Filed on behalf of: Meta Platforms, Inc.

Entered: May 21, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

EIGHT KHZ, LLC,
Patent Owner.

Case IPR2023-01021
Patent 10,917,737 B2

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

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.72 and 42.74, Petitioners Meta Platforms, Inc., Meta Platforms Technologies, LLC, and Twisted Pixel Games, LLC (collectively, "Meta" or "Petitioners") and Patent Owner Eight kHz, LLC ("8K" or "Patent Owner") (collectively, the "Parties") jointly request termination of the *inter partes* review of U.S. Patent No. 10,917,737 (the "'737 Patent"), Case No. IPR2023-01021. The filing of this Joint Motion was authorized by the Board in email correspondence dated May 20, 2024.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On May 15, Petitioner and Patent Owner executed a confidential agreement to resolve all disputes regarding the '737 Patent. Accordingly, termination is appropriate because all disputes between the parties regarding the '737 Patent have been resolved.

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018); *see also* Consolidated Trial Practice Guide at 86 (Nov. 2019) ("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."). Further, a dismissal of this IPR would promote efficiency and minimize unnecessary costs.

Termination is warranted here. This proceeding is still in its preliminary stages. Petitioners filed their petition for *inter partes* review on June 9, 2023 (Paper 2). The Patent Owner's preliminary response was filed October 11, 2023 (Paper 6), the Petitioner's reply was filed on November 6, 2023 (Paper 7), and the Patent Owner's sur-reply was filed on November 13, 2023 (Paper 8). The Board issued an Order on January 9, 2024 instituting the requested *inter partes* review (Paper 9). Patent Owner has not yet filed its Patent Owner's Response.

Further, the Parties are jointly requesting termination because the parties have settled their larger dispute concerning the '737 Patent, including in the district court litigation between the parties. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("There are strong public policy reasons to favor settlement between the parties to a proceeding."). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation, and terminating this IPR furthers that purpose. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 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.").

The Parties' confidential agreement is submitted concurrently herewith. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a Joint Request that the confidential agreement be treated as confidential business information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). A true and correct copy of the confidential agreement is submitted with that Request as Confidential Exhibit 1145.

Petitioners and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Both Petitioners and Patent Owner support termination of the proceeding.

III. CONCLUSION

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

Respectfully submitted,

Dated: May 21, 2024

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 21st day of May, 2024, a true and correct copy of the foregoing **Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses.

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