

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

PARUS HOLDINGS, INC.,
Patent Owner.

IPR2023-00303
Patent No. 8,185,402

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

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74,¹ Petitioner Apple Inc. (“Apple” or “Petitioner”) and Patent Owner Parus Holdings, Inc. (“Parus”) jointly move to terminate the present *inter partes* review proceeding with respect to both the Petitioner and Patent Owner, in light of the parties’ resolution of their dispute relating to U.S. Patent No. 8,185,402 (“the ’402 patent”) and the executed written agreement regarding the parties’ resolution.

Termination with respect to Petitioner and Patent Owner Parus is appropriate in the instant proceeding because the dispute between the parties has been resolved. The parties are filing, concurrently herewith, a true copy of the executed written agreement between Apple and Parus as Exhibit 1100. The parties certify that, other than Exhibit 1100, the parties made no collateral agreements or understandings in connection with, or in contemplation of, the termination of the *inter partes* review. The parties further request, pursuant to 37 C.F.R. § 42.74(c), that the agreement be treated as confidential business information and kept separate from the files of the involved patent. The parties are filing, concurrently herewith, a request to treat the settlement agreement as confidential business information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c).

¹ See also Email from Goldschlager, E. to Ehmke, A., dated Feb. 27, 2023 (authorizing parties to file a Joint Motion to Terminate and a Joint Request to File Settlement Agreement as Business Confidential Information).

The applicable statute provides that an *inter partes* review proceeding “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.” 35 U.S.C. § 317(a) (emphasis added). Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding. Indeed, the Office Patent Trial Practice Guide provides:

N. Settlement. There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. 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.

The Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14 2012).

Petitioner filed IPR2023-00303 on December 23, 2022. No institution decision has been issued. Accordingly, the Board has not decided the merits of the proceeding.

Because the Board has not yet decided the merits of the present *inter partes* review proceeding, Section 317 provides that the proceeding should be terminated with respect to Petitioner. And because Apple is the only petitioner in this *inter*

partes review, no petitioner will remain, and the Office may terminate the review in its entirety under Section 317. No public interest factors militate against termination of this proceeding with respect to both Petitioner and Patent Owner in light of the circumstances of this proceeding.

Under 35 U.S.C. § 317(a), because Petitioner Apple and Patent Owner Parus request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Petitioner Apple.

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated with respect to both Petitioner and Patent Owner.

Dated: March 3, 2023

Respectfully submitted,

McKool Smith, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701

/s/ John B. Campbell

John B. Campbell
Lead Counsel for Patent Owner
Reg. No. 54,665

Dated: March 3, 2023

Respectfully submitted,

HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219

/Andrew S. Ehmke/

Andrew S. Ehmke
Lead Counsel for Petitioner
Reg. No. 50,271

CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

The undersigned hereby certifies that the above-captioned **JOINT
MOTION TO TERMINATE PURSUANT TO 35 U.S.C § 317 AND 37 C.F.R.**

§ 42.74 and supporting materials have been served in its entirety this 3rd Day of

March 2023 on the following parties via electronic mail:

John B. Campbell, Lead Counsel
McKool Smith, P.C.
303 Colorado Street, Suite 2100
Austin, Texas 78701
jcampbell@mckoolsmith.com
ParusAppleIPR@mckoolsmith.com

Scott W. Hejny, Backup Counsel
McKool Smith, P.C.
300 Crescent Court, Suite 1500
Dallas, Texas 75201
shejny@mckoolsmith.com

/Andrew S. Ehmke/

Andrew S. Ehmke
Lead Counsel for Petitioner
HAYNES AND BOONE, LLP
2323 Victory Avenue, Suite 700
Dallas, Texas 75219