UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

IMBERATEK LLC,
Patent Owner

Case No. IPR2025-00578
U.S. Patent No. 7,989,944

JOINT MOTION TO TERMINATE

LIST OF EXHIBITS

APPLE-1001	U.S. Patent No. 7,989,944
APPLE-1002	U.S. Patent No. 7,989,944 File History
APPLE-1003	Declaration of Dr. Dean Neikirk
APPLE-1004	Certified Translation of JP Patent Application Publication No. 2001-339165A ("Sakamoto")
APPLE-1005	U.S. Patent Application Publication No. 2002/0175402 ("McCormack")
APPLE-1006	U.S. Patent No. 6,489,685 ("Asahi")
APPLE-1007	U.S. Patent Application Publication No. 2001/0030059 ("Sugaya")
APPLE-1008	U.S. Patent Application Publication No. 2002/0020898 ("Vu")
APPLE-1009	U.S. Patent No. 7,294,529 ("the '529 Patent")
APPLE-1010	RESERVED
APPLE-1011	Certified Translation of JP Patent No. 3207174 ("Hayashi")
APPLE-1012	Certified Translation of JP Patent Application Publication No. 2002-016327 ("Eiji")
APPLE-1013	U.S. Patent No. 6,335,571 ("Capote")
APPLE-1014	U.S. Patent No. 6,297,551 ("Dudderar")
APPLE-1015	U.S. Patent No. 6,404,052 ("Kurita")
APPLE-1016	Certified Translation of JP Patent Application Publication No. 2001-068624A ("Imoto")
APPLE-1017	Certified Translation of PCT Publication No. WO00/09623 ("Watanabe")

APPLE-1018	U.S. Patent No. 4,179,802 ("Joshi")
APPLE-1019	U.S. Patent No. 5,608,262 ("Degani")
APPLE-1020	U.S. Patent No. 5,321,210 ("Kimbara")
APPLE-1021	U.S. Patent No. 5,146,674 ("Frankeny")
APPLE-1022	JP Patent Application Publication No. 2001-339165A ("Sakamoto")
APPLE-1023	JP Patent No. 3207174 ("Hayashi")
APPLE-1024	JP Patent Application Publication No. 2002-016327 ("Eiji")
APPLE-1025	JP Patent Application Publication No. 2001-068624A ("Imoto")
APPLE-1026	PCT Publication No. WO00/09623 ("Watanabe")
APPLE-1027	RESERVED
APPLE-1028	RESERVED
APPLE-1029	U.S. Patent No. 5,745,984 ("Cole")
APPLE-1030	RESERVED
APPLE-1031	RESERVED
APPLE-1032	RESERVED
APPLE-1033	RESERVED
APPLE-1034	RESERVED
APPLE-1035	RESERVED
APPLE-1036	U.S. Patent No. 5,880,938 ("Johnsen")
APPLE-1037-1149	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. 7,989,944 ("the '944 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 '944 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 '944 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"):

Proceeding No.	Patent No.
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 '944 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.

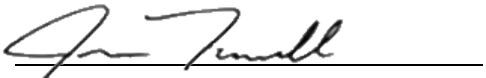
Dated: May 23, 2025

Respectfully submitted,

/Craig A. Deutsch/

Craig Deutsch, Reg. No. 69,264
Fish & Richardson P.C.

Counsel for Petitioner



James Fussell, Reg. No. 54,885
Mayer Brown LLP

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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