UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC
Petitioner

v.

SCRAMOGE TECHNOLOGY LTD.,

Patent Owner.

Case No. IPR2023-01048
U.S. Patent No. 10,546,685

JOINT MOTION OF PETITIONER AND PATENT OWNER TO TERMINATE *INTER PARTES* REVIEW PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. **§** 42.72, and the Board's authorization provided on August 17, 2023, Petitioner BMW of North America, LLC ("BMW" or "Petitioner") and Patent Owner Scramoge Technology Ltd. ("Scramoge" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached a settlement agreement and jointly request termination of the following *inter partes* reviews:

1. Case No. IPR2023-00913 challenging U.S. Patent No. 10,243,400 ("the '400 patent");
2. Case No. IPR2023-01048 challenging U.S. Patent No. 10,546,685 ("the '685 patent").

Because none of the IPRs have been joined, this motion has been filed under separate caption in each proceeding.

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the parties relating to the '400 patent and the '685 patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review 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 proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, "no

estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner." *Id.*

Petitioner filed IPR2023-00913 (directed to the '400 patent) on June 7, 2023, and filed IPR2023-01048 (directed to the '685 patent) on June 30, 2023. Patent Owner's Preliminary Response for both IPRs is due October 30, 2023. Neither IPR has been instituted and no other motions or actions are outstanding. The proceedings are thus in the preliminary stage, the record lacks full briefing on the trial issues, and the Board has accordingly not decided the merits of the proceedings.

The Parties also represent that they have agreed to settle and dismiss all other litigation between them and that there are no related IPR proceedings in the U.S. Patent and Trademark Office.

Further, Patent Owner represents that it does not have any plans at the present time to assert any of the challenged claims against any particular company. Thus, by granting the present motion, the Board and the Parties can conserve resources.

II. Agreement in Writing Submitted to the Board

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties' settlement agreement is being submitted as Exhibit 1020. The settlement

agreement is in writing and constitutes the Parties' entire understanding and agreement.

III. Conclusion

For at least the foregoing reasons, the Parties respectfully request that the Board terminate *Inter Partes* Reviews IPR2023-00913 and IPR2023-01048.

Dated: August 18, 2023

Respectfully submitted,

/s/Brett Cooper
Brett Cooper

Counsel for Patent Owner
Scramoge Technology Ltd.

/Lionel M. Lavenue/
Lionel M. Lavenue

Counsel for Petitioner
BMW of North America, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION OF PETITIONER AND PATENT OWNER TO TERMINATE *INTER PARTES* REVIEW PROCEEDING** was served on August 18, 2023, via email directed to counsel of record for Patent Owner at the following:

Brett Cooper
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Dated: August 18, 2023

By: /Lisa C. Hines/
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