

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMBERATEK LLC,
Patent Owner

Case No. IPR2025-00575
U.S. Patent No. 7,609,527

JOINT MOTION TO TERMINATE

LIST OF EXHIBITS

APPLE-1001	U.S. Patent No. 7,609,527 (“the ’527 patent”)
APPLE-1002	File History of U.S. Patent No. 7,609,527
APPLE-1003	Expert Declaration of Dr. R. Jacob Baker, Ph.D., P.E.
APPLE-1004	U.S. Patent No. 5,616,520 to Nishiuma et al. (“Nishiuma”)
APPLE-1005	U.S. Publication No. 2002/0149117 to Shibata (“Shibata”)
APPLE-1006	RESERVED
APPLE-1007	U.S. Publication No. 2002/0159242 to Nakatani et al. (“Nakatani”)
APPLE-1008	Japanese Patent Publication No. 2001-085473 to Onda with Certified Translation (“Onda”)
APPLE-1009	Japanese Patent Publication No. 11-191574 to Matsuda with Certified Translation (“Matsuda”)
APPLE-1010	U.S. Patent No. 4,912,844 to Parker (“Parker”)
APPLE-1011	U.S. Publication No. 2003/0034557 to Gupta et al. (“Gupta”)
APPLE-1012	RESERVED
APPLE-1013	Japanese Patent Publication No. 2002-280713 to Yoneyama with Certified Translation (“Yoneyama”)
APPLE-1014	U.S. Patent No. 5,719,438 to Beilstein et al. (“Beilstein”)
APPLE-1015	U.S. Patent No. 5,866,942 to Suzuki et al. (“Suzuki”)
APPLE-1016	U.S. Publication No. 2004/0007774 to Crane et al. (“Crane”)

APPLE-1017	U.S. Patent No. 4,774,633 to Dehaine et al. (“Dehaine”)
APPLE-1018	U.S. Patent No. 7,297,572 to Salmon (“Salmon”)
APPLE-1019	U.S. Publication No. 2003/0047806 to Stelzl et al. (“Stelzl”)
APPLE-1020	U.S. Patent No. 4,068,022 to Glick (“Glick”)
APPLE-1021	J.A. Scarlett, <i>The Multilayer Printed Circuit Board Handbook</i> , Electrochemical Publications Limited, 8 Barns Street, Ayr Scotland © 1985
APPLE-1022	J.A. Scarlett, <i>An Introduction to Printed Circuit Board Technology</i> , Electrochemical Publication Limited, 8 Barns Street, Ayr Scotland © 1984
APPLE-1023-1024	RESERVED
APPLE-1025	U.S. Publication No. 2003/0090883 to Asahi (“Asahi”)
APPLE-1026-1030	RESERVED
APPLE-1031	Rudolf F. Graf, <i>Modern Dictionary of Electronics</i> , Newnes, 7 th ed. © 1999
APPLE-1032	Alan Freedman, <i>Computer Desktop Encyclopedia</i> , Osborne/McGraw-Hill, 9 th ed. © 2001
APPLE-1033	Frank Hargrave, <i>Hargrave’s Communications Dictionary</i> , IEEE Press © 2001
APPLE-1034	RESERVED
APPLE-1035	William D. Callister, Jr., <i>Materials Science and Engineering: An Introduction</i> , 5 th Ed., John Wiley & Sons, Inc. © 2000
APPLE-1036	Simon Thomas, <i>3D-Integration: Trends and Opportunities – An Overview</i> (Materials Research Society 2003)

APPLE-1037	R. Kujala, et. al., <i>Solderless Interconnection and Packaging Technique for Embedded Active Components</i> (IEEE 1999)
APPLE-1038	U.S. Patent Publication No. 2001/0026010 to Horiuchi (“Horiuchi”)
APPLE-1039	U.S. Patent No. 6,038,133 to Nakatani et al. (“Nakatani-II”)
APPLE-1040	U.S. Patent No. 5,250,843 to Eichelberger (“Eichelberger”)
APPLE-1041	International Patent Application WO1996012296 to Suwa et al. and Certified Translation (“Suwa”)
APPLE-1042	Japanese Patent Application No. 2002-83926 to Enomoto et al. and Certified Translation (“Enomoto”)
APPLE-1043	European Patent Publication No. EP1069616 to Kurita (“Kurita”)
APPLE-1044	Aggarwal, A., et al., <i>A Model for Hierarchical Memory</i> , IBM T. J. Watson Research Center, Proceedings of the Nineteenth Annual ACM Symposium on Theory of Computing, 305-314 © 1987
APPLE-1101	Complaint for Patent Infringement (February 5, 2024), Case No. 1-24-cv-00129 (WDTX), Document 1
APPLE-1102	Amended Complaint for Patent Infringement (April 11, 2024), Case No. 1-24-cv-00129 (WDTX), Document 31 (redacted)
APPLE-1103	K. Vidal Memorandum on <i>Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation</i> , June 21, 2022
APPLE-1104	<i>United States District Courts – National Judicial Caseload Profile</i> (June 2024) (retrieved from

https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0630.2024.pdf)

APPLE-1105	Exhibit 10 to Complaint for Patent Infringement – Infringement Claim Chart for '527 Patent (February 5, 2024), Case No. 1-24-cv-00129 (WDTX), Document 1-10
APPLE-1106	Return of Service (February 8, 2024), Case No. 1-24-cv-00129 (WDTX), Document 8
APPLE-1107-1149	RESERVED
APPLE-1150	CONFIDENTIAL – Settlement Agreement
APPLE-1151	Order Granting Stipulation of Dismissal, Case No. 3:25-cv-02206-RS (NDCA), Document 115 (May 6, 2025)
APPLE-1152	Trials Email Authorizing Joint Request to File Motions Motions to Terminate and Requests to Treat the Settlement Agreement as Business Confidential Information (May 16, 2025)

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.71 and 42.74, and the Board’s authorization email of May 16, 2025 (APPLE-1152), Petitioner Apple Inc. (“Petitioner”) and Patent Owner ImberaTek LLC (“Patent Owner”) jointly move to terminate IPR2025-00584 (“the Present IPR Proceeding”) in its entirety.

II. BACKGROUND

A. Status of the Present IPR Proceeding

The Present IPR Proceeding was initiated by the filing of a Petition for *Inter Partes* Review of U.S. Patent No. 7,609,527 (“the ‘527 Patent”) on February 6, 2025. The Board accorded a filing date to the Petition on April 8, 2025, and the deadline for a decision on institution is still months away.

B. Related Matters

The ‘527 Patent was the subject of a civil action in *ImberaTek LLC v. Apple Inc.*, 3-25-cv-02206 (NDCA) (“the California Litigation”). The California litigation was dismissed by order of the court on May 6, 2025. APPLE-1151. The ‘527 Patent is not the subject of any other pending litigation.

Nine patents were asserted in the California Litigation including U.S. Patent Nos. 11,716,816, 11,071,207, 9,107,324, 8,368,201, 7,989,944, 7,609,527, 8,222,723, 7,732,909, and 8,238,113 (“the Asserted Patents”). Petitioner filed petitions for *Inter Partes* Review on eight of the Asserted Patents in the proceedings identified below (“the Related IPRs”):

<u>Proceeding No.</u>	<u>Patent No.</u>
IPR2025-00584	11,716,816
IPR2025-00583	11,071,207
IPR2025-00582	9,107,324
IPR2025-00581	8,368,201
IPR2025-00578	7,989,944
IPR2025-00575	7,609,527
IPR2025-00580	8,222,723
IPR2025-00577	7,732,909
IPR2025-00576	7,732,909

Pursuant to the Board's authorization email of May 16, 2025 (APPLE-1152), Petitioner and Patent Owner are concurrently filing joint motions to terminate each of the Related IPRs.

C. Filing of Litigation Agreement, and Certification of No Collateral Agreements or Understandings

Petitioner and Patent Owner entered into an agreement that was fully executed on May 2, 2025, which settled the parties' disputes involving the Asserted Patents. The parties are concurrently filing a true copy of the settlement agreement as Exhibit 1150, along with a Joint Request to Treat Settlement Agreement as Business Confidential Information under 37 C.F.R. § 42.74(c).

Petitioner and Patent Owner certify that no collateral agreements or understandings exist in connection with, or in contemplation of, dismissal and termination of the Present IPR Proceeding or any of the Related IPRs beyond the settlement agreement filed as Exhibit 1150.

IV. GOOD CAUSE JUSTIFIES TERMINATION OF THE PRESENT IPR PROCEEDING

The Board has recognized that termination of pre-institution IPR proceedings is available upon a showing of good cause. *See, e.g., Samsung Elec. Co. Ltd. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7, at 5 (PTAB August 3, 2021) (finding good cause for dismissal where “[t]he parties have settled their dispute, the proceedings are early in the preliminary stages, Patent Owner has not filed any preliminary responses, and the Board has not issued any decisions or otherwise invested in the merits of these proceedings”); *Apple Inc. v. Pinn, Inc.*, IPR2021-00220 Paper 10 (PTAB Mar. 19, 2021); *Staylinked Corp. v. Ivanti, Inc.*, IPR2021-00022, Paper 10 (PTAB Feb. 4, 2021); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257, Paper 16 (PTAB Jan. 2, 2020); *World Programming LTD. v. SAS Institute, Inc.*, IPR2019-01457 Paper 19 (PTAB Dec. 27, 2019).

In view of the agreement that settled the parties’ disputes involving the ‘527 Patent, Petitioner and Patent Owner respectfully submit that termination of the Present IPR Proceeding is warranted to conserve resources of the Board, to conserve resources of the parties, and to promote a speedy and just resolution of the Present IPR Proceeding. The Board has recognized that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding,” and as such, the Board “expects” a proceeding to be terminated at the parties’ request “unless the Board has already decided the merits of the proceeding.” Consolidated Trial

Practice Guide, November 2019, p. 86. Here, the merits of the Present IPR Proceeding have not been decided, let alone considered in any decision by the Board. Accordingly, good cause exists to terminate the Present IPR Proceeding in its entirety.

V. CONCLUSION

For the above reasons, Petitioner and Patent Owner jointly and respectfully request that the Board terminate the Present IPR Proceeding.

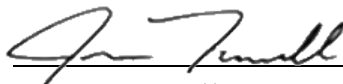
Dated: 05/23/2025

Respectfully submitted,

/Nicholas W. Stephens/

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Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on May 23, 2025, a complete and entire copy of this Joint Motion to Terminate was provided via email, to Patent Owner by serving the email correspondence addresses of record as follows:

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