UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner
v.

SONRAI MEMORY LIMITED,
Patent Owner

Case No. IPR2023-00819
Patent No. 6,874,014

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 in anticipation of the Board's authorization in response to the joint e-mail Request for Authorization to file Joint Motions to Terminate dated December 15, 2023, Petitioner Apple Inc. ("Apple") and Patent Owner Sonrai Memory Limited ("Sonrai") jointly move to terminate the present *inter partes* review proceeding as a result of a settlement agreement between Apple and Sonrai. The settlement agreement completely resolves all pending controversies between Apple and Sonrai concerning U.S. Patent No. 6,874,014 ("the '014 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 '014 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

Sonrai asserted the ’014 patent against Apple in the action entitled *Sonrai Memory Limited v. Apple Inc.,* Case No. 6:22-cv-00787-ADA (W.D. Tex.) (the “Litigation”).

Apple filed a petition for *inter partes* review of claims 1, 3, 5, 7, 11-13, and 15 of the ’014 patent on April 12, 2023. The Board issued an institution decision on November 21, 2023. Apple is the only Petitioner in this Proceeding.

On November 18, 2023, Apple and Sonrai 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 20, 2023, Apple and Sonrai filed a Joint Stipulation of Dismissal as to 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 Sonrai:

IPR	Patent	Filed Date
IPR2023-00819	6,874,014	April 12, 2023
IPR2023-00975	6,874,014	May 26, 2023

Apple and Sonrai will file motions to dismiss or terminate each of these proceedings in light of the settlement between Apple and Sonrai. Thus, once the Board grants those motions, there will be no other proceedings before the Patent Office involving both Apple and Sonrai.

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

Date: December 18, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned "JOINT MOTION TO TERMINATE PROCEEDING" was served in its entirety on December 18, 2023, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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