

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner

v.

EQUIL IP HOLDINGS LLC,
Patent Owner

Case IPR2023-00330
U.S. Patent No. 8,495,242

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Dr. Mark T. Jones in Support of Patent Owner's Preliminary Response
2002	Curriculum Vitae of Dr. Mark T. Jones
2003	Petition Under 37 C.F.R. § 1.324(a) to Correct Inventorship in a Patent
2004	<i>Intentionally Left Blank</i>
2005	U.S. Patent No. 8,656,046 to Barger et al.
2006	U.S. Patent No. 6,964,009 to Samaniego et al.
2007	WO 98/43177 (International Publication of PCT/US98/05304) to Tso et al.
2008	Redline comparison of specifications of PCT/US98/05304 (Tso PCT) and U.S. Patent No. 6,421,733 (Tso)
2009	U.S. Patent No. 5,902,846 to Feret et al.
2010	First Amended Complaint for Patent Infringement, 22-677-RGA, <i>Equil IP Holdings LLC v. Akamai Technologies, Inc.</i>
2011	U.S. Patent No. 6,483,851 to Neogi
2012	Decision Granting Petition to Correct Inventorship Under § 1.324 for U.S. Patent No. 6,964,009
2013	Decision on Certificate of Correction for U.S. Patent No 6,964,009
2014	Certificate of Correction for U.S. Patent No 6,964,009
2015	Settlement Agreement (CONFIDENTIAL)

I. STATEMENT OF RELIEF REQUESTED

Akamai Technologies, Inc. (“Petitioner”), and Equil IP Holdings LLC (“Patent Owner”) (collectively, “the Parties”) have entered into a confidential settlement agreement that resolves all underlying disputes between Petitioner and Patent Owner with respect to U.S. Patent No. 8,495,242 (“the ’242 patent”). A copy of the Parties’ settlement agreement is being filed with this motion as Exhibit 2015 (the “Agreement”). The Parties are concurrently filing a separate request that the Agreement be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Accordingly, pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board on October 24, 2023, the Parties jointly request termination of this *inter partes* review proceeding in its entirety.

II. STATEMENT OF FACTS

The Parties entered into a confidential Agreement. *See* EX2015 (Confidential). Pursuant to the terms of the Agreement, the Parties agreed to jointly seek termination of this proceeding.

III. ARGUMENT

A. Termination is appropriate.

IPR proceedings “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.” 35 U.S.C. §317(a); *see also id.* (“If no petitioner remains in the inter partes review, the Office may terminate the review...”). Petitioner and Patent Owner have settled their dispute regarding the ’242 patent, including both this proceeding and Patent Owner’s assertion of the ’242 patent in the related district court litigation, *Equil IP Holdings LLC v. Akamai Technologies, Inc.*, Case No. 1:22-cv-00677 (D. Del.). The Parties do not anticipate further litigation between them concerning the ’242 patent.¹ The Parties are therefore jointly requesting termination of this proceeding. And the Office has not decided the merits of this IPR. Termination of this IPR is therefore appropriate. *See* 35 U.S.C. §317(a).

Good cause exists to terminate this proceeding because the Parties have settled their dispute regarding the ’242 patent. The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” PTAB November 2019 Consolidated Trial Practice Guide, at 86. Further, the proceeding is at an early stage. Patent Owner has not yet filed its Patent Owner Response, and the Office has not decided the merits of the

¹ Also currently before the Board is an instituted *inter partes* review of U.S. Patent No. 6,792,575 (Case No. IPR2023-00329). The Parties are concurrently filing a motion to terminate that proceeding pursuant to this settlement agreement.

proceeding. Terminating the proceeding now would serve the interests of judicial economy as well as the mutual interest of the Parties.

B. Written Agreement

The Parties represent that their entire agreement in connection with the termination of this proceeding is embodied in the Agreement, which has been made in writing. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review.

Pursuant to 35 U.S.C. §317(b), a true and correct copy of the Agreement is filed herewith as Exhibit 2015. The Agreement has been filed for access by the “Parties and Board Only” due to the highly sensitive business confidential information it contains. The Parties desire that the Agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request to treat the settlement agreement as business confidential information is being filed concurrently.

IV. CONCLUSION

Petitioner and Patent Owner respectfully request that the Board grant the Parties' Joint Motion to Terminate this proceeding in its entirety.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

Richard M. Bemben
Registration No. 68,658
Counsel for Patent Owner

Date: October 26, 2023

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

ROPES & GRAY LLP

/s/ James L. Davis, Jr.

James L. Davis, Jr.
Registration No. 57,325
Counsel for Petitioner

Date: October 25, 2023

1900 University Avenue, 6th Floor
East Palo Alto, CA 94303-2284
(650) 617-4794

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned certifies that true and correct copies of the foregoing
JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW and
EXHIBIT 2015 (CONFIDENTIAL) were served in their entireties electronically
via e-mail on October 26, 2023, on the following counsel for Petitioner:

James L. Davis (Lead Counsel)
Daniel W. Richards (Back-Up Counsel)
ROPES & GRAY LLP
james.l.davis@ropesgray.com
daniel.richards@ropesgray.com
akamai-equil-ropes-ipr-service@ropesgray.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Richard M. Bemben/

Richard M. Bemben
Registration No. 68,658
Counsel for Patent Owner

Date: October 26, 2023

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600