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14 *Attorneys for Plaintiff*

Attorneys for Defendant

17 **IN THE UNITED STATES DISTRICT COURT**
 18 **NORTHERN DISTRICT OF CALIFORNIA**
 19 **SAN FRANCISCO**

20 **UNWIRED PLANET LLC,**
 a Nevada limited liability company,
 21
 22 Plaintiff,

23 v.

24 **APPLE INC.,**
 a California corporation,
 25
 26 Defendant.

CIVIL ACTION NO.

3:13-CV-04134-VC

STIPULATION AND ~~PROPOSED~~
ORDER REGARDING JUDGMENT
OF NON-INFRINGEMENT OF THE
'491 PATENT

Judge: Hon. Vince Chhabria

1 WHEREAS, Plaintiff Unwired Planet LLC (“Unwired Planet”) and Defendant Apple Inc.
2 (“Apple”) (“the Parties”) stipulate and move for entry of judgment of non-infringement under
3 asserted Claims 15 and 26 of U.S. Patent No. 6,813,491 (“the ’491 Patent”) as to all accused
4 products under the Court’s Claim Construction Order (Dkt. No. 269) and Order Denying Motion
5 to Supplement Infringement Contentions (Dkt. No. 261); and
6

7 WHEREAS, entering judgment of non-infringement now will allow the parties to forego
8 further litigation in this Court on Claims 15 and 26 of the ’491 Patent, while preserving Unwired
9 Planet’s right to appeal the Court’s Claim Construction Order (Dkt. No. 269) and Order Denying
10 Motion to Supplement Infringement Contentions (Dkt. No. 261);

11 IT IS HEREBY STIPULATED AND AGREED by the Parties, subject to the approval of
12 the Court, as follows:

13 1. This is a patent infringement action brought by Unwired Planet against Apple.
14 Unwired Planet filed this patent litigation against Apple on September 19, 2012, in the District of
15 Nevada. *See* Dkt. No. 1. Currently, the patents-in-suit include United States Patents Nos.
16 6,647,260; 6,321,092; 6,317,831; 6,532,446; and 6,813,491 (collectively, the “Asserted
17 Patents”). Unwired Planet has dismissed without prejudice other patents previously asserted.
18 *See* Dkt. No. 259.
19

20 2. Unwired Planet has accused certain electronic devices, namely certain of
21 Defendant’s iOS products prior to the release of iOS8 of infringing the ’491 Patent as shown in
22 Dkt. No. 231-13, 231-15, and 231-17 (Unwired Planet’s First Amended Infringement
23 Contentions), incorporated by reference herein.
24

25 3. This case was transferred to the Northern District of California in August 2013.
26 Dkt. No. 151.
27
28

1 4. The parties disputed the construction of the term “determining whether the mobile
2 device is proximate to its owner” of Claim 15 of the ’491 Patent. Unwired Planet proposed the
3 following construction: “determining if the mobile device is close to the individual who owns or
4 is using the device.” Apple proposed the following construction: “determining if the mobile
5 device is, or is not, close to the individual who owns the device.”
6

7 5. The parties also disputed the construction of the terms “stationary / active
8 preferences” of Claim 26 of the ’491 Patent. Unwired Planet proposed the following
9 construction: “configuration of settings that may be set when the mobile device determines that it
10 has been / has not been stationary.” Apple proposed the following construction: “configuration of
11 user-selectable settings the user wants when the device is stationary / active.”
12

13 6. On July 17, 2014, Unwired Planet served its Second Supplemental Infringement
14 Contentions for the ’491 Patent as shown in Dkt. Nos. 231-9, 231-11, incorporated by reference
15 herein. Also on July 17, 2014, Unwired Planet agreed to Apple’s proposed construction of the
16 term “determining whether the mobile device is proximate to its owner” of Claim 15 of the ’491
17 Patent.
18

19 7. Apple objected to the service of Unwired Planet’s Second Supplemental
20 Infringement Contentions with respect to the ’491 Patent, including the addition of contentions
21 regarding the “Do Not Disturb” feature with respect to Claims 15 and 26 of the ’491 Patent, and
22 “Touch ID” with respect to Claim 15 of the ’491 Patent.
23

24 8. On August 29, 2014, Unwired Planet moved to amend its infringement
25 contentions for the ’491 Patent. *See* Dkt. Nos. 232 (Motion to Supplement Infringement
26 Contentions), 245-3 (Reply).
27

28 9. On September 15, 2014, Apple opposed Unwired Planet’s Motion with respect to
the ’491 Patent. *See* Dkt. No. 242.

1 10. On October 23, 2014, the Court denied Plaintiff’s Motion to Supplement
2 Infringement Contentions. Dkt. No. 261.

3 11. On November 3, 2014, the Court issued a Claim Construction Order construing
4 the disputed claim terms of the Asserted Patents. Dkt. No. 269. The Court accepted the parties’
5 agreed-upon construction of the term “determining whether the device is proximate to its owner”
6 of Claim 15 of the ’491 Patent: “determining if the mobile device is, or is not, close to the
7 individual who owns the device.” *Id.* at 1. The Court adopted the following construction of
8 “stationary / active preferences” term of Claim 26: “configuration of user-selectable settings the
9 user wants when the device determines that it is / is not stationary.” *Id.* at 28.
10

11 12. The Parties now stipulate that, given the Court’s construction of the term
12 “stationary / active preferences” as set forth in the Court’s Claim Construction Order (Dkt. No.
13 269), and the Court’s denial of Unwired Planet’s Motion to Supplement its Infringement
14 Contentions (*see* Dkt. Nos. 232, 261), Unwired Planet cannot prove infringement of Claim 26 of
15 the ’491 Patent for the accused products.
16

17 13. The Parties further stipulate that, given Parties’ agreed-upon construction of
18 “determining whether the mobile device is proximate to its owner”, and the Court’s denial of
19 Unwired Planet’s Motion to Supplement Infringement Contentions (*see* Dkt. Nos. 232, 261),
20 Unwired Planet cannot prove infringement of Claim 15 of the ’491 Patent for the accused
21 products.
22

23 14. The Parties respectfully request that the Court enter judgment of non-infringement
24 as to the ’491 Patent to conserve judicial resources and to avoid the time and expense of further
25 discovery and motion practice related to the ’491 Patent. Upon entry of such judgment and upon
26 entry of final judgment in this case resolving the remaining Asserted Patents, Unwired Planet
27 intends to file a notice of appeal as to the Court’s Claim Construction Order (Dkt. No. 269) and
28

1 Order Denying Motion to Supplement Infringement Contentions (Dkt. No. 261). In the event that
2 the Federal Circuit dismisses Unwired Planet's appeal as premature, Unwired Planet reserves the
3 right (which Defendant does not contest) to undertake further proceedings in this Court on
4 remand to complete the record for appeal.

5 15. The Parties further stipulate and agree that Defendant's unadjudicated affirmative
6 defenses and counterclaims as to the '491 Patent are dismissed without prejudice to being
7 reasserted in the event of remand or other assertions by Unwired Planet of the '491 Patent.
8

9 **IT IS SO AGREED AND STIPULATED this 19th day of January, 2015:**

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23
24 **IT IS SO ORDERED.**

25
26 
27 UNITED STATES DISTRICT JUDGE

28 DATED: January 20, 2015