

Paper No. \_\_\_\_  
Date: April 25, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CSC SERVICEWORKS, INC.,  
Petitioners,

v.

PAYRANGE INC.,  
Patent Owner.

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Case No. IPR2023-01449  
Patent 11,481,772

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**JOINT MOTION TO TERMINATE INTER PARTES REVIEW**

Pursuant to 35 U.S.C. §317 and 37 C.F.R §42.74, and as authorized by the Board in its e-mail dated April 25, 2024, Petitioner CSC ServiceWorks, Inc. (“Petitioner”) and Patent Owner PayRange Inc. (“Patent Owner”) jointly move for termination of this proceeding due to settlement.

## **I. CERTIFICATION**

Petitioner and Patent Owner submit with this motion a confidential version of a true copy of the agreement or understanding (EX1015) between Petitioner and Patent Owner made in connection with, or in contemplation of, the termination of this proceeding under 35 U.S.C. §317(b) and 37 CFR §42.74(b). The parties certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

## **II. STATUS OF RELATED PROCEEDINGS**

Petitioners and Patent Owner have resolved their disputes regarding the ’772 patent, including the District Court proceeding between the parties regarding this patent and do not anticipate further litigation between them concerning this patent. The Parties also state that they are not aware of any other pending proceeding regarding this patent.

## **III. RELIEF REQUESTED**

As authorized by the Board, the parties are jointly and contemporaneously filing: (i) this joint motion to terminate the proceeding; (ii) a true copy of the agreement or understanding (EX1015) between Petitioner and Patent Owner made

in connection with, or in contemplation of, the requested termination; and (iii) a joint request to treat the agreement (EX1015) as business confidential information and keep the agreement separate from the file of the involved patent, pursuant to 35 U.S.C. §317(b) and 37 C.F.R. §42.74(c).

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety. Termination is appropriate at this stage and in view of a settlement between Petitioner and Patent Owner. *See* 35 U.S.C. §317(a); *see also*, *e.g.*, *Pfizer, Inc. v. Novo Nordisk A/S*, IPR2020-00324, Paper 80 (2021); *Clio USA, Inc. v. The Procter & Gamble Co.*, IPR2013-00438, Paper 57 (2014). Good cause exists to terminate this proceeding because (1) Petitioner and Patent Owner have resolved their disputes regarding the '772 patent; (2) this proceeding is still at an early stage because the Board just recently instituted this proceeding, Patent Owner has not filed its Patent Owner Response, Petitioner has not filed its Reply, Patent Owner has not filed its Sur-Reply, no oral argument has been held, and the Board has not yet reached a Final Written Decision on the merits of this proceeding; and (3) terminating the proceeding now would thus serve the interests of preservation of Board resources as well as the mutual interest of the parties.

Respectfully submitted,

Date: April 25, 2024

/Jason R. Mudd/

Jason R. Mudd (Reg. 57,700)

Lead Counsel for Petitioner

Date: April 25, 2024

Matthew A. Argenti/

Matthew A. Argenti (Reg. No. 61,836)

Lead Counsel for Patent Owner

### **CERTIFICATE OF COMPLIANCE**

This paper complies with the page limitation of 15 pages, excluding the parts exempted by 37 C.F.R. §42.24. This paper complies with the general format requirements of 37 C.F.R. §42.6 and has been prepared using Microsoft® Word in 14-point Times New Roman.

Respectfully submitted,

Date: April 25, 2024

/Jason R. Mudd/

Jason R. Mudd (Reg. No. 57,700)

Lead Counsel for Petitioner

### **CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing JOINT MOTION TO TERMINATE INTER PARTES REVIEW and Confidential Exhibit 1015 were served on April 25, 2024, on Patent Owner at the electronic correspondence addresses of Patent Owner's counsel as follows:

Matthew A. Argenti  
Jad A. Mills  
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Respectfully submitted,

Date: April 25, 2024

/Jason R. Mudd/  
Jason R. Mudd (Reg. No. 57,700)  
Attorney for Petitioner

**PETITIONER’S UPDATED EXHIBIT LIST**

| <b>EXHIBIT NO.</b> | <b>DESCRIPTION</b>                                                                                 |
|--------------------|----------------------------------------------------------------------------------------------------|
| Ex. 1001           | U.S. Patent No. 11,481,772                                                                         |
| Ex. 1002           | Prosecution History of U.S. Patent No. 11,481,772                                                  |
| Ex. 1003           | Declaration of Dr. Clifford Neuman                                                                 |
| Ex. 1004           | U.S. Patent No. 7,458,510 to Zhou                                                                  |
| Ex. 1005           | U.S. Patent Pub. No. 2003/0130902 to Athwal                                                        |
| Ex. 1006           | U.S. Patent No. 10,210,501 to Low et al.                                                           |
| Ex. 1007           | U.S. Patent No. 9,898,884 to Arora et al.                                                          |
| Ex. 1008           | U.S. Patent No. 8,255,323 to Casey et al.                                                          |
| Ex. 1009           | U.S. Patent No. 8,958,846 to Freeny                                                                |
| Ex. 1010           | U.S. Patent App. Pub. No. 2010/0082485 to Lin                                                      |
| Ex. 1011           | Curriculum Vitae of Dr. Clifford Neuman                                                            |
| Ex. 1012           | Redacted Version of Patent Owner’s Preliminary Response                                            |
| Ex. 1013           | Declaration of Chris Maxie In Support of Petitioner’s Reply to Patent Owner’s Preliminary Response |
| Ex. 1014           | Redacted Version of Patent Owner’s Preliminary Sur-Reply                                           |
| Ex. 1015           | Confidential Settlement Agreement                                                                  |