

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC. and AMAZON.COM SERVICES LLC,
Petitioners,

v.

COUNTERFLO AB,
Patent Owner.

IPR2023-00362
U.S. Patent No. 8,791,829

JOINT MOTION TO TERMINATE PROCEEDING

EXHIBIT LIST

LIST OF NEWLY FILED EXHIBITS

The following exhibit is being filed with this Joint Motion To Terminate Proceeding and concurrent Joint Request To Treat The Parties' Settlement Agreement As Business Confidential Information:

No.	Description
1028	Confidential Settlement Agreement

LIST OF PREVIOUSLY FILED EXHIBITS

EX No.	Description
1001	U.S. Patent No. 8,791,829 (“ the ’829 patent ”)
1002	Excerpts from the Prosecution File History of U.S. Patent No. 8,791,829 (“ the ’829 file history ”)
1003	Declaration of Gary L. Woods (“ Woods ”)
1004	Curriculum Vitae of Gary L. Woods
1005	International Publication No. WO 2005/052443 to Jablonski (“ Jablonski ”)
1006	International Application No. PCT/AU2004/001664 (“ Jablonski application ”)
1007	U.S. Patent No. 7,324,006 to Godard (“ Godard ”)
1008	U.S. Patent Application No. 10/960,844 (“ Godard application ”)
1009	U.S. Patent Application Publication No. 2005/0146827 to Borden et. al. (“ Borden ”)
1010	U.S. Patent Application No. 10/752,854 (“ Borden application ”)

EX No.	Description
1011	U.S. Patent No. 7,233,086 to Borden et. al.
1012	U.S. Patent Application Publication No. 2005/0124209 to Currie et. al. (“ Currie ”)
1013	U.S. Patent Application No. 10/948,186
1014	U.S. Patent No. 7,019,658 to Erickson et. al. (“ Erickson ”)
1015	U.S. Patent Application No. 10/677,994 (“ Erickson application ”)
1016	Excerpts from Rudolf F. Graf, <i>Modern Dictionary of Electronics</i> , Newnes (7th ed. 1999) (“ Graf ”)
1017	Excerpts from McGraw-Hill Dictionary of Electrical and Computer Engineering, McGraw-Hill (2004) (“ Dictionary of Electrical and Computer Engineering ”)
1018	Excerpts from Julie K. Peterson, <i>Fiber Optic Illustrated Dictionary</i> , CRC Press (2003) (“ Peterson ”)
1019	Excerpts from Jacob Fraden, <i>Handbook of Modern Sensors</i> , Springer (3rd ed. 2004) (“ Fraden ”)
1020	Excerpts from David R. Goff, <i>Fiber Optic Reference Guide</i> , Focal Press (3rd ed. 2002) (“ Goff ”)
1021	Excerpts from Stephen H. Lampen, <i>Wire, Cable, and Fiber Optics for Video & Audio Engineers</i> , McGraw-Hill (1998) (“ Lampen ”)
1022	Excerpts from R.M. Marston, <i>Optoelectronics Circuits Manual</i> , Newnes (2nd ed. 1999) (“ Marston ”)
1023	Excerpts from R.S. Popovic, <i>Hall Effect Devices</i> , Adam Hilger (1991) (“ Popovic ”)
1024	Excerpts from <i>Electrical, Measurement, Signal Processing, and Displays</i> , edited by John G. Webster, CRC Press (2004) (“ Webster ”)
1025	Excerpts from Time Magazine’s “50 Best Inventions of 2010”

EX No.	Description
1026	Allegro Microsystems ACS750xCA-050 Datasheet
1027	Triad Magnetics UL1560 Datasheet

I. STATEMENT OF RELIEF REQUESTED

Petitioners Amazon.com, Inc. and Amazon.com Services LLC (“Petitioner”) and Patent Owner Counterflo AB (“Patent Owner”) (collectively, the “Parties”) have reached a settlement. Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and authorization provided by the Board on March 29, 2023, the Parties jointly move for termination of this *inter partes* review proceeding (IPR2023-00362) (the “Proceeding”), without prejudice to either Party. The Parties are concurrently filing a true copy of the Parties’ settlement agreement (Confidential Exhibit 1028) along with a request that it be kept separate and treated as “business confidential information” pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Prior to filing this motion, undersigned counsel for Petitioner obtained permission from undersigned counsel for Patent Owner to add his signature and file this motion and request jointly on behalf of the Parties.

II. JOINT MOTION FOR TERMINATION

Petitioner filed its petition for *inter partes* review on December 22, 2022 (Paper 2), and a Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3) was issued on January 10, 2022. Patent Owner has not yet filed a preliminary response and the Board has not yet issued a decision on institution. On March 1, 2023, the parties entered into a

settlement agreement to resolve their disputes regarding U.S. Patent No. 8,791,829, including an agreement to terminate this *inter partes* review. *See* Confidential Exhibit 1028. On March 2, 2023, the Parties filed a joint motion to dismiss Patent Owner's patent infringement lawsuit against Petitioner, with Patent Owner's claims dismissed with prejudice and Petitioner's defenses dismissed without prejudice. An amended order to this effect was issued on March 7, 2023. Order, 2:22-cv-00050-JRG-RSP, ECF No. 63. Also on March 7, 2023, the Parties' contacted the Board by email seeking permission to file this motion and a corresponding request to treat Confidential Exhibit 1028 as business confidential information. The Board authorized these filings in a responsive email on March 29, 2023. There is no litigation contemplated between Patent Owner and Petitioner in view of the settlement agreement.

Termination of the Proceeding is appropriate because (i) the Parties are making this joint request under 35 U.S.C. § 317; and (ii) the Proceeding is at an early stage and the Board has not yet made an institution determination. 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." *See also* Patent Trial and Appeal Board Consolidated Trial

Practice Guide (November 2019), page 86, Section II (N) (“There are strong public policy reasons to favor settlement between the parties to a proceeding. [...] The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. 35 U.S.C. §§ 317(a), 327.”). Here, the Proceeding is at an early stage, no institution decision has been reached, the deadline for institution will not arrive for approximately three months, and there has been no decision on the merits.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties’ settlement agreement (Confidential Exhibit 1028) is being filed concurrently with this motion and request. As discussed in the Parties’ concurrently filed Joint Request, the Parties request that Confidential Exhibit 1028 be treated as business confidential information. There are no other agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the Proceeding.

For at least these reasons, termination of the *inter partes* review is appropriate under 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

III. CONCLUSION

There are no other petitioners to this *inter partes* review, and no final written decision on the merits has been entered. For at least these reasons, termination of

this *inter partes* review is proper under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Should this joint motion to terminate be denied, Petitioner would not continue to participate in the Proceeding.

As stated in 35 U.S.C. § 317(a) and 37 C.F.R. § 42.73(d), because Patent Owner and Petitioner jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to the Petitioner.

Dated: April 7, 2023

By: /Jeffrey Mann/

Jeffrey Mann (Reg. No. 51,993)
Ryan J. Singer (Reg. No. 79,736)
STROOCK & STROOCK & LAVAN
LLP
180 Maiden Lane
New York, New York 10038
Tel: (212) 806-5400
Fax: (212) 806-6006
Email: jmann@stroock.com
Email: rsinger@stroock.com

Counsel for Patent Owner

Dated: April 7, 2023

By: /John D. Vandenberg/

John D. Vandenberg, Reg. No. 31,312
john.vandenberg@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Petitioner

**CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6(E)(4)**

The undersigned certifies that on April 7, 2023, a complete copy of **JOINT MOTION TO TERMINATE PROCEEDING** was served on Patent Owner via electronic mail as follows:

Jeffrey Mann
Ryan J. Singer
STROOCK & STROOCK & LAVAN LLP
180 Maiden Lane
New York, NY 10038
Email: jmann@stroock.com
rsinger@stroock.com

Dated: April 7, 2023

By: /John D. Vandenberg/
John D. Vandenberg, Reg. No. 31,312
john.vandenberg@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Petitioner