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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

THX LTD.,

Plaintiff,

v.

APPLE INC.,

Defendant.

Civil Action No. 13-CV-01161-HSG

JOINT STATUS REPORT REGARDING *INTER PARTES* REVIEWS AND REQUEST TO LIFT STAY

Hon. Haywood S. Gilliam, Jr.

Pursuant to the Court's October 24, 2013 Order (Doc. 35), the parties hereby submit the following joint status report regarding the *Inter Partes* Review ("IPR petitions") filed by Defendant Apple Inc. ("Apple"). Additionally, since, as discussed below, the United States Patent and Trademark Office Patent Trial and Appeal Board ("PTAB") has issued a final written decision on the sole IPR petition on which trial was instituted, the parties hereby jointly request that the Court lift the stay in this case and permit the parties to submit a supplemental Joint Case Management Statement within fourteen days of the filing of this joint status report. Furthermore, the parties respectfully request that the Court set a date for a scheduling conference at the Court's earliest convenience.

A. Status of IPR Petitions

On December 6, 2013, Apple filed petitions for *Inter Partes* Review of claims 1-7 and 29-34 of U.S. Patent No. 8,457,340 ("the '340 Patent") and claims 1-6, 8, 10, 16 and 18-20 of U.S. Patent No. 7,433,483 ("the '483 Patent") (collectively, "the Patents-In-Suit"), which are asserted by Plaintiff THX Ltd. ("THX") in this action. Apple's petition with respect to the '340 Patent was assigned case no. IPR2014-00234 ("IPR-234") and Apple's petition with respect to the '483 Patent was assigned case no. IPR2014-00235 ("IPR-235").

On June 11, 2014, the PTAB issued decisions on whether it would institute *inter partes* review of the Patents-In-Suit. With respect to IPR-234, the PTAB declined to institute *inter partes* review of any claim of the '340 Patent. With respect to IPR-235, the PTAB instituted *inter partes* review of claims 1-3 of the '483 Patent but declined to institute *inter partes* review of the remaining challenged claims.

On June 9, 2015, the PTAB issued a Final Written Decision in IPR-235 determining that claims 1 and 2 of the '483 patent are unpatentable and that Apple did not show that claim 3 is unpatentable.

B. Request to Lift Stay

The Court's October 24, 2013 Order stayed this case "pending issuance of a final written decision by the United States Patent and Trademark Office on Apple's petitions for *inter partes review* of the Patents-in-Suit." (Doc. 35 at 1.) Since the PTAB did not institute trial on IPR-234

and has now issued a final written decision in IPR-235, the parties respectfully request that the Court lift the stay in this case. While Apple agrees that it is appropriate based on the October 24, 2013 Order to lift the stay at this time, Apple reserves the right to move for entry of a further stay based on subsequent events, including, for example, the filing of an appeal by either party of the PTAB's final written decision.[1] THX does not believe that a further stay would be appropriate and intends to oppose any request by Apple for a further stay.

Furthermore, the parties request that the Court allow the parties to submit a supplemental Joint Case Management Statement on July 2, 2015, which will include a proposed case schedule, and set a date for a scheduling conference at the Court's earliest convenience.

Dated: June 18, 2015

PERKINS COIE LLP

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[1] At this time, neither party has determined whether it will seek rehearing or appeal the PTAB's final written decision. The parties' time to appeal expires on August 11, 2015. *See* 35 U.S.C. § 141(c) (parties' deadline to file notice of appeal to the Federal Circuit is August 11, 2015); *see also* 37 C.F.R. § 42.71(d) (parties' deadline to file Request for Rehearing with the PTAB is July 9, 2015).

Pursuant to Civil Local Rule 5-1(i)(3), counsel for THX has obtained the concurrence of Apple's counsel in the filing of this Joint Status Report Regarding *Inter Partes* Reviews and Request to Lift Stay.

Dated: June 18, 2015

By: */s/ Eric L. Wesenberg*
Eric L. Wesenberg

CERTIFICATE OF SERVICE

I hereby certify that on June 18, 2015, I electronically transmitted the attached document to the Clerk's Office using the CM/ECF System for filing and transmittal of a Notice of Electronic Filing to the CM/EMF registrants for this case.

/s/ Eric L. Wesenberg
Eric L. Wesenberg