

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

Apple Inc.  
Petitioner,

v.

Telefonaktiebolaget LM Ericsson  
Patent Owner.

---

Case IPR2022-00457  
Patent No. 9,509,440

---

**JOINT MOTION TO TERMINATE PROCEEDING**

**UPDATED EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
<b>1001</b>	U.S. Patent No. 9,509,440
<b>1002</b>	Certified File History of U.S. Patent No. 9,509,440 (“the ’904 Application”)
<b>1003</b>	Declaration of Dr. Apostolos Kakaes for Inter Partes Review of U.S. Patent No. 9,509,440
<b>1004</b>	<i>Curriculum Vitae</i> of Dr. Apostolos Kakaes
<b>1005</b>	Intentionally Left Blank
<b>1006</b>	U.S. Patent No. 9,648,601 (“Wang”)
<b>1007</b>	Arunabha Ghosh, et al., Fundamentals of LTE (Pub. 2011) (“Ghosh”)
<b>1008</b>	Stefania Sesia, et al., LTE - The UMTS Long Term Evolution: From Theory to Practice (2nd ed., 2011) (“Sesia”)
<b>1009</b>	3GPP TS 36.213, Evolved Universal Terrestrial Radio Access (EULTRA), Physical Layer Procedures, Version 10.3 (Release 10)
<b>1010</b>	Declaration of James Mullins in Support of the Public Availability of Fundamentals of LTE, Arunabha Ghosh, et. al., (Pub. 2011); LTE -The UMTS Long Term Evolution: From Theory to Practice, Stefania Sesia, et al., (2nd ed., 2011); and LTE for UMTS, Evolution to LTEAdvanced, Harri Holma & Antti Toskala (2nd ed., 2011)
<b>1011</b>	International Publication Number WO 2013/123961 A1 to Lahetkangas et al. (“Lahetkangas”)
<b>1012</b>	International Publication Number WO 2014/029108 A1
<b>1013</b>	Holma, Harri & Toskala, Antti, LTE for UMTS: Evolution to LTE-Advanced, Second Edition, (Pub. 2011) (“Holma”)

<b>1014</b>	Declaration of Jacob Robert Munford on Authentication of Publication
<b>1015</b>	Erik Dahlman et al., 4G LTE / LTE-Advanced for Mobile Broadband (Pub. 2011) (“Dahlman”)
<b>1016</b>	Declaration of Friedhelm Rodermund in Support of the Public Availability of 3GPP TS 36.213 V10.3
<b>1017</b>	Confidential Settlement Agreement

..

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 1017. 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

after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Settling Parties jointly request, for the following reasons.

**First**, Apple and Ericsson have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

**Second**, Apple and Ericsson have reached a settlement as to all the disputes in this proceeding and as to the ’440 patent. A true copy of the settlement agreement is being filed concurrently herewith. *See* Confidential Exhibit 1017. Apple and Ericsson request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

**Third**, termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.