

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM, INC.
Petitioner

v.

APPLE INC.
Patent Owner

Case IPR2019-00322
Patent 8,443,216

JOINT MOTION TO DISMISS PROCEEDING

The Patent Owner Apple Inc. (“Apple”) and Petitioner Qualcomm, Inc. (“Qualcomm”) (collectively “Parties”) hereby jointly move for an order dismissing the inter partes review, pursuant to the terms of their Settlement Agreement, dated April 16, 2019. The Board provided written authorization by email to file this motion to dismiss on April 29, 2019.

The IPR Proceeding relates to a petition for *inter partes* review filed November 12, 2018, directed to Patent No. 8,443,216 (the “216 patent”), and assigned case number IPR2019-00322. Patent Owner filed a Preliminary Response on April 10, 2019. (Paper No. 6.) The Office has not reached a decision on instituting this petition.

The Parties have settled their dispute, and have reached agreement to dismiss this IPR Proceeding. The Parties’ Settlement Agreement has been made in writing, and a true copy of the same is attached as Exhibit 1019.

In addition, the Parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

1. Reasons Why Dismissal Is Appropriate

Dismissal is proper because the Parties are jointly requesting dismissal, the review is still in its early stages, and the Office has not yet “decided the merits of

the proceeding before the request for termination is filed.” As noted in the Patent Office Trial Practice Guidelines, “there are strong public policy reasons to favor settlement between the parties to a proceeding 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.”¹ Accordingly, dismissal is appropriate here.

The Parties understand that if the Board dismisses this *inter partes* review with respect to Petitioner, no estoppel under section 315(e) will attach to Petitioner on the basis of this *inter partes* review. The Parties also understand that if the Board dismisses this *inter partes* review with respect to Petitioner before a final written decision on patentability, no estoppel will attach to Petitioner under 37 C.F.R. § 42.73(d)(1). The Parties understand that if the Board dismisses this *inter partes* review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

As authorized by email on April 29, 2019, a true copy of the Settlement Agreement made in connection with, or in contemplation of, the dismissal of this *inter partes* review is being contemporaneously filed herewith as Exhibit 1019. A

¹ See Federal Register Vol. 77, No. 157 at 48768.

joint request to treat this agreement as business confidential information and to keep it separate from the files of the '216 patent is being filed concurrently.

2. Parties In Related Litigation Involving the Patent At-Issue

The '216 patent is asserted in Qualcomm, Inc. v. Apple Inc. 3:17-cv-01375-DMS-MDD (“the 1375 Litigation”). The Parties to this proceeding are also the only parties to the 1375 Litigation.

3. Related Proceedings Currently Before the Office

The Parties are unaware of any other proceedings involving the '216 patent that are currently before the Office.

There are a number of proceedings involving the Parties and other patents asserted in the 1375 Litigation, as listed in Table 1 below. The Parties have or will also be jointly moving to dismiss the additional proceedings listed in Table 1.

TABLE 1

Patent	IPR No(s).
8,098,534	IPR2019-00270
7,760,559	IPR2019-00274
7,355,905	IPR2019-00276
7,383,453	IPR2019-00296
8,433,940	IPR2019-00297
8,271,812	IPR2019-00321
8,656,196	IPR2019-00325

There are also a number of proceedings before the Office involving other patents at issue in the 1375 Litigation, but for which Intel Corporation is the

Petitioner, as listed in Table 2. The settlement between Qualcomm and Apple does not resolve the proceedings listed in Table 2.

TABLE 2

Patent	IPR No(s).
9,535,490	IPR2018-01344
9,535,490	IPR2018-01346
9,535,490	IPR2018-01261
9,535,490	IPR2018-01293
9,535,490	IPR2018-01295
9,608,675	IPR2018-01326
9,608,675	IPR2018-01327
9,608,675	IPR2018-01328
9,608,675	IPR2018-01329
9,608,675	IPR2018-01330
9,608,675	IPR2018-01340
8,838,949	IPR2018-01334
8,698,558	IPR2018-01152
8,698,558	IPR2018-01153
8,698,558	IPR2018-01154
8,698,558	IPR2018-01240

4. Status of Related District Court Litigation

The '216 patent was at issue in the 1375 Litigation. On April 23, 2019, the District Court dismissed the Parties respective claims and counterclaims with prejudice in the related 1375 Litigation. There are no other pending litigations or any other proceedings between the Petitioner and Patent Owner relating to the '216 patent.

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