UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SPLAT-R-BALL, LLC, DAISY MANUFACTURING COMPANY,
AND S-BEAM PRECISION PRODUCTS LTD.,
Petitioner

v.

SPIN MASTER, INC.,
Patent Owner

Case IPR2023-00773
Patent No. 8,640,683

JOINT MOTION TO TERMINATE PROCEEDING

LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 8,640,683 (the "'683 Patent")
1002	Prosecution History of the '683 Patent
1003	Declaration of Amanda Bligh, Ph.D.
1004	Curriculum Vitae of Amanda Bligh, Ph.D.
1005	Declaration of Robert Wanat
1006	Curriculum Vitae of Robert Wanat
1007	Publication Declaration of Nathanial E. Frank-White and ThinkGeek Spitballs Internet Archive Webpage ("Spitballs")
1008	Publication Declaration of Nathanial E. Frank-White and ThinkGeek Internet Archive Webpage
1009	Japanese Patent No. JP 2006-234191 ("Nagayoshi")
1010	U.S. Patent No. 3,521,616 ("Meggs")
1011	Bulgarian Patent No. BG110343 ("Peev")
1012	Translation of Bulgarian Patent Law Section 46(c)(2)
1013	U.S. Patent No. 683,431 ("Bennett")
1014	U.S. Patent No. 408,971 ("Hamilton")
1015	Publication Declaration of Nathanial E. Frank-White and Spudgun Internet Archive Webpage ("Spudgun")
1016	Korean Patent Publication No. KR 20-2010-0004855 ("Kim")
1017	Publication Declaration of Anna Tanova-Atanasova
1018	N. Gawande, A.A. Mungray, Superabsorbent polymer (SAP) hydrogels for protein enrichment, *Separation and Purification Technology* (2015)
1019	"Not your kid brother's toy gun," CNET (2006), available at https://www.cnet.com/culture/not-your-bkid-brothers-toy-gun/
1020	"Airsoft Submachine Gun with Laser Sight," Internet Archive (2006), available at https://web.archive.org/web/20061125021504/http://www.thinkgeek.com/geektoys/warfare/8932/
1021	"Tech: Desk Toys," Wall Street Journal (2006), available at https://www.wsj.com/articles/SB116684498725258456
1022	"USB Airsoft Turret," Inventgeek (2006), available at www.inventgeek.com/usb-airsoft-turret/

Exhibit No.	Description
1023	"R/C Missile Launcher – Unstoppable Cube Welfare," The Green Head (2006), available at https://www.thegreenhead.com/2006/05/rc-missile-launcher-unstoppable-cube.php
1024	Prosecution History of U.S. Patent No. 8,371,282
1025	"Cube Warfare Toys," Internet Archive (2006), available at https://web.archive.org/web/20061211065620/http://www.thinkgeek.com/geektoys/warfare/feature/desc/0/all
1026	"BB, Pellet, Paintball Guns Dangerous to Kids: Experts Say Don't Characterize Them as Toys," WebMD (2004), available at https://www.webmd.com/children/news/20041101/bb-pellet-paintball-guns-dangerous-to-kids
1027	"Not Your Dad's BB Gun," Washington Post (2004), available at https://www.washingtonpost.com/archive/lifestyle/2004/11/26/not-your-dads-bb-gun/6ccffa5e-a5bb-45e2-9a5c-a17de827267c/
1028	"Airsoft Guns: A Double-Edged Sword," Bleacher Report (2008), available at https://bleacherreport.com/articles/46402-airsoft-guns-a-double-edged-sword
1029	"Spitballs Grow up to 200 times their original Size," YouTube (2010), available at https://www.youtube.com/watch?v=n-Wje1G1wBA
1030	Liquid Marbles Video, YouTube (2009), available at https://www.youtube.com/watch?v=Us-LpPp9HUc&lc=UgyTGvGXd3eo8c4tyB4AaABAg
1031	Liquid Marbles Video Comments, YouTube (2009), available at https://www.youtube.com/watch?v=Us-LpPp9HUc&lc=UgyTGvGXd3eo8c4 tyB4AaABAg
1032	"Discovering the Chemistry of Infomercials," BCA Chemistry, available at https://bcachemistry.wordpress.com/tag/orbeez/
1033	"What do you do with Orbeez?," YouTube (2010), available at https://www.youtube.com/watch?v=Zt1QRj2pcTw
1034	"Toy-making is serious business in Southern California," Los Angeles Times (2012), available at http://www.latimes.com/business/la-xpm-2012-dec-22-la-fi-social-enterprise-toys-20121223-story.html
1035	New Oxford American Dictionary (2001)
1036	Webster's II New College Dictionary (2005)
1037	Patent Owner's Notice of Patent Priority Dates and Dates of Conception
1038	10.18.2022 Joint Claim Construction Chart
1039	U.S. Patent No. 8,584,589 ("Carlson")

Exhibit No.	Description
1040	Superabsorbent Polymers from South Korea, Investigation No. 731-TA-1574 (Final)
1041	"DuneCraft Spit Balls," The Green Head (2009), available at https://www.thegreenhead.com/2009/11/dunecraft-spit-balls.php
1042	10.25.2022 Infringement Contentions Chart US8371282 for Splat-R-Ball Products
1043	Be Amazing Toys Meeting Information dated May 28, 2008
1044	11.23.2022 Deposition Transcript of Steve Spangler
1045	Images of Steve Spangler at Science in the Rockies (July 10, 2008)
1046	Video of Steve Spangler's Tube Presentation at Science in the Rockies
1047	"Vanishing Jelly Marbles," Internet Archive (2009), available at https://web.archive.org/web/20090308004638/http:/www.stevespanglerscience.com /content/experiment/vanishing-jelly-marbles
1048	Photographs of Steve Spangler's Blow Guns
1049	U.S. Patent Application Publication No. 2008/0168973 ("Levin")
1050	U.S. Patent No. 7,134,978 ("Liu")
1051	Daisy Outdoor Products Catalog (2006)
1052	Prosecution History of U.S. Patent No. 8,596,255
1053	Luis E. Martinez, Force-on-Force Police Training Using Airsoft, A Manual for the Law Enforcement Trainer on the use of Airsoft Non-Lethal Technology
1054	Fredric L. Buchholz and Andrew T. Graham, Modern Superabsorbent Polymer Technology, Wiley-VCH (1998)
1055	"One Team, One Product—Many Uses," Agricultural Research (1996)
1056	"Super Slurper," Agricultural Research (1975)
1057	U.S Patent No. 3,997,484
1058	"History of Super Absorbent Polymer Chemistry"
1059	"Superabsorbent Polymer : Materials : A Review" (2008)
1060	U.S Patent No. 2006/0069367 A1
1061	Japanese Industrial Standard JIS K 7223:1996 – Testing method for Water Absorption Capacity of Super Absorbent Polymers
1062	U.S Patent No. 5,660,935
1063	"Superabsorbent Polymers and Superabsorbent Polymer Composites" (2007)

Exhibit No.	Description
1064	11.28.2022 Deposition Transcript and Errata of Ellen Peterson
1065	"Bow and arrow," Wikipedia (2022)
1066	"List of infantry weapons of World War I," Wikipedia (2022)
1067	"Slingshot," Wikipedia (2022)
1068	Video Screenshot of "Spitballs Grow up to 200 times their original Size," YouTube (2010), available at https://www.youtube.com/watch?v=n-Wje1G1wBA
1069	Video Screenshot of "What do you do with Orbeez?," YouTube (2010), available at https://www.youtube.com/watch?v=Zt1QRj2pcTw
1070	10.25.2022 Infringement Contentions Chart US8640683 for Splat-R-Ball Products
1071	Confidential Settlement Agreement Between Hasbro, Inc. and Petitioners Daisy Manufacturing Co. and Splat-R-Ball, LLC
1072	Confidential Settlement Agreement Between Hasbro, Inc. and S-Beam Precision Products Ltd.

Petitioners and Patent Owner, by and through its exclusive licensee Hasbro Inc., (collectively, "the Parties") have reached a settlement. Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the Parties move to terminate the present *inter partes* review proceeding regarding U.S. Patent No. 8,640,683 ("the '683 Patent").

I. CONCURRENT REQUEST FOR AUTHORIZATION

The Parties respectfully request Board authorization concurrently with filing this Joint Motion to Terminate. *See* 37 C.F.R. § 42.20 ("A motion will not be entered without Board authorization."). The Parties finalized their settlement agreement hours before opening arguments in the co-pending ITC investigation and sought to file termination motions there and here around the same time to resolve all pending disputes contemporaneously. Given the unique timing and nature of the Parties' agreement, and the strong public policy reasons to promote settlement, there is good cause to consider this authorization request timely under 37 C.F.R. § 42.20, or alternatively, to waive the authorization requirement pursuant to 37 C.F.R. § 42.5(b).

II. STATEMENT OF THE FACTS

On July 20, 2022, Patent Owner submitted a request to the United States International Trade Commission for an investigation pursuant to Section 337 of the Tariff Act of 1930 (Inv. No. 337-TA-1325) based on two related patents—the '683 Patent and U.S. Patent No. 8,371,282 ("the '282 Patent").

Petitioner filed Petitions for *inter partes* review of the '282 and '683 Patents on March 24, 2023 in this proceeding, Case No. IPR2023-00773, and in Case No. IPR2023-00772. Patent Owner's Preliminary Responses are due on July 24, 2023.

The Parties have now reached an agreement (the "Settlement Agreement") to resolve their disputes. The Settlement Agreement has been made in writing, and a true and correct copy of the same is filed herewith as Confidential Exhibits 1071 and 1072. The Parties also desire the Settlement Agreement to be maintained as business confidential under 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

III. RELIEF REQUESTED

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."

Termination of this *inter partes* review is appropriate because the Board has not yet "decided the merits of the proceeding." *See*, *e.g.*, PTAB Consolidated Trial Practice Guide (Nov. 2019), p. 86. Indeed, the Board's Institution Decision is still months away, and any Final Written Decision is more than a year out. A decision on the merits here is far more remote than in other cases where the Board has granted joint termination motions. *See*, *e.g.*, *AM General LLC v. Uusi, LLC*, IPR2016-

01050, Paper 44 (Nov. 7, 2017) (terminating an instituted IPR after the oral hearing); *Lam Research Corp. v. Daniel L. Flamm*, IPR2015-01764, IPR2015-01767, IPR2015-01768, Paper 27 (Dec. 15, 2016) (same); *Hydrite Chemical Co. v. Solenis Technologies, L.P.*, IPR2015-01586, Paper 38, IPR2015-01592, Paper 39 (Nov. 25, 2016) (same); *Clio USA, Inc. v. The Procter & Gamble Company*, IPR2013-00438, Paper 57 (Oct. 31, 2014) (same).

Consistent with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' Settlement Agreement is in writing, and true and correct copies are being filed as Confidential Exhibits 1071 and 1072. There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.

In addition to satisfying the statutory and regulatory requirements, termination is also appropriate because it would preserve significant resources for the Parties and the Board.

IV. CONCLUSION

The Parties have settled all disputes relating to the '683 Patent. This proceeding is at an early stage, and the Board has not entered any decision on the merits. Accordingly, the Parties respectfully request termination of this proceeding.

Dated: May 18, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on May 18, 2023, a true and correct copy of the foregoing JOINT MOTION TO TERMINATE PROCEEDING by overnight carrier to the Patent Owner at the correspondence address of record for the Patent Owner as follows:

Stephen Ashley
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Brookfield Place
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A courtesy copy of the foregoing was also served on the counsel of record via email at the following address:

IPR50745-0001IP2@fr.com

/s/ Gianni L. Cutri
Gianni L. Cutri