

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE, INC.  
Petitioner

v.

MULLEN INDUSTRIES LLC  
Patent Owner

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Case IPR2022-01389  
Patent No. 11,190,633

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**JOINT MOTION TO TERMINATE PURSUANT TO  
35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

## **I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Apple, Inc. (“Apple”) and Patent Owner Mullen Industries LLC (“Mullen”) jointly move to terminate this *inter partes* review proceeding in light of the parties’ settlement of their dispute related to the subject patent, U.S. Pat. No. 11,190,633. The filing of this Joint Motion was authorized by the Board in its email of October 23, 2023. The parties are submitting this joint motion to terminate this proceeding, along with a true copy of the related Settlement Agreement (Ex. 1019). Given that Apple is the only Petitioner in this *inter partes* review proceeding, the Settlement Agreement effectively resolves all disputes related to U.S. Patent No. 11,190,633 (“the ’633 patent”), and this entire proceeding should be dismissed as to both Petitioner and Patent Owner.

## **II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED**

On October 5, 2023, Petitioner and Patent Owner reached an agreement resolving the underlying dispute in the above-captioned *inter partes* review. Ex. 1019. Accordingly, termination of this IPR proceeding is appropriate because all disputes between the parties regarding the ’633 patent have been resolved. Motions to terminate based on a joint request are routinely granted in the pre-final written decision timeframe.<sup>1</sup> Accordingly, termination is appropriate because a final written decision

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<sup>1</sup> See, e.g., *Mylan Pharms. Inc. v. Qualicaps Co., Ltd.*, IPR2017-00203 (P.T.A.B. Dec. 19, 2017) (Paper 60 at 2); *Nike, Inc. v. Point 3 Basketball, LLC*, IPR2016-

has not yet issued.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement Agreement resolving the dispute in the above-captioned *inter partes* review is being submitted as Ex. 1019 by the parties, along with a 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). The parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). For at least these reasons, Patent Owner and Petitioner submit that termination of this post grant is appropriate. Pursuant to 35 U.S.C. § 317(a), because the *inter partes* review is being terminated with respect to the Petitioner, no estoppel pursuant to 35 U.S.C. § 315(e) shall attach to Petitioner Apple.

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00396 (P.T.A.B. Feb. 22, 2017) (Paper 20 at 3); *Am. Megatrends, Inc. v. Kinglite Holdings Inc.*, IPR2016-00114 (P.T.A.B. Dec. 13, 2016) (Paper 22 at 2).

Dated: October 24, 2023

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Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **JOINT  
MOTION TO TERMINATE PURSUANT TO U.S.C. § 317 AND 37 C.F.R. §  
42.74** has been served electronically via email upon the following:

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Dated: October 24, 2023

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