UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner
v.

TOGAIL TECHNOLOGIES LTD.,
Patent Owner

Case No. IPR2023-00644
Patent No. 11,115,165

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

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 Togail Technologies Ltd. ("Togail") jointly move to terminate the present *inter partes* review proceeding as a result of a settlement agreement between Apple and Togail. The settlement agreement completely resolves all pending controversies between Apple and Togail concerning U.S. Patent No. 11,115,165 ("the '165 patent").

The parties are concurrently filing a true copy of their settlement agreement 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 '165 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

Togail asserted the ’165 patent against Apple in the action entitled *Togail Technologies Ltd. v. Apple Inc.,* Case No. 6:22-cv-00326-ADA (W.D. Tex.) (the “Litigation”), which was subsequently transferred to the Southern District of California, bearing Case No. 3:23-cv-00610-JO.

Apple filed a petition for *inter partes* review of all claims of the ’165 patent on March 7, 2023. The Board instituted *inter partes* review on October 11, 2023. Togail has not yet filed a response. Apple is the only Petitioner in this Proceeding.

On November 18, 2023, Apple and Togail 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 Togail 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 Togail:

IPR	Patent	Filed Date
IPR2023-00644	11,115,165	March 7, 2023
IPR2023-00645	10,743,238	March 22, 2023
IPR2023-00720	10,791,502	March 16, 2023
IPR2023-00721	10,972,972	March 17, 2023

In light of the settlement between Apple and Togail, Apple and Togail will file motions to dismiss or terminate IPR2023-00644, IPR2023-00645, and IPR2023-

00721, and Apple will file a motion to withdraw its pending request for rehearing of the Board's decision to deny institution in IPR2023-00720. Thus, once the Board grants those motions, there will be no other proceedings before the Patent Office involving both Apple and Togail.

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 '165 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 Togail 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 Togail respectfully request that the Board grant this Joint Motion to Terminate the above-captioned IPR proceeding.

Respectfully submitted,

Date: December 18, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service December 18, 2023

Manner of service Electronic Service by email: bcooper@bc-lawgroup.com; robert@auchterlaw.com; Togail_Counsel@b-clg.com

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

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