UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEL BLASTER, INC.,
Petitioner

v.

SPIN MASTER, INC.,
Patent Owner

Case IPR2023-00301
Patent No. 8,371,282

JOINT MOTION TO TERMINATE PROCEEDING

EXHIBITS

Exhibit #	Reference Name
1001	U.S. Patent No. 8,371,282
1002	File History of U.S. Patent No. 8,371,282
1003	Declaration of Guerry Grune, Ph.D.
1004	Curriculum Vitae of Guerry Grune, Ph.D.
1005	This exhibit intentionally left blank.
1006	U.S. Patent No. 5,241,944 ("Rappaport")
1007	Declaration from archive.org and webpage describing DuneCraft Spit Balls, archived at archive.org, from https://web.archive.org/web/20091127080602/http://www.thinkgeek.com/geektoys/science/cd32/
1008	This exhibit intentionally left blank.
1009	Declaration from archive.org and webpage showing the packaging of the DuneCraft SpitBalls, archived at archive.org, from https://web.archive.org/web/20091128071922/http://www.thinkgeek.com/geektoys/science/cd32/zoom/
1010	This exhibit intentionally left blank.
1011	U.S. Patent Application No. 2006/0180134A1 ("Illuzzi")
1012	KR20100004855U ("Kim application")
1013	Certified translation of KR20100004855U ("Kim application")
1014	Declaration from archive.org and webpage describing "Things To Shoot" ("Cake") archived at archive.org, from https://web.archive.org/web/20090206231446/https://www.aaroncake.net/spuds/things.asp
1015	This exhibit intentionally left blank.
1016	U.S. Patent No. 8,584,589 ("Carlson")
1017	ITC Complaint (public version)

1018	Certificate of Service
1019	Complainants' Notice Of Patent Priority Dates And Dates Of Conception in Inv. No. 337-TA-1325
1020	Joint Claim Construction Chart in Inv. No. 337-TA-1325
1021	Hasbro's Answer, Affirmative Defenses, and Counterclaims in Civil Action No. 1:22-cv-00828-LY (W.D. Texas)
1022	https://www.cpsc.gov/Recalls/2012/dunecraft-recalls-water-balz-skulls-orbs-and-flower-toys-due-to-serious-ingestion
1023	Confidential Settlement Agreement

Petitioner and Patent Owner, by and through its exclusive licensee Hasbro Inc., (collectively, "the Parties") have reached a settlement. Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the Parties move to terminate the present *inter partes* review proceeding regarding U.S. Patent No. 8,371,282 ("the '282 Patent").

I. STATEMENT OF THE FACTS

On July 20, 2022, Patent Owner submitted a request to the United States International Trade Commission for an investigation pursuant to Section 337 of the Tariff Act of 1930 (Inv. No. 337-TA-1325) based on two related patents—the '282 Patent and U.S. Patent No. 8,640,683 ("the '683 Patent").

On August 12, 2022, Petitioner brought suit against Patent Owner in the United States District Court for the Western District of Texas (Civil Action No. 1:22-cv-00828). Patent Owner raised counterclaims against Petitioner based on the '282 and '683 Patents on October 11, 2022.

Petitioner filed Petitions for *inter partes* review of the '282 and '683 Patents on December 5, 2022 in this proceeding, Case No. IPR2023-00301, and Case No. IPR2023-00302, respectively. Patent Owner filed its Preliminary Responses on March 23, 2023. The Board's Institution Decisions are due by June 23, 2023.

The Parties have now reached an agreement (the "Settlement Agreement") to resolve their disputes. The Settlement Agreement has been made in writing, and a true and correct copy of the same is filed herewith as Confidential Exhibit 1023. The

Parties desire the Settlement Agreement to be maintained as business confidential under 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

On May 15, 2023, the Parties requested permission to file this Joint Motion to Terminate Proceeding. On May 17, 2023, the Board authorized the Parties, via email, to file the motion.

II. RELIEF REQUESTED

Under 35 U.S.C. § 317(a), "[a]n *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."

Termination of this *inter partes* review is appropriate because the Board has not yet "decided the merits of the proceeding." *See*, *e.g.*, PTAB Consolidated Trial Practice Guide (Nov. 2019), p. 86. Indeed, the Board's Institution Decision is still more than a month away, and any Final Written Decision is more than a year out. A decision on the merits in this case is far more remote than in other cases where the Board has granted joint termination motions. *See*, *e.g.*, *AM General LLC v. Uusi, LLC*, IPR2016-01050, Paper 44 (Nov. 7, 2017) (terminating an instituted IPR after the oral hearing); *Lam Research Corp. v. Daniel L. Flamm*, IPR2015-01764, IPR2015-01767, IPR2015-01768, Paper 27 (Dec. 15, 2016) (same); *Hydrite*

Chemical Co. v. Solenis Technologies, L.P., IPR2015-01586, Paper 38, IPR2015-01592, Paper 39 (Nov. 25, 2016) (same); *Clio USA, Inc. v. The Procter & Gamble Company*, IPR2013-00438, Paper 57 (Oct. 31, 2014) (same).

Consistent with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' Settlement Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 1023. There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.

In addition to satisfying the statutory and regulatory requirements, termination is also appropriate because it would preserve significant resources for the Parties and the Board.

III. CONCLUSION

The Parties have settled all disputes relating to the challenged patent. This proceeding is at an early stage, and the Board has not entered an institution decision or a final written decision on the merits. Accordingly, the Parties respectfully request that the Board terminate this proceeding.

Respectfully submitted,

Dated: May 19, 2023

/Douglas Lewis/
Douglas Lewis
Counsel for Petitioner
Reg. No. 39,748

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e)(1), the parties have agreed to accept service by electronic means. I hereby certify that on May 19, 2023, I caused a copy of the foregoing document, as well as Exhibit 1023, to be served via electronic mail to the following addresses:

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