIBITS

- APPLE-1001 U.S. Patent No. 8,995,357 to Erik Dahlman et al. (“the ’357 patent”)
- APPLE-1002 Excerpts from the Prosecution History of the ’357 Patent (“the Prosecution History”)
- APPLE-1003 Declaration of Jonathan Wells, Ph.D., M.B.A.
- APPLE-1004 U.S. Patent Application Publication No. 2010/0167746 to Lee et al. (“Lee-746”)
- APPLE-1005 System Information, R2-072183, 3GPP TSG RAN WG2#58, 07-11 May 2007 (“R2-072183”)
- APPLE-1006 U.S. Patent Application Publication No. 2008/0285668 to Lee et al. (“Lee-668”)
- APPLE-1007 Scheduling of D-BCH, R2-071762, 3GPP TSG-RAN WG2 #58, 7-11 May 2007 (“R2-071762”)
- APPLE-1008 U.S. Patent Application No. 2008/0056198 to Charpentier et al.
- APPLE-1009 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Radio Interface Protocol Architecture (Release 7), 3GPP TS 25.301 V7.1.0 (2007-03)
- APPLE-1010 3rd Generation Partnership Project; Technical Specification Group GSM/EDGE Radio Access Network; Mobile radio interface layer 3 specification; Radio Resource Control (RRC) protocol (Release 7), 3GPP TS 44.018 V7.8.0 (2007-03)
- APPLE-1011 Downlink Model for HSDPA, TSGR1#19(01)0312, TSG-RAN Working Group 1 #19, February 26-March 2, 2001 (“TSGR1#19(01)0312”)

APPLE-1012 System information structure (with TP), R2-071911, 3GPP TSG-RAN WG2 Meeting #58, 7-11 May 2007 (“R2-071911”)

APPLE-1013 Variable TTI proposal for HSDPA, TSGR1#18(01)0079, TSG-RAN Working Group 1, January 15-19, 2001 (“TSGR1#18(01)0079”)

APPLE-1014 U.S. Patent Application Publication No. 2007/0263528 to Mukherjee (“Mukherjee”)

APPLE-1015 U.S. Patent Application Publication No. 2007/0064669 to Classon et al.

APPLE-1016 U.S. Patent Application Publication No. 2009/0209256 to Nakashima et al.

APPLE-1017 U.S. Patent Application Publication No. 2008/0298315 to Ihm et al.

APPLE-1018 System information scheduling and change notification, R2-071337, 3GPP TSG-RAN2 Meeting #57bis, 26th-30th March 2007 (“R2-071337”) (Resubmitted as R2-071912)

APPLE-1019-1034 RESERVED

APPLE-1035 Declaration of Friedhelm Rodermund

APPLE-1036 Confidential Settlement Agreement

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ERICSSON LIST OF EXHIBITS

- Ex. 2001 Declaration of Dr. Zygmunt Haas
- Ex. 2002 Prosecution History of the '357 Patent
- Ex. 2003 Draft text proposal capturing agreements on system information, R2-072205, 3GPP TSG-RAN2 Meeting #58, 07-11 May 2007 (“Samsung Proposal”)
- Ex. 2004 System information scheduling and change notification, R2071912, 3GPP TSG-RAN2 Meeting #58, 07-11 May 2007 (“Samsung Discussion document”)
- Ex. 2005 Discussion on BCCH Update, R2-072736, 3GPP TSG-RAN2 Meeting #58bis, 25-29 June 2007 (“R2-072736”)
- Ex. 2006 *Curriculum Vitae* of Zygmunt Haas, Ph.D.
- Ex. 2007 Prosecution History of the '355 Patent
- Ex. 2008 U.S. Patent No. 9,532,355 to Erik Dahlman et. al. (“the '355 Patent”)
- Ex. 2009 Apple’s Proposed Constructions of Identified Claim Terms in related ITC Litigation

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Petitioner Apple Inc. (“Apple” or “Petitioner”) and Patent Owner Telefonaktiebolaget LM Ericsson (“Ericsson” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Apple and Ericsson move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

Apple and Ericsson (collectively, the “Settling Parties”) have reached an agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1036. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate

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