Filed on behalf of: AX Wireless, LLC

Entered: July 23, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL INC., and DELL TECHNOLOGIES INC.,
Petitioner,

v.

AX Wireless, LLC,
Patent Owner.

Case IPR2024-00684
Patent No. 10,291,449

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

Exhibit List

Exhibit	Description
2001	Confidential Agreement [*Parties and Board Only*] ("AXW-2001")

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Patent Owner AX Wireless, LLC ("Patent Owner") and Petitioners Dell Inc. and Dell Technologies Inc. ("Petitioners") hereby jointly request that the above-referenced pending *inter partes* review be terminated. The Board previously authorized the parties to file a motion to terminate in an email to the parties on June 24, 2024. On July 1, 2024, the parties filed a Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 8), a Joint Request to File Confidential Statement As Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 9), and a copy of the Confidential Statement (Ex. 1049). On July 15, 2024, the Board issued an Order denying the Motion and Joint Request without prejudice. The Board authorized the parties to file a renewed motion to terminate and renewed request to treat the settlement paper as confidential (Paper 10).

Good cause exists to terminate this proceeding. Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a), such as this one. "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." PTAB Consolidated Trial Practice Guide (Nov. 2019), at 86; *see also* 35 U.S.C. § 317(a) ("An *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.”). Here, the parties respectfully submit that termination is appropriate because they have reached an agreement resolving their dispute concerning the patent at issue in the above-captioned *inter partes* review, briefing has not been completed on the issues raised in the above-captioned *inter partes* review, and the Board has not issued a final written decision or decided the merits of the proceeding. Moreover, the parties filed a Joint Stipulation for Dismissal in the United States District Court for the Eastern District of Texas on June 24, 2024 in the underlying lawsuit styled *AX Wireless LLC v. Dell Inc. and Dell Technologies Inc.*, No. 2-22-cv-00277 (E.D. Tex.).

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Patent Owner and and Petitioners submit concurrently herewith a Confidential Agreement signed by Patent Owner and Petitioners that includes all agreements that resolve the issues in the above-captioned *inter partes* review. *See* Confidential AXW-2001. In addition, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties are concurrently filing a joint request that the Confidential Agreement (Confidential AXW-2001) be treated as business confidential information, be kept separate from the file of the involved patent, and be made available, on written request to the Board, only to Federal Government agencies or to any person on a showing of good cause.

Respectfully submitted,

Dated: July 23, 2024

By: / S. Giri Pathmanaban /

S. Giri Pathmanaban (Reg. No. 75,986)
giri.pathmanaban@lw.com
Latham & Watkins LLP
300 Colorado Street, Suite 2400
Austin, TX 78701-3295
Telephone: 737.910.7300
Fax: 737.910.7301

Counsel for Patent Owner
AX Wireless, LLC

Respectfully submitted,

Dated: July 23, 2024

By: / Jonathan R. Carter /

Jonathan R. Carter (Reg. No. 75,145)
Carter-ptab@perkinscoie.com
Perkins Coie LLP
1155 Avenue of the Americas, 22nd Floor
New York, New York 10036
Tel: 212.261.6826
Fax: 212.977.1649

Counsel for Petitioners
Dell Inc. and Dell Technologies Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 23rd day of July, 2024, a true and correct copy of the foregoing **Renewed Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 and Exhibit 2001** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

Jonathan R. Carter (Reg. No. 75,145)
Perkins Coie LLP
1155 Avenue of the Americas, 22nd Floor
New York, New York 10036
Carter-ptab@perkinscoie.com
Tel: 212.261.6826
Fax: 212.977.1649

Bryan S. Banks (Reg. No. 52,588)
Perkins Coie LLP
2901 North Central Avenue, Suite 2000
Phoenix, Arizona 85012
Banks-ptab@perkinscoie.com
Tel: 602.351.8096
Fax: 602.648.7043

Matthew W. Hindman (Reg. No. 57,398)
Perkins Coie LLP
3150 Porter Drive
Palo Alto, CA 94304-1212
hindman-ptab@perkinscoie.com
Tel: 650.838.4372
Fax: 650.838.4350

By: / S. Giri Pathmanaban /

S. Giri Pathmanaban (Reg. No. 75,986)

giri.pathmanaban@lw.com
Latham & Watkins LLP
300 Colorado Street, Suite 2400
Austin, TX 78701-3295
Telephone: 737.910.7300
Fax: 737.910.7301

Counsel for Patent Owner
AX Wireless, LLC