

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner
v.

SPEIR TECHNOLOGIES LTD.,
Patent Owner

Case No. IPR2023-00151
Patent No. 7,110,779

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R §§ 42.72, 42.74**

LIST OF EXHIBITS

APPLE-1001	U.S. Patent 7,110,779 to Thomas Jay Billhartz, <i>et al.</i> (“the ’779 Patent”)
APPLE-1002	Excerpts from the Prosecution History of the ’779 Patent (“the Prosecution History”)
APPLE-1003	Declaration of Dr. Zhi Ding
APPLE-1004	Curriculum Vitae of Dr. Zhi Ding
APPLE-1005	U.S. Patent 6,453,168 to McCrady (“McCrady”)
APPLE-1006	U.S. Patent 7,511,604 to Raphaeli, <i>et al.</i> (“Raphaeli”)
APPLE-1007	U.S. Patent 6,070,079 to Kuwahara (“Kuwahara”)
APPLE-1008	WO2003098528 to Raphaeli, <i>et al.</i> (“Raphaeli”)
APPLE-1009	U.S. Patent 7,058,414 to Rofheart (“Rofheart”)
APPLE-1010	Hargrave’s Communications Dictionary, 2001 (excerpts)
APPLE-1011	The Authoritative Dictionary of IEEE Standards Terms, 2000 (excerpts)
APPLE-1012	Federal Court Management Statistics June 2022 published by the Administrative Office of the U.S. Courts, retrieved from https://www.uscourts.gov/sites/default/files/fcms_na_distprofile0630.2022_0.pdf on August 19, 2022
APPLE-1013	Scheduling Order, <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)

APPLE-1014	Complaint for Patent Infringement Against Apple Inc., <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1015	Amended Complaint for Patent Infringement Against Apple Inc., <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1016	Preliminary Disclosure of Asserted Claims and Infringement Contentions to Defendant Apple Inc., <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1017	Apple’s Opening Claim Construction Brief, <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1018	Speir’s Responsive Claim Construction Brief, <i>Speir Technologies Ltd. v. Apple Inc.</i> , Case 6:22-cv-00077-ADA (WDTX)
APPLE-1019	U.S. Patent 6,181,944 to Uebayashi <i>et al.</i> (“Uebayashi”)
APPLE-1020	U.S. Patent 5,945,948 to Buford <i>et al.</i> (“Buford”)
APPLE-1021	U.S. Patent 5,929,806 to Birchler <i>et al.</i> (“Birchler”)
APPLE-1022	U.S. Patent 5,365,516 to Jandrell (“Jandrell”)
APPLE-1023	U.S. Patent 6,760,882 to Gesbert <i>et al.</i> (“Gesbert”)
APPLE-1024	U.S. Patent App. Pub. 2006/0234725 to Litwin (“Litwin”)
APPLE-1025	U.S. Patent App. Pub. 2002/0136226 to Christoffel <i>et al.</i> (“Christoffel”)
APPLE-1026	C. Eisenhart, “Realistic Evaluation of the Precision and Accuracy of Instrument Calibration Systems,” JOURNAL OF RESEARCH of the National Bureau of Standards-C. Engineering and Instrumentation, Vol. 67C, No.2, April-June

1963 (“Eisenhart”). Retrieved from https://nvlpubs.nist.gov/nistpubs/jres/67C/jresv67Cn2p161_A1b.pdf on September 6, 2022.

- APPLE-1027 U.S. Patent Publication 2003/0013146 to Werb (“Werb”)
- APPLE-1028 U.S. Patent Publication 2005/0130634 to Godfrey (“Godfrey”)
- APPLE-1029 U.S. Provisional No. 60/515,701 (“Godfrey-Provisional”)
- APPLE-1030 ANSI/IEEE Std 802.11, *Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications* (Aug. 20, 1999) (“IEEE 802.11”)
- APPLE-1031 Order Resetting Markman Hearing, *Speir Technologies Ltd. v. Apple Inc.*, Case 6:22-cv-00077-ADA (WDTX)
- APPLE-1032 L. van der Perre, S. Thoen, P. Vandenameele, B. Gyselinckx and M. Engels, “Adaptive loading strategy for a high speed OFDM-based WLAN,” IEEE GLOBECOM 1998 (Cat. NO. 98CH36250), 1998, pp. 1936-1940.
- APPLE-1033 Settlement Agreement

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board’s authorization by email dated December 15, 2023, Petitioner Apple Inc. (“Apple”) and Patent Owner Speir Technologies Ltd. (“Speir”) jointly move to terminate the present *inter partes* review proceeding as a result of a settlement agreement between Apple and Speir. The settlement agreement completely resolves all pending controversies between Apple and Speir concerning U.S. Patent No. 7,110,779 (“the ’779 patent”).

The parties are concurrently filing a true copy of their settlement agreement (APPLE-1033) in connection with this matter as required by statute. The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the settlement agreement be treated as business confidential information and kept separate from the file of the ’779 patent. A joint request for such treatment pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently herewith.

II. STATEMENT OF FACTS

Speir asserted the '779 patent against Apple in the action entitled *Speir Technologies Ltd. v. Apple Inc.*, Case No. 6:22-cv-00077-ADA (W.D. Tex.) (the “Litigation”), which was subsequently transferred to the Northern District of California and now bears Case No. 5:23-cv-00095-EJD.

Apple filed a petition for *inter partes* review of all claims of the '779 patent on November 30, 2022. The Board instituted *inter partes* review on June 9, 2023. Speir filed a response on August 28, 2023. Apple has not yet filed a reply, Speir has not yet filed a sur-reply, and the Board has not held oral argument. Apple is the only Petitioner in this Proceeding.

On November 18, 2023, Apple and Speir entered into a settlement agreement pursuant to which they agreed, among other things, to mutually cooperate to request the termination of this IPR proceeding. On November 21, 2023, Apple and Speir filed a Joint Motion to Dismiss all claims in the related Litigation. The Court dismissed all claims on November 28, 2023.

Apple filed the following petitions to institute *inter partes* proceedings concerning patents owned by Speir:

IPR	Patent	Filed Date
IPR2022-01512	7,321,777	September 9, 2022
IPR2023-00151	7,110,779	November 30, 2022
IPR2023-00305	7,321,777	December 9, 2022
IPR2023-00496	8,345,780	January 20, 2023

IPR	Patent	Filed Date
IPR2023-00542	7,765,399	February 1, 2023
IPR2023-00543	7,765,399	February 1, 2023

IPR2023-00305 and IPR2023-00543 were not instituted. Apple and Speir will file motions to dismiss or terminate each of the remaining proceedings in light of the settlement between Apple and Speir. Thus, once the Board grants those motions, there will be no other proceedings before the Patent Office involving both Apple and Speir.

III. LEGAL STANDARD

35 U.S.C. § 317(a) provides that “[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.” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that 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.” 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

IV. GOOD CAUSE EXISTS TO TERMINATE THE ABOVE-CAPTIONED IPR

Termination of the instant IPR is appropriate because all parties have settled all pending disputes concerning the '779 patent and the Board has not yet decided the merits of this proceeding. Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (P.T.A.B. July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)).

Further, termination of the proceeding is a just and fair resolution. The parties agree that neither Apple nor Speir will be prejudiced by the termination. Finally, the parties will benefit from preserving resources that would otherwise be expended if this motion is denied.

V. CONCLUSION

For at least these reasons, Apple and Speir respectfully request that the Board grant this Joint Motion to Terminate the above-captioned IPR proceeding.

Date: December 19, 2023

Respectfully submitted,

/Brett Cooper/

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on December 19, 2023, a complete and entire copy of this Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 AND 37 C.F.R §§ 42.72, 42.74 was provided by email to Patent Owner by serving the email correspondence addresses of record as follows:

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