

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DeFi Education Fund

Petitioner

v.

True Return Systems, LLC

Patent Owner

IPR2023-01388

Patent 10,025,797 B1

**JOINT MOTION TO TERMINATE
THE PROCEEDING PURSUANT TO 37 C.F.R. §§ 42.71 and 42.74**

I. Statement of Relief Requested

Pursuant to 37 C.F.R. §§ 42.71 and 42.74, and the Board's authorization on August 22, 2024, Petitioner DeFi Education Fund (“Petitioner”) and Patent Owner True Return Systems, LLC (“Patent Owner”)(collectively “the Parties”), jointly move that the Board terminate the above-captioned proceeding as a result of a settlement agreement between the Parties.

The settlement agreement, designated as Exhibit 1025 is being filed concurrently herewith, designated as “Only to Board” to preserve the confidentiality of the agreement. The Parties are also filing concurrently herewith a request that the settlement agreement be treated as business confidential information and be kept separate from the file of this proceeding and the involved patent, pursuant to 35 U.S.C. 317(b) and 37 C.F.R. § 42.74(c).

II. Statement of Facts

On September 7, 2023, Petitioner sought *inter partes* review of U.S. Patent No. 10,025,797 (the “’797 Patent”) via the present proceeding. The Board instituted trial on January 5, 2024. Paper 7. On August 8, 2024, Petitioner and Patent Owner jointly entered into a settlement agreement that resolved Petitioner and Patent Owner's disputes with regard to the ’797 Patent and the present proceeding. *See* EX1025, *passim*. Pursuant to the terms of the settlement agreement, the Parties

agreed, among other things, to jointly move for termination of the above-captioned IPR proceeding. EX1025 at 3.

III. Argument

A. Legal Standard

35 U.S.C. § 317(a) provides 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.” Furthermore, the “parties may agree to settle any issue in a proceeding.” 37 C.F.R. § 42.74. The *inter partes* review process recognizes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and “[t]he 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.” Consolidated Trial Practice Guide at 86 (November 2019); *see also* 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

B. The Board Should Terminate the Above-Captioned Proceeding

As noted above, “An 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.” 35 U.S.C. § 317(a) (emphasis added). The present motion is being submitted prior to a decision on the merits, and therefore, it

is appropriate for the Board to exercise its authority pursuant to 37 C.F.R. § 42.74 to terminate the proceeding in response to the settlement entered into between the Parties.

Pursuant to 35 U.S.C. § 317(b), filed concurrently herewith as Exhibit 1025 is a true copy of the settlement agreement between the Parties. This agreement was made in connection with, or in contemplation of, the termination of Petitioner's participation in the above-captioned proceeding. EX1025 at 3. The Parties certify that there are no additional collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. Accordingly, the Parties have complied with the requirements of 35 U.S.C. § 317 and 37 C.F.R. § 42.74, and it is appropriate for the Board to terminate the above-captioned proceeding.

C. Status of Related Matters

Related to the present proceedings are the following litigations:

- True Return Systems, LLC v. MakerDAO, Case No. 1:22-cv-08478-VSB (SDNY), filed October 5, 2022; and
- True Return Systems, LLC v. Compound Protocol, Case No. 1:22-cv-08483-JGLC (SDNY), filed October 5, 2022.

As indicated in Exhibit 1026 and Exhibit 1027, Notices of Voluntary Dismissal have been filed in each of these proceedings.

Aside from the proceedings identified above, the parties are unaware of any other pending related proceedings regarding the involved patent before the Board, or any other matter before the USPTO (or any other tribunal) that would be affected by the requested termination of this proceeding.

IV. Conclusion

The Parties respectfully request that the Board grant the parties' Joint Motion to terminate the above-captioned *inter partes* review. The Parties also request that the Board grant the joint request to treat the settlement agreement between the Parties as business confidential information and keep it separate from the file of these proceedings and the file of the '797 Patent.

Respectfully submitted:

August 22, 2024
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CERTIFICATE OF SERVICE

I certify that the foregoing **JOINT MOTION TO TERMINATE THE PROCEEDING PURSUANT TO 37 C.F.R. §§ 42.71 and 42.74 AND ACCOMPANYING EXHIBITS** were served August 22, 2024 by email, as previously consented to by Patent Owner, to:

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