

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MYPORT TECHNOLOGIES, INC.,
Patent Owner.

IPR2025-01467
U.S. Patent No. 11,188,998

**JOINT MOTION TO DISMISS PETITION AND
TERMINATE IPR PROCEEDING**

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I. Introduction

Petitioner Apple Inc. and MyPort Technologies, Inc. (collectively, the “Parties”) jointly submit this motion to dismiss the Petition and terminate IPR2025-01467 under 37 C.F.R. §§ 42.71(a) and 42.72. In a January 28, 2026 email, the Board authorized the parties to file this motion.

The Board has discretion to “grant, deny, or dismiss any petition or motion.” 37 C.F.R. § 42.71(a). The Parties respectfully request that the Board dismiss the Petition (Paper 2) and terminate the proceeding for the good cause shown herein. The Parties have fully and permanently resolved their dispute with regard to U.S. Patent No. 11,188,998, the patent at issue in this IPR proceeding (hereinafter “the ’998 patent”). Specifically, all claims related to the ’998 patent in the parallel proceeding have been dismissed *with prejudice*.

Termination will achieve a just, speedy, and inexpensive resolution of the dispute. 37 C.F.R. § 42.1(b). This IPR proceeding is at an early stage. Patent Owner has not filed any briefing in this IPR proceeding, and the Board has yet to consider or issue any institution decision or final written decision. As such, preservation of resources would be real and substantial for both the Board and the Parties. Withdrawal is also in the interest of justice, as the Parties have no other disputes involving the ’998 patent, and dismissal will resolve all matters involving the ’998 patent between the Parties.

II. Argument

Good cause exists to dismiss the Petition and to terminate this IPR proceeding. The Parties' dispute with respect to the '998 patent has been fully and permanently resolved.

The '998 patent was at issue between the Parties in *MyPort Technologies, Inc. v. Apple Inc.*, No. 1-24-cv-01337 in the U.S. District Court for the District of Delaware ("the parallel proceeding"). On March 21, 2025, Petitioner filed a motion to dismiss the case for failure to state a claim, which Patent Owner opposed. Ex.1011; Ex.1012. On September, 23, 2025, the court granted Petitioner's motion, and found all patents-in-suit, including the '998 patent, invalid under 35 U.S.C. §101. Ex.1013, 1. The court authorized Patent Owner to file a motion for leave to file an amended complaint, which was denied on December 18, 2025. Ex.1014, 1.

The parties then agreed to dismiss this IPR if Patent Owner would forego appealing the district court's dismissal of the claims asserting infringement of U.S. Patent No. 11,188,998. The court subsequently dismissed *with prejudice* all claims against Petitioner, including those relating to the '998 patent. Ex.1014, 1. Patent Owner filed a notice of appeal with respect to the other patents-in-suit that specifically indicates that it "*does not appeal* the Court's dismissal of the claims asserting infringement of U.S. Patent No. 11,188,998" (the '998 patent). Ex.1015, note 1. Therefore, there is no longer—and will never be—any dispute between the

Parties with respect to the '998 patent. Good cause thus exists to dismiss the Petition and to terminate this IPR proceeding.

The Board has broad authority to dismiss a petition under 37 C.F.R. §§ 42.71(a) and 42.5(a). *See Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 at 4 (PTAB Oct. 9, 2018) (noting that “the regulations expressly provide the Board with broad authority to dismiss a petition where appropriate” and dismissing since, among other reasons, it was an “inefficient use of the Board’s resources,” and the proceedings were “at a relatively early stage”); *see also Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 at 3–4 (PTAB Dec. 9, 2015) (dismissing because the case was “at [an] early juncture” and “to promote efficiency and minimize unnecessary costs”). As with the Board’s prior decisions, the facts here warrant dismissal, at least to reduce the Parties’ expenses, conserve Board resources, and promote efficiency.

The Parties are not aware of any example wherein the Board found that it could not—or would not—terminate a proceeding under the present circumstances. In the few cases where the Board has denied a request for termination, the Board has repeatedly attributed the advanced stage of the proceeding as weighing against termination. *See, e.g., Blackberry Corp. et al. v. MobileMedia Ideas LLC*, IPR2013-00016, Paper 31 at 3 (PTAB Dec. 11, 2013) (denying motion to terminate due to the advanced stage of the proceeding where “issues had been fully briefed at

the time the parties moved to terminate the proceeding”). That is not the case here.

Patent Owner has not filed any briefing in this IPR proceeding, and the Board has not determined whether to institute review of the claims challenged in this IPR proceeding. Accordingly, the Parties’ joint request for dismissal of the Petition and termination of the IPR proceeding is early, voluntary, and consistent with the Board’s practices.

The Parties further confirm that, beyond their joint agreement to file this motion and forego appeal of the district court’s dismissal of claims asserting infringement of the ’998 patent, there are no other agreements between the Parties, written or oral, between the Parties made in connection with, or in contemplation of, the dismissal of the Petition and termination of this proceeding. Specifically, there is no settlement agreement or collateral agreement between the Parties with respect to the ’998 patent.

The Board should dismiss the Petition and terminate this IPR proceeding. Termination would save the Board and the Parties the time and resources when there is no longer a dispute between the Parties with respect to the ’998 patent.

III. Conclusion

The Board should order the dismissal of the Petition and terminate IPR2025-01467.

Respectfully submitted,

Date: 1/29/2026

/Scott Jarratt/

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/Rex Hwang/

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PETITIONER’S EXHIBIT LIST

Ex.1001	U.S. Patent No. 11,188,998
Ex.1002	Prosecution History of U.S. Patent No. 11,188,998
Ex.1003	Declaration of Dr. Nathaniel Polish under 37 C.F.R. § 1.68
Ex.1004	<i>Curriculum Vitae</i> of Dr. Nathaniel Polish
Ex.1005	U.S. Patent Publication No. 2003/0120940 to Vataja (“Vataja”)
Ex.1006	U.S. Patent No. 7,216,232 to Cox et al. (“Cox”)
Ex.1007	U.S. Patent No. 6,961,441 to Hershey (“Hershey”)
Ex.1008	RFC 2459
Ex.1009	RFC 2437
Ex.1010	Complaint, <i>MyPort Technologies, Inc. v. Apple, Inc.</i> 1-24-cv-01337 (DDE), Dec. 6, 2024
Ex.1011 (New)	Motion to Dismiss, <i>MyPort Technologies, Inc. v. Apple, Inc.</i> 1-24-cv-01337 (DDE), Mar. 21, 2025
Ex.1012 (New)	Brief ISO Motion to Dismiss, <i>MyPort Technologies, Inc. v. Apple, Inc.</i> 1-24-cv-01337 (DDE), Mar. 21, 2025
Ex.1013 (New)	Order Granting Motion to Dismiss, <i>MyPort Technologies, Inc. v. Apple, Inc.</i> 1-24-cv-01337 (DDE), Sept. 23, 2025
Ex.1014 (New)	Order Dismissing with Prejudice, <i>MyPort Technologies, Inc. v. Apple, Inc.</i> 1-24-cv-01337 (DDE), Dec. 18, 2025
Ex.1015 (New)	Notice of Appeal, <i>MyPort Technologies, Inc. v. Apple, Inc.</i> 1-24-cv-01337 (DDE), Jan. 16, 2025

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 January 29, 2026

Manner of service Electronic Service:
MyPort_IPR_SDTeam@skiermontderby.com

Documents served ***Joint Motion to Dismiss Petition and Terminate IPR Proceeding; Exhibits 1011-1015***

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