

Paper No. _____
Filed: August 4, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

OPENTV, INC.
Patent Owner

Case IPR2015-00969
Patent 5,884,033

**JOINT REQUEST TO FILE SETTLEMENT AGREEMENT
AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT
TO 35 U.S.C. § 317(b)**

INTRODUCTION

Petitioner Apple Inc., Patent Owner parent Kudelski S.A., and third party RPX Corporation have made five agreements that, taken together, resolve all underlying disputes between the parties, including this proceeding. In an email dated July 20, 2016, the Board authorized the parties to file upon completion of a settlement a joint motion to terminate and a joint request to file settlement agreement as business confidential information. As required by the Board, the parties are submitting true copies of the five agreements along with their joint motion to terminate:

- Patent License Agreement between Apple and Kudelski (Ex. 2008)
- Patent License Agreement between Kudelski and RPX (Ex. 2009)
- Letter Agreement between Kudelski, RPX, and Apple (Ex. 2010)
- Letter Agreement No. 2 between Kudelski and Apple (Ex. 2011)
- Agreement between Apple and RPX (Ex. 1013)

Both parties have access to the Patent License Agreement between Apple and Kudelski; the Letter Agreement between Kudelski, RPX, and Apple; and the Letter Agreement No. 2 between Kudelski and Apple, but each of the other agreements preclude one of the parties from disclosing it to the other of the parties. Specifically, the Patent License Agreement between Kudelski and RPX cannot be shared with Petitioner. Also, the Agreement between Apple and RPX cannot be

shared with Patent Owner. The parties have thus agreed to file those two agreements as “available only to Board,” and to waive service of the agreements on each other. Indeed, it would be contrary to the intent of the parties and the express confidentiality provision of those two agreements for Petitioner or Patent Owner to have access to all of them.

RELIEF REQUESTED

If requested, the rules permit the parties to have any filed settlement agreement treated as business confidential information and kept separate from the files of the involved patent. 37 C.F.R. § 42.74(c). Indeed, the statute requires it.

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

35 U.S.C. § 317(b).

Pursuant to 37 C.F.R. § 42.74(c) and 35 U.S.C. § 317(b), Petitioner and Patent Owner jointly request that the Office treat the five agreements (Exhibits 2008, 2009, 2010, 2011, and 1013) as business confidential information, that the five agreements be kept separate from the file of the involved patent, and that the

five agreements be made available only to Federal Government agencies on written request, or to other persons only on a showing of good cause.

Respectfully submitted,

Dated: August 4, 2016

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317(b)** was served via e-mail on counsel of record for the Petitioner on August 4, 2016 at the following addresses:

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