

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SPEAKWARE, INC.,
Patent Owner.

Case No. IPR2019-00874
Patent 6,397,186

**AMENDED JOINT MOTION TO DISMISS AND TERMINATE
PROCEEDINGS**

INTRODUCTION

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, the authorization provided by the Board in an email dated July 18, 2019, and the additional guidance provided by the Board Petitioner Apple, Inc. and Patent Owner SpeakWare, Inc. file this amended joint motion and jointly request dismissal and termination of this proceeding.

Petitioner and Patent Owner have settled their dispute regarding the '186 Patent, including both this proceeding and Patent Owner's assertion of the '186 Patent in the related district court litigation, *SpeakWare, Inc. v. Microsoft Corp., et al.*, No. 8-18-cv-01293). A true and correct copy of the Parties' agreement has been filed as Exhibit 2001, along with a joint motion to treat the agreement as business confidential information and be kept separate from the files of this proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Petitioner and Patent Owner certify that there are no collateral agreements or understandings between the parties and made in connection with, or in contemplation of, the termination of this proceeding.

STATUS OF RELATED PROCEEDINGS

In addition to this proceeding, there are several IPR proceedings involving the '186 Patent. There was also a recently concluded district court proceeding involving the '186 Patent. The status of these proceedings is indicated here:

1. *SpeakWare, Inc. v. Microsoft Corporation, et al.*, Case No. 8:18-cv-01293 (C.D. Cal): In this consolidated district court action, SpeakWare asserted the '186 patent against Apple Inc., Microsoft Corp., Samsung Electronics Co., LTD, Samsung Electronics America, Inc., Amazon.com, Inc., and Google LLC. SpeakWare has settled its claim against each of these Defendants. And each of SpeakWare's claims has been dismissed with prejudice.

2. *Apple, Inc. v. SpeakWare, Inc.*, IPR2019-00875: As stated above, SpeakWare has settled its dispute with Apple. A joint motion to terminate IPR2019-00875 has already been filed, and an amended joint motion is being filed on the same day as this joint motion to terminate.

3. *Microsoft Corp. v. SpeakWare, Inc.*, IPR2019-00758 and IPR2019-00792: As stated above, SpeakWare has settled its dispute with Microsoft. Upon authorization from the Board, the parties will be filing joint motions to terminate these proceedings.

4. *Samsung Electronics Co., LTD, Samsung Electronics America, Inc. v. SpeakWare, Inc.*, IPR2019-01146 and IPR2019-01147: As stated above, SpeakWare has settled its dispute with the Samsung entities. The parties have filed joint motions to terminate these proceedings.

5. Amazon.com, Inc. v. SpeakWare, Inc., IPR2019-00999: As stated above, SpeakWare has settled its dispute with Amazon. The parties have filed a joint motion to terminate this proceeding.

6. Google LLC v. SpeakWare, Inc., IPR2019-00340 and IPR2019-00342: As stated above, SpeakWare has settled its dispute with Google. The parties have filed joint motions to terminate these proceedings.

7. Unified Patents Inc. v. SpeakWare, Inc., IPR2019-00495: Unified Patents Inc. filed its petition on December 27, 2018. The Board entered a Decision instituting *Inter Partes* Review on July 1, 2019. Oral Argument is scheduled for April 1, 2020.

RELIEF REQUESTED

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety. Termination is appropriate at this stage in view of the agreement (Ex. 2001) between the parties. The agreement (Ex. 2001) ends all disputes between the parties, including this proceeding.

Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575,

1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The U.S. Court of Appeals for the Federal Circuit also places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Moreover, the Board generally expects that a proceeding “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012); *see* 37 C.F.R. § 42.72.

Maintaining this proceeding after Petitioner’s settlement with Patent Owner would discourage future settlements by removing a primary motivation for settlement: eliminating litigation risk by resolving the parties’ disputes and ending the pending proceedings between them. For patent owners, litigation risks include the potential for an invalidity ruling against their patents. If a patent owner knows that an *inter partes* review or covered business method review will likely continue regardless of settlement, it creates a strong disincentive for the patent owner to settle.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety.

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