

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

NEODRON LTD.,
Patent Owner.

Case IPR2020-01287
U.S. Patent No. 9,411,472

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Patent Owner Neodron Ltd. and Petitioner Apple Inc. 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. 9,411,472 (“Patent-in-Suit”), Case IPR2020-01287. The parties were authorized to file this Joint Motion by the Board (via email) on February 1, 2021.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement (Patent License Agreement) that resolves the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit is filed herewith as a confidential exhibit. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Neodron and Apple are concurrently filing a Joint Request to Keep Separate, which asks the Board to treat the settlement agreement 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 IPR2020-01287, in its entirety.

II. Reasons Why Termination Is Appropriate

Termination of this proceeding with respect to all parties is proper. This *inter partes* review is still in an early stage. This Petition was filed on August 17, 2020.

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.” Because all parties request termination and the Board has not yet decided the merits of the proceeding, the Board should terminate the proceeding with respect to Apple.

When there are no petitioners remaining in an *inter partes* review, the Board may terminate the proceeding entirely. 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Apple is the only petitioner in this *inter partes* review. All parties support termination of this proceeding. With no petitioners remaining in the proceeding and no final written decision on the merits, termination of this proceeding entirely is appropriate.

The lawsuits between Neodron and Apple involving the Patent-in-Suit are in the process of being dismissed concurrently with this *inter partes* review. The parties do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future.

III. No Future Participation by Petitioners

Apple will not be participating further in this proceeding.

IV. Conclusion

The parties have settled all disputes relating to the Patent-in-Suit. This *inter partes* review is in an early stage, and the Board has not entered a final written

decision on the merits in this proceeding. Accordingly, the parties respectfully request the Board to terminate this proceeding in its entirety.

Respectfully submitted,

Date: February 5, 2021

/Neil Rubin /

Neil Rubin (Reg. No. 67,030)
Russ August & Kabat
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025
Phone: (310) 826-7474
nrubin@raklaw.com

Counsel for Patent Owner

/Adam P. Seitz/

Adam P. Seitz (Reg. No. 52,206)
ERISE IP, P.A.
7015 College Blvd., Ste. 700
Overland Park, Kansas 66211
Phone: (913) 777-5600
Adam.Seitz@eriseip.com

Counsel for Petitioners

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

The undersigned hereby certifies that the above document was served on February 5, 2021, by filing this document through the Patent Trial and Appeal Board End to End system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioners:

Adam P. Seitz, Adam.Seitz@eriseip.com
Paul R. Hart, Paul.Hart@eriseip.com
Callie A. Pendergrass, Callie.Pendergrass@eriseip.com

Date: February 5, 2021

/Neil Rubin /

Neil Rubin (Reg. No. 67,030)
Russ August & Kabat
12424 Wilshire Blvd., 12th Fl.
Los Angeles, CA 90025
Phone: (310) 826-7474
nrubin@raklaw.com

Counsel for Patent Owner