

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERNATIONAL BUSINESS MACHINES CORPORATION
Petitioner,

v.

DIGITALDOORS, INC.
Patent Owner.

Case IPR2023-00973
U.S. Patent 8,468,244

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

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner International Business Machines Corporation (“Petitioner” or “IBM”) and Patent Owner DigitalDoors, Inc. (“Patent Owner” or “DigitalDoors”) jointly file this request to terminate pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

On April 17, 2024, the litigation between DigitalDoors and IBM involving U.S. Patent 8,468,244 in the Eastern District of Texas was dismissed with Prejudice. See E.D. of Tex. case no. 2:22-cv-00457-JRG-RSP, Dkt. No. 77.

Thereafter, on May 15, 2024, by email correspondence, Patent Owner DigitalDoors requested that the above-referenced IPR petition be dismissed under 35 U.S.C. § 317. In email correspondence dated May 15, 2024, the Board authorized the parties to file a joint motion to terminate *Inter Partes* Review No. IPR2023-00973 pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

On April 1, 2024, Petitioner and Patent Owner filed a Joint Stipulation of Dismissal in the related District Court case, settling all disputes relating to the patent at issue in this proceeding (“the Agreement”). Pursuant to 37 C.F.R. § 42.74(b), the Agreement between Petitioner and Patent Owner is in writing, a true copy of which is submitted herewith as Exhibit 2016. There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.

II. STATUS OF PROCEEDINGS

The following are the only proceedings that involve the subject patent.

District Court Case	Status
TXED-2-22-cv-00457	Dismissed April 17, 2024

PTAB Case	Status
IPR2023-00973	Instituted

II. RELIEF REQUESTED

Petitioner and Patent Owner jointly request that the Board dismiss and terminate this proceeding in its entirety. Termination is appropriate at this stage in view of the Agreement which reflects that all disputes between the parties relating to the patent at issue in this proceeding have ended. Exhibit 2016.

Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. See, e.g., *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The U.S. Court of Appeals for the Federal Circuit also places a particularly strong emphasis on settlement. See *Cheyenne River Sioux*

Tribe v. U.S., 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Accordingly, the Board generally expects that a proceeding will terminate after the filing of a settlement. See, e.g., Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

In addition, 35 U.S.C. § 317(a) states 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.” The Board has not decided the merits of this proceeding, and this proceeding should be terminated.

IV. **CONCLUSION**

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board dismiss and terminate this proceeding in its entirety.

Dated: May 22, 2024

Respectfully submitted,

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Case No. IPR2023-00973

U.S. Patent 8,468,244

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that on May 22, 2024, a complete and correct copy of the foregoing JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74 was served via electronic mail on the following counsel of record for Petitioner:

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