UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZYXEL COMMUNICATIONS CORPORATION AND
ZYXEL NETWORKS CORPORATION,
Petitioners
v.

ATLAS GLOBAL TECHNOLOGIES LLC,
Patent Owner

Case No. IPR2023-00877
Patent No. 9,917,679

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

I. STATEMENT OF RELIEF REQUESTED

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 October 13, 2023, Petitioners ZyXEL Communications Corporation and ZyXEL Networks Corporation (collectively, "ZyXEL" or "Petitioners") and Patent Owner Atlas Global Technologies LLC ("AGT" or "P.O.") jointly move to terminate the present *inter partes* review proceeding as a result of a Settlement Agreement entered as of October 12, 2023 ("Settlement Agreement"). The Settlement Agreement completely resolves all pending controversies between ZyXEL and AGT concerning U.S. Patent No. 9,917,679 ("the '679 Patent").

The parties are concurrently filing true copies of the Settlement 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 Settlement Agreement be treated as business confidential information and kept separate from the file of the '679 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

AGT asserted the '679 Patent against ZyXEL in the action entitled *Atlas Global Technologies LLC v. ZyXEL Communications Corporation and ZyXEL Networks Corporation*, Case No. 6:22-cv-00355-ADA (W.D. Tex.) (the "Texas Litigation").

Petitioners filed a petition for *inter partes* review of the claims of the '679 Patent on April 21, 2023. Patent Owner filed its preliminary response on August 11, 2023. The Board has not issued its institution decision. ZyXEL Communications Corporation and ZyXEL Networks Corporation are the only Petitioners in this Proceeding.

The Settlement Agreement was entered on October 12, 2023. Pursuant to the Settlement Agreement, ZyXEL and AGT agreed, among other things, to mutually cooperate to request the termination of this IPR proceeding.

ZyXEL filed the following petitions to institute *inter partes* proceedings concerning patents owned by AGT:

IPR	Patent	Filed Date
IPR2023-00863	9,531,520	April 18, 2023
IPR2023-00877	9,917,679	April 21, 2023

ZyXEL and AGT will file motions to dismiss or terminate each of these proceedings in light of the Settlement Agreement involving ZyXEL and AGT. Thus, once the

Board grants those motions, there will be no other proceedings before the Patent Office involving both ZyXEL and AGT.

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 THE ABOVE-CAPTIONED IPR

Termination of the instant IPR is appropriate because all parties have settled their entire dispute concerning the '679 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)).

Further, termination of the proceeding is a just and fair resolution. The parties agree that neither Petitioners nor P.O. will be prejudiced by the termination. Finally, the parties will benefit from preserving resources that would otherwise be expended if this motion is denied.

V. CONCLUSION

For at least these reasons, Petitioners and P.O. respectfully request that the Board grant this Joint Motion to Terminate the above-captioned IPR proceeding.

Date: October 16, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned "JOINT MOTION TO TERMINATE PROCEEDING" was served in its entirety on October 16, 2023, via electronic service on lead and back-up counsel:

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