UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XILINX, INC.
Petitioner

v.

POLARIS INNOVATIONS LIMITED
Patent Owner

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Case IPR2023-00516
U.S. Patent 6,157,589

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JOINT MOTION TO TERMINATE PROCEEDING

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Xilinx, Inc. and Patent Owner Polaris Innovations Limited (collectively, the "Parties"), through their respective counsel of record, jointly request termination of this proceeding in view of the Parties' resolution of their dispute relating to U.S. Patent No. 6,157,589 (the "'589 Patent"). The Board authorized the filing of this Joint Motion to Terminate via e-mail dated February 7, 2024.

Termination with respect to Petitioner and Patent Owner is appropriate in the instant proceeding because the dispute between the parties has been resolved. The Parties have reached a confidential settlement of their dispute with respect to the '589 Patent, which includes an agreement to terminate this and all related proceedings. The confidential settlement agreement between Petitioner and Patent Owner has been made in writing, and a true and correct copy of the settlement agreement between the Parties is filed concurrently with this motion as Exhibit 1020 (which is submitted as "Parties and Board Only"), pursuant to 35 U.S.C. § 317(b), along with a separate Joint Request to Treat as Confidential and Keep Separate Pursuant to 35 U.S.C. § 317(b). The Parties certify that there are no other collateral agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding. The Parties request that the settlement agreement be treated as business confidential

information, be kept separate from the files of the involved patent, and be made available only pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c).

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (PTAB Oct. 24, 2018). "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." PTAB Consolidated Trial Practice Guide at 86 (November 2019).

This proceeding was instituted on September 15, 2023. Paper 12. Patent Owner filed its response on December 11, 2023. Paper 17. Petitioner has yet to file its Reply, which is due on March 4, 2024. Paper 13 at 12. Oral argument is set for June 12, 2024. *Id*. As such, the Board has not already decided the merits, making termination appropriate under 34 C.F.R. § 42.72. Moreover, the parallel litigations will be dismissed pursuant to the Parties' settlement agreement.

Therefore, for the foregoing reasons, Petitioner and Patent Owner jointly request termination of this proceeding.

Dated: February 8, 2024

Respectfully submitted,

/Brian W. Oaks/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on February 8, 2024, a copy of the foregoing document was electronically served on the following counsel of record for Patent Owner:

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/Brian W. Oaks/
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Lead Counsel for Petitioner