UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc.
Petitioner,

v.

Telefonaktiebolaget LM Ericsson
Patent Owner.

Case IPR2022-00459
Patent No. 8,798,658

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

Exhibit 1001	U.S. Patent No. 8,798,658
Exhibit 1002	File History of U.S. Patent No. 8,798,658
Exhibit 1003	Declaration of Dr. Matthew C. Valenti for *Inter Partes* Review of U.S. Patent No. 8,798,658 ("Valenti Declaration")
Exhibit 1004	Curriculum Vitae of Matthew Valenti
Exhibit 1005	PCT Application PCT/CN2010/074128 / WO 2011/160274 ("Zhou")
Exhibit 1006	U.S. Patent No. 8,594,657 ("Wu")
Exhibit 1007	U.S. Provision Patent Application No. 61/378,400 ("Wu Provisional")
Exhibit 1008	"Minimization of Drive Tests Solution in 3GPP," Wuri A. Hapsari et al. (June 2012) ("Hapsari")
Exhibit 1009	"3GPP TR 36.805 v9.0.0," 3rd Generation Partnership Project (Dec. 2009) ("3GPP TR 36.805")
Exhibit 1010	"3GPP TS 37.320 vl.0.0," 3rd Generation Partnership Project (Aug. 2010) ("3GPP TS 37.320 vl.0.0")
Exhibit 1011	"3GPP TS 37.320 v10.0.0," 3rd Generation Partnership Project (Dec. 2010) ("3GPP TS 37.320 vl0.0.0")
Exhibit 1012	Declaration of Friedhelm Rodermund in Support of Petition for *Inter Partes* Review of U.S. Patent No. 8,798,658
Exhibit 1013	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 1013. 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 '658 patent. A true copy of the settlement agreement is being filed concurrently herewith. *See* Confidential Exhibit 1013. 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

and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Apple and Ericsson respectfully request termination of this *inter partes* review.

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