

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VMWARE, INC.,
Petitioner

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner

Case IPR2020-00470
Patent 7,949,752

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Joint Claim Construction Statement, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, April 17, 2020.
2002	Defendant's Preliminary Invalidation Contentions, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, January 15, 2020.
2003	Order Resetting Markman Hearing, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, April 16, 2020.
2004	Exhibit C-1: Invalidation Chart for U.S. Patent No. 7,949,752, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, filed July 31, 2019.
2005	Preliminary Claim Construction Rulings, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, May 14, 2020.
2006	Disputed Claim Terms, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, April 17, 2020
2007	Plaintiffs' Claim Construction Brief, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, March 6, 2020
2008	Defendant VMware, Inc.'s Opening Claim Construction Brief, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, March 6, 2020

Exhibit No.	Description
2009	Defendant VMware, Inc.'s Responsive Claim Construction Brief, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, March 27, 2020.
2010	Plaintiffs' Reply Claim Construction Brief, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, April 10, 2020.
2011	Defendant VMware Inc.'s Reply Claim Construction Brief, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, April 10, 2020.
2012	Plaintiffs' Supplemental Construction Brief, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, May 13, 2020.
2013	Defendant's Supplemental Claim Construction Statement, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, May 13, 2020.
2014	Intellectual Ventures' Technology Tutorial of the '752 patent, <i>Intellectual Ventures I, LLC et. al. v. VMware, Inc.</i> , No. 1:19-cv-01075, U.S. District Court for the Western District of Texas, April 24, 2020.
2015	Curriculum Vitae of Prashant Shenoy, PH.D.
2016	Declaration of Prashant Shenoy, PH.D. in Support of Patent Owner's Response
2017	Nieva, Richard, "At Premiere of General Magic Doc, Tech Icons Consider the Future," Cnet.com (July 27, 2018)
2018	U.S. Trademark Registration No. 4,425,780 (filed Dec. 15, 2007)

Exhibit No.	Description
2019	Remote Deposition Transcript of Darrell Long, Ph.d. (October 28, 2020)
2020	Milojčić et al., “Process Migration,” ACM Computing Surveys, Vol. 32, No. 3, 241-299 (September 2000)
2021	Settlement Agreement (CONFIDENTIAL)

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board email of January 21, 2021, Petitioner VMware Inc. (“Petitioner”) and Patent Owner Intellectual Ventures I LLC (“Patent Owner”) jointly request termination of this proceeding, IPR2020-00470, directed to U.S. Patent No. 7,949,752 (the “’752 Patent”).

I. CERTIFICATION

Petitioner and Patent Owner submit a true copy of any agreement or understanding (Exhibit 2021) between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of the proceeding under 37 CFR § 42.74(b) with this joint motion.

II. STATUS OF RELATED PROCEEDINGS

Petitioner and Patent Owner have resolved their disputes regarding the ’752 Patent, including this proceeding and Patent Owner’s assertion of the ’752 Patent in the related district court litigation, 1-19-cv-01075. The parties do not anticipate further litigation between them concerning the ’752 Patent.

III. RELIEF REQUESTED

As authorized by the Board, the parties are jointly and contemporaneously filing: (i) this joint motion to terminate the proceeding; (ii) a true copy of any agreement or understanding (Exhibit 2021) between Petitioner and Patent Owner made in connection with, or in contemplation of, the requested termination; and

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