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To: [Gordon, Lori \(Perkins Coie\)](#); [Trials](#)
Cc: [Oaks, Brian](#); [Matthew, Thomas \(Perkins Coie\)](#); morgan.mayne@bakerbotts.com; jeff.becker@bakerbotts.com; clarke.stavinoha@bakerbotts.com
Subject: RE: IPR2023-01104, -1105, -1227: Authorization to File Motion to Terminate Due to Settlement and Request to Treat Settlement Agreement As Confidential
Date: Thursday, February 22, 2024 11:59:51 AM

Counsel,

The parties are authorized to file a joint motion to terminate in each proceeding. The parties should file a true copy of the settlement agreement and any collateral agreements (including any licensing agreements) with the Board. See *DTN v. Farms Technology, LLC*, IPR2018-01412, Paper 21 (June 19, 2019 PTAB) (precedential) (explaining requirements for filing collateral agreements). The parties should include a statement in the joint motion to terminate 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, assuming such statement is correct. Alternatively, if the parties cannot make such a statement, the other agreement(s) should be filed pursuant to 37 C.F.R. § 42.74(b).

The parties also are authorized to file a joint request to treat the settlement agreement as business confidential information in each proceeding. To have the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file a true copy of the confidential settlement agreement electronically in Patent Trial and Appeal Board End to End (PTAB E2E) as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at https://www.uspto.gov/sites/default/files/documents/p-tacts_faqs_20221007.pdf for guidance on how to file their settlement agreement as confidential.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Gordon, Lori (Perkins Coie) <LoriGordon@perkinscoie.com>
Sent: Thursday, February 22, 2024 10:38 AM
To: Trials <Trials@USPTO.GOV>
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IPR2023-01104, -01104, 01227
Ex. 3001

IPR2023-01104: U.S. Patent 8,682,505
IPR2023-01105: U.S. Patent 8,332,082
IPR2023-01227: U.S. Patent 11,288,972

Your Honors –

All disputes between Petitioner and Patent Owner related to U.S. Patent 8,682,505, U.S. Patent 8,332,082, and U.S. Patent 11,288,972 have been resolved by settlement. Petitioner and Patent Owner therefore jointly request authorization to file (1) a motion to terminate the above-referenced IPRs and (2) a joint request to treat their settlement agreement as business confidential information.

Should the Board require a conference call to discuss this request, the parties are generally available during business hours Eastern time (or can propose specific times and dates of availability).

Regards –

Lori A. Gordon
Lead Counsel – Petitioner

Brian Oaks
Lead Counsel – Patent Owner

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