

Filed: June 9, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

Case No. IPR2020-00209
U.S. Patent No. 10,213,113

AMENDED JOINT MOTION TO TERMINATE

TABLE OF AUTHORITIES

Cases **Page(s)**

Bergh v. Dept. of Transp.,
794 F.2d 1575 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 950 (1986)2

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37 C.F.R. § 42.20(b)1

37 C.F.R. § 42.741

77 Fed. Reg. 48,680, 48,686 (Aug. 14, 2012)1, 2, 3

In response to the Board's Order (Paper No. 11), and pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Apple Inc. ("Petitioner") and Patent Owner Omni MedSci, Inc. ("Patent Owner") jointly request termination of this *inter partes* review (IPR) of 10,213,113 ("113 patent"), Case No. IPR2020-00209, and termination of the proceeding with respect to Petitioner. The parties note that the Decision on Institution is pending.

The Board's Order denied the parties' previous joint motion to terminate (Paper No. 9) and authorized the parties to file this amended motion on June 5, 2020. The parties have reached a settlement agreement regarding the '113 patent and have agreed to terminate this IPR2020-00209, filed by Apple. Ex. 1067. The parties certify that this settlement agreement (Ex. 1067) represents the complete agreement, including all terms and conditions, between the parties and includes all (and there are no other) collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding as required by 35 U.S.C. § 317(b). No other IPRs are known to be pending against the '113 patent.

Termination of this proceeding is proper for at least the following reasons:

- In the district court litigation, *Omni MedSci, Inc. v. Apple Inc.*, No. 19-cv-5673-YGR (N.D. Cal.) (pending), the Court has dismissed the

parties respective claims and counterclaims pertaining to the '113 patent. No other cases involve the '113 patent, and the parties do not contemplate any litigation or proceeding involving the subject patent in the foreseeable future.

- The parties are jointly requesting termination. 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“There are *strong public policy reasons to favor settlement* between the parties to a proceeding.”) (emphasis added). 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 [Fed. R. Civ. P.] 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 Federal Circuit 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). Here, no public interest or other factors weigh against termination of this proceeding.

- The Board has not yet “decided the merits of the proceeding *before the request for termination is filed.*” 35 U.S.C. § 317(a) (emphasis added); 77 Fed. Reg. 48,768 (“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.”). The Board has not yet made a decision on institution of this inter partes review. Apple Inc. filed its petition for *inter partes* review on December 11, 2019. No Motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this *inter partes* review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings. 77 Fed. Reg. 48,680, 48,686 (Aug. 14, 2012) (And 35 U.S.C. 317(a) provides “An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”)
- The District Court in *Omni MedSci, Inc. v. Apple Inc.*, No. 4:19-cv-05673-YGR (pending) granted the parties motion to dismiss the ’113

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