

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., HP INC., AMAZON.COM, INC., AMAZON.COM
SERVICES LLC, SAMSUNG ELECTRONICS CO., LTD., SAMSUNG
ELECTRONICS AMERICA, INC., GOOGLE LLC, DELL
TECHNOLOGIES INC. and DELL INC.

Petitioners

v.

XR COMMUNICATIONS, LLC, D/B/A VIVATO TECHNOLOGIES,
Patent Owner

IPR2022-00367¹
Patent No. 10,715,235

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

¹ Apple Inc., and HP Inc., were the original Petitioners in this proceeding (IPR2022-00367). Amazon.com, Inc., and Amazon.com Services LLC, which filed a petition in IPR2022-01353; Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Google LLC, which filed a petition in IPR2022-01362; and Dell Technologies Inc. and Dell Inc., which filed a petition in IPR2022-01398; were joined as Petitioners in this proceeding.

Patent Owner XR Communications, LLC (“XR”) and all Petitioners Apple Inc., HP Inc., Amazon.com, Inc., Amazon.com Services LLC, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Google LLC, Dell Technologies Inc., and Dell Inc. (collectively, “Petitioners”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request termination of the *inter partes* review of U.S. Patent No. 10,715,235 (“Patent-in-Suit”), Case IPR2022-00367. The parties were authorized to file this joint motion to terminate by the Board via emails on June 12 and 13, 2023.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a copy of the agreements that resolve the disputes between XR and each Petitioner relating to this IPR are filed herewith as exhibits. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought. Based on the Board’s guidance, and as agreed by the parties, XR is filing each agreement as “Filing Party and Board Only.” This will ensure that the agreement for each Petitioner will remain confidential and will not be accessible by other Petitioners.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), XR and Petitioners are concurrently filing a Joint Request to Keep Separate, which asks the Board to treat the settlement agreements as business confidential information, and to keep it separate from the files of this proceeding and the files of the Patent-in-Suit.

I. STATEMENT OF PRECISE RELIEF REQUESTED

The parties jointly request that the Board terminate the *inter partes* review of the Patent-in-Suit, Case IPR2022-00367.

II. TERMINATION OF THE PROCEEDING IS APPROPRIATE

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” This *inter partes* review has not yet been decided on the merits. XR and each Petitioner have jointly moved to dismiss the lawsuits involving the Patent-in-Suit, and those lawsuits have been dismissed. XR and Petitioners do not contemplate any future litigation or proceeding involving the Patent-in-Suit in the foreseeable future. Further, because XR and Petitioners jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to the Petitioners.

III. CONCLUSION

XR and all Petitioners have settled their disputes relating to the Patent-in-Suit. The Board has not entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request that the Board terminate this proceeding, IPR2022-00367, in its entirety.

Dated: June 16, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on June 16, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) system as well as delivering a copy via electronic mail upon all attorneys of record for Petitioners.

Dated: June 16, 2023

/ Philip Wang /
Philip Wang