

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NANOBEBE US INC.,

Petitioner,

v.

MAYBORN (UK) LIMITED,

Patent Owner

IPR2023-00467

Patent 10,952,930

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S.
PATENT NO. 10,952,930 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Petitioner Nanobebe Inc. (“Nanobebe”) and Patent Owner Mayborn (UK) Limited (“Mayborn”) (collectively, the “Parties”) jointly move to terminate the above-captioned *inter partes* review proceeding pursuant to the parties’ settlement of their dispute related to the challenged patent, U.S. Patent No. 10,952,930 (the “’930 Patent”). This joint motion was authorized by the Board in its email dated February 2, 2024. Along with this joint motion to terminate this proceeding, the Parties concurrently submit a true copy of the Parties’ confidential agreement (“Agreement”) as Exhibit 1031 along with a motion to keep the Agreement confidential and separate from the file of the ’930 Patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. There are no other agreements, written or oral, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

I. ARGUMENT

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB July 28, 2014).

a. Brief Explanation as to Why Termination Is Appropriate

Termination is appropriate because the Parties' have reached an agreement in principle to settle this case, and the Agreement resolves all disputes related to the '930 Patent between the Parties. The Parties are concurrently filing a copy of the Agreement as Exhibit 1031 along with a motion to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. In view of that request, Exhibit 1031 has been filed for access "Available Only to Board."

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1031 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1031 is a true and accurate copy of the Agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding. The parties "may terminate the proceeding ..., unless the Board has already decided the merits of the proceeding." Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 4 (Nov. 2019).

Petitioner has yet to file its Petitioner's Reply, and the Board has yet to decide the merits of this proceeding. The parties have now settled their dispute and have reached agreement to terminate the Petition.

Public policy favors terminating the present Petition for *Inter Partes* Review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dep’t of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. United States*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to mitigate antagonism and hostility between parties). And the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 86 (Nov. 2019).

b. Identification of Parties and Status of Litigation

The underlying district court litigation between the parties, captioned *Nanobebe US Inc. v. Mayborn (UK) Limited et al.*, Case No. 1:21-cv-08444 (S.D.N.Y.), which is currently stayed, shall be dismissed with prejudice upon the earlier of the execution of a long-form agreement or February 2, 2024. *See* Ex.[1031], Section 2.

In addition, Nanobebe is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

c. Identification and Status of Proceedings Before the USPTO

Petitioner's Reply is due on February 6, 2024. *See* Paper No. 25. The parties have now resolved their dispute and reached agreement to terminate this proceeding as well as related IPR proceeding IPR2023-00465. The USPTO can conserve its resources by terminating now, removing the need for the Board to further consider the arguments and to render a Final Written Decision. Therefore, the Parties respectfully request termination of this *Inter Partes* Review

Dated: February 2, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 2nd day of February, 2024, the **Joint Motion to Terminate *Inter Partes* Review of U.S. Patent No. 10,952,930 Under 35 U.S.C. § 317 and 37 C.F.R. § 42.72** was served by email on the following counsel for Patent Owner:

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Dated: February 2, 2024

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