

Filed on behalf of: Flexiworld Technologies, Inc.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEXMARK INTERNATIONAL, INC.,

Petitioner,

v.

FLEXIWORLD TECHNOLOGIES, INC.,

Patent Owner.

Case IPR2023-00846

U.S. Patent No. 9,965,233

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72, 42.74**

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board’s authorization by email dated January 17, 2024, Petitioner Lexmark International, Inc. (“Lexmark”) and Patent Owner Flexiworld Technologies, Inc. (“Flexiworld”) jointly move to terminate the present *inter partes* review proceeding as a result of a Patent License Agreement between Lexmark and Flexiworld (the “Agreement”). The Agreement completely resolves all pending controversies between Lexmark and Flexiworld concerning U.S. Patent No. 9,965,233 (“the ’233 patent”).

The parties are concurrently filing true copies of their Agreement in connection with this matter as required by statute. The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Agreement be treated as business confidential information and kept separate from the file of the ’073 patent. A joint request for such treatment pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently herewith.

II. STATEMENT OF FACTS

Flexiworld asserted the ’233 patent against Lexmark in the action entitled *Flexiworld Technologies, Inc. v. Lexmark International, Inc.*, Case No. 5:22-cv-

00110-KKC (E.D. Ky.). Flexiworld asserted thirteen other patents against Lexmark in the complaint in that litigation and others filed on the same day (collectively “the Lexmark Litigations”).

On April 28, 2023, Lexmark filed a petition for *inter partes* review in this proceeding against the '233 Patent. *See generally* Paper 1. On November 14, 2023, the Board issued a decision granting institution in this proceeding. *See generally* Paper 6. Under the Board’s scheduling order, Flexiworld’s patent owner response is due on February 6, 2024. *See* Paper 7.

On January 16, 2024, the parties entered into the Agreement pursuant to which they agreed, among other things, to dismiss with prejudice the Lexmark Litigations and to seek termination of this IPR proceeding. Concurrently herewith, the parties are filing joint motions to dismiss all claims in the Lexmark Litigations with prejudice. Pursuant the Board’s January 17, 2024 authorization email, the parties hereby submit this joint motion to terminate. Collectively, these joint filings before the Board and the district court will resolve all pending disputes between Flexiworld and Lexmark.

III. LEGAL STANDARD

35 U.S.C. § 317(a) provides that “[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.” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that 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.” 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

IV. GOOD CAUSE EXISTS TO TERMINATE THIS PROCEEDING.

Termination of the instant IPR is appropriate because the parties have settled their entire dispute concerning the ’233 Patent and the Board has not yet decided the merits of this proceeding. Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (P.T.A.B. July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). Patent Owner submits that terminating this proceeding promotes the Congressional goal to establish a more efficient and streamlined patent system that, inter alia, limits unnecessary and counterproductive litigation costs. See “Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional

Program for Covered Business Method Patents,” Final Rule, 77 Fed. Reg. 48680 (Aug. 14, 2012).

Accepting these principles, the Board has terminated proceedings based upon joint or unopposed motions to terminate. *See, e.g., Staylinked Corp. v. Ivanti, Inc.*, IPR2021-00022, Paper 10 (P.T.A.B. Feb. 4, 2021) (granting unopposed motion); *World Programming LTD. v. SAS Institute, Inc.*, IPR2019-01457 Paper 22 at 2 (P.T.A.B. Dec. 27, 2019); *Samsung v. Nvidia*, IPR2015-01270, Paper 12 (P.T.A.B. Dec. 9, 2015).

V. CONCLUSION

Petitioner and Patent Owner respectfully request that the Board grant the parties’ Joint Motion and terminate this proceeding. The parties also request that the Board grant the parties’ joint request to treat the Agreement as business confidential information and keep it separate from the file of the ’233 patent and this *inter partes* review proceeding.

Dated: January 17, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Joint Motion to Terminate was served January 17, 2024, to Lead and Back-up Counsel for Petitioner:

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