UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HEWLETT PACKARD ENTERPRISE COMPANY,

Petitioner,

v.

SOVEREIGN PEAK VENTURES, LLC,

Patent Owner.

_____

Case IPR2023-01261

U.S. Patent No. 8,045,531

JOINT MOTION TO TERMINATE PROCEEDINGS

EXHIBIT LIST

Exhibit No.	Description
2001	Confidential Settlement and License Agreement (Parties and Board Only)

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner HEWLETT PACKARD ENTERPRISE COMPANY and Patent Owner SOVEREIGN PEAK VENTURES, LLC jointly request that this *inter partes* review proceeding involving U.S. Patent No. 8,045,531 ("the '531 patent") be terminated based on a settlement between Petitioner and Patent Owner ("the Parties") with respect to the '531 patent.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing of the instant motion on October 11, 2023. Guidance as to the content of a motion to terminate is provided in IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id*. at 2. This motion satisfies each of the above requirements and is accompanied by the Parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 35 C.F.R. § 42.74 (b).

a. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because no patent owner preliminary response or patent owner response has yet been filed, no trial has been instituted, the Board has not decided the merits of the proceeding, and no final written decision has been issued. Under 35 U.S.C. § 317(a), this proceeding "shall be terminated with respect to [] [P]etitioner" because the parties are jointly requesting termination and the Office has not yet "decided the merits of the proceeding before the request for termination is filed." The Parties have resolved their disputes with respect to the '531 patent. Patent Owner has filed a notice of dismissal of its infringement claim under the '531 patent in the related proceedings (*Sovereign Peak Ventures, LLC v. Hewlett Packard Enterprise Company*), and Patent Owner and Petitioner have executed an agreement to request termination of this proceeding and providing a covenant not to sue under the '531 patent.

b. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigations are related to the '531 patent:

Sovereign Peak Ventures, LLC v. Hewlett Packard Enterprise Company, Civil Action No. 2:23-CV-00009-JRG-RSP (E.D. Tex.).

c. Related Proceedings Currently Before the Office

The following proceedings are related to the PTAB IPR2023-01261:

Hewlett Packard Enterprise Company v. Sovereign Peak Ventures, LLC, PTAB-IPR2023-01260.

Hewlett Packard Enterprise Company v. Sovereign Peak Ventures, LLC, PTAB-IPR2023-01262.

Joint motions to terminate each of the above proceedings are being filed concurrently with this instant motion.

d. Current Status of Each Such Related Litigation of Proceeding With Respect to Each Party in the Litigation or Proceeding

Sections II.b and II.c above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding.

III. SETTLEMENT AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 2001.[1] There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of these proceedings. The parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the settlement agreement as business confidential information and keep it separate from the files of the '531 patent.

IV. CONCLUSION

[1] The settlement agreement is being filed via the PTAB E2E with access to the "Parties and Board only."

For all these reasons, the Parties respectfully request termination of this proceeding.

Respectfully submitted,

Dated: October 12, 2023

/ Patrick D. McPherson/
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing

JOINT MOTION TO TERMINATE PROCEEDINGS

was served on October 12, 2023, by filing this document though the PTAB P-TACTS System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following addresses:

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The parties have agreed to electronic service in this proceeding.

Respectfully submitted,

Dated: October 12, 2023

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