

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SKYWALKER HOLDINGS, LLC
Petitioner,

v.

BOARD & BATTEN INTERNATIONAL INC.
Patent Owner

Case IPR2023-00350

Patent No. 7,854,687

PETITIONER AND PATENT OWNER'S JOINT MOTION
TO TERMINATE *INTER PARTES* REVIEW PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317(A)

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner Skywalker Holdings, LLC (“Petitioner”) and Board & Batten International Inc. (“Patent Owner”) (collectively, “the Parties”) hereby provide notice that they have reached a settlement agreement and jointly request termination of this *inter partes* review, Case No. IPR2023-00350, challenging U.S. Patent No. 7,854,687 (“the ’687 patent”).

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the Parties relating to the ’687 patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review 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 proceedings before the request for termination is filed. 35 U.S.C. § 317(a).

The Board instituted trial on July 18, 2023. On October 4, 2023, the Parties stipulated to a 30-day extension to the due date for the Patent Owner’s response to the petition to allow the Parties to engage in settlement discussions. The extended due date for the Patent Owner’s response is November 9, 2023. The proceedings are therefore in their preliminary stage, and the Board has not decided the merits of the proceedings.

As required by the settlement agreement, the Parties have filed a notice of stipulated dismissal in the corresponding litigation matter between the Parties, Civil Case No. 2:23-cv-00297-DAK-CMR. As a result, this matter was terminated on October 31, 2023. The Parties also represent that they have agreed to settle and dismiss all other litigation between them, that no other district court litigation related to the ’687 patent is currently pending and that there are no related proceedings in the U.S. Patent and Trademark Office. Further, the Parties represent that no

litigation or proceeding involving the '687 patent is contemplated in the foreseeable future. By granting the present motion, the Board and the Parties can conserve resources.

II. Agreement in Writing Submitted to the Board

As required by statute, the Parties are filing concurrently herewith, as a separate submission, a Joint Request to File Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b), along with a true and correct copy of the written settlement agreement in connection with this matter. The Parties request that the settlement agreement be treated as business confidential information and be kept separate from the files of the '687 patent pursuant to 37 C.F.R. 42.74(c). The Parties certify that there are no other agreements or understandings between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of the instant *inter partes* review.

III. Conclusion

For the reasons stated above, the Parties respectfully request that the Board terminate IPR2023-00350. Because the Parties jointly request termination as to Petitioner, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

DATED: November 6, 2023

Respectfully submitted,

/s/ Brian D. Tucker
Brian D. Tucker
Registration No. 61,550
Lead Counsel for Petitioner

/s/ Kelly J. Kubasta
Kelly J. Kubasta
Registration No. 44,196
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on the 6th day of November, 2023, a copy of the foregoing document was served to the email addresses provided by Patent Owner pursuant to 37 C.F.R. §§ 42.6(e) and 42.8:

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/Brian D. Tucker/