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Paper 10
Date: February 8, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMOTOMO INC. AND COMOTOMO CORPORATION,
Petitioner,

v.

MAYBORN (UK) LIMITED,
Patent Owner.

IPR2022-01325
Patent 10,952,930 B2

Before ULRIKE W. JENKS, MICHAEL L. WOODS, and CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

TERMINATION
Dismissal After Institution of Trial
37 C.F.R. § 42.72

I. INTRODUCTION

On February 3, 2023, and with the Board's authorization, Petitioner and Patent Owner (collectively, "the Parties") filed a Joint Motion to Terminate Proceedings Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72. Paper 9 ("Motion" or "Mot.").

II. DISCUSSION

The Parties acknowledge that the Related Litigation[1] remains pending and that there are "no settlement agreement[s] or other agreements made in connection with, or in contemplation of, the termination of this *inter partes* proceeding." *See* Mot. 3–4. The Parties request that the Board terminate this proceeding under 35 U.S.C. § 317(a). *Id.* at 2.

The relevant statute provides that

> *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*. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that inter partes review. If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

35 U.S.C. § 317(a) (emphasis added).

Here, we recently instituted *inter partes* review on January 24, 2023, and have not decided the merits of this proceeding. Paper 7. The

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[1] *Mayborn (UK) Limited, et al. v. Comotomo Inc., et al.*, Case No. 1:22-cv-00694 (S.D.N.Y.) and *Nanobebe US Inc. v. Mayborn (UK) Limited et al.*, Case No. 1:21-cv-08444 (S.D.N.Y.) (collectively, the "Related Litigation").

requirements for termination are met here. *See* 37 U.S.C. § 317(a) ("inter partes review instituted . . . shall be terminated . . . upon the joint request . . . unless the Office has decided the merits of the proceeding"); *see also* 37 C.F.R. § 42.72 ("The Board may terminate a trial without rendering a final written decision . . . pursuant to a joint request under 35 U.S.C. 317(a)").

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a). 35 U.S.C. § 317(a); *see also* 37 C.F.R. § 42.72.

III. ORDER

Accordingly, it is

ORDERED that the Motion is granted and

FURTHER ORDERED that IPR2022-01325 is terminated pursuant to 37 C.F.R. § 42.72.

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