UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KIOXIA AMERICA, INC. and KIOXIA CORPORATION,

Petitioners,

v.

BiTMICRO LLC,

Patent Owner.

Case No.: IPR2023-00742
U.S. Patent No. 8,010,740

JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioners KIOXIA Corporation and KIOXIA America, Inc. ("Petitioners") and Patent Owner BiTMICRO LLC ("Patent Owner") hereby jointly request that the above-referenced pending *inter partes* review be terminated. The Board authorized the filing of this motion in an email to the Parties on November 13, 2023.

Good cause exists to terminate this 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." Office Patent Trial Practice Guide, (Nov. 2019); *see also* 35 U.S.C. § 317(a) ("An *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"). Here, the Parties respectfully submit that termination is appropriate because they have reached an agreement resolving the dispute involving the patent at issue in the above-captioned *inter partes* review, briefing has not been completed on the issues raised in the above-captioned *inter partes* review, and the Board has not issued a final written decision or decided the merits of the proceeding. Moreover, the Parties filed a Joint Motion for Dismissal in the United States District Court for the Western District of Texas on November 13, 2023 in the underlying lawsuit styled *BiTMICRO*

v. KIOXIA America, Inc., et al., Case No. 6:22-cv-00331-ADA (W.D. Tex).

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioners and Patent Owner submit concurrently herewith a true and correct copy of the Settlement and License Agreement governing the resolution of the *inter partes* review and underlying litigation. *See* Confidential Exhibit 2001. There are no other collateral agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

The Parties are concurrently filing a joint request that the Settlement and License Agreement, Confidential Exhibit 2001, be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 42.74(c).

Dated: November 13, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on November 13, 2023, a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email addresses of record as follows:

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