UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOME DEPOT USA, INC. AND
HOME DEPOT SOLUTIONS LLC
Petitioner,

v.

INNOVAPORT, LLC
Patent Owner

IPR2024-00096
Patent 8,775,260

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,775,260 UNDER 37 C.F.R. § 42.72

INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(a) Petitioner Home Depot USA, Inc. and Home Depot Solutions LLC and Patent Owner Innovaport, LLC jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,775,260 (the "'260 Patent") in IPR2024-00096. On March 13, 2024, the Parties informed the Board of a settlement agreement between Petitioner and Patent Owner via email and requested authorization to file a Joint Motion to Terminate the proceeding with respect to both the Patent Owner and Petitioner. As set forth in an email dated March 13, 2024, the Board authorized the filing of the requested Joint Motion to Terminate. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

ARGUMENT

A joint motion to terminate generally must "(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

A. Brief Explanation as to Why Termination Is Appropriate

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The Parties are concurrently filing a copy of the settlement agreement as Exhibit 1030 along with a request to treat it as business confidential information pursuant to 35 U.S.C. § 317(b). Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1030 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1030 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The Parties "may terminate the proceeding…unless the Board has already decided the merits of the proceeding." Consolidated Office Patent Trial Practice Guide, at 4 (November 2019). This proceeding is still in its early stages and Patent Owner has yet to file its Patent Owner Preliminary Response. The Parties have now settled their dispute and have reached agreement to terminate the Petition.

Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *Delta Air Lines, Inc. v.*

August, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). The Board's Trial Practice Guide stresses that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Office Patent Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

The '260 Patent is subject to the following actions:

- *Innovaport LLC v. IKEA North America Services, LLC et al.*, No. 2:21-cv-00789 (E.D. Wis. filed June 25, 2021)—case is still pending.
- *Innovaport LLC v. Target Corporation*, No. 3:22-cv-00425 (W.D. Wis. filed Aug. 4, 2022)—judgment entered in favor of Defendant Target Corporation dismissing the case on February 7, 2024.

- *Innovaport LLC v. Best Buy Co., Inc.*, No. 3:23-cv-00016 (W.D. Wis. filed Jan. 6, 2023)—Stipulation of Dismissal filed December 22, 2023.

- *Innovaport LLC v. Home Depot U.S.A., Inc., et al.*, No. 3:23-cv-00225 (W.D. Wis. filed Apr. 11, 2023)—Stipulation of Dismissal to be filed concurrently with this motion.

- *Innovaport LLC v. Walmart Inc.*, No. 3:23-cv-00498 (W.D. Wis. filed July 21, 2023)—case is still pending.

C. Identification and Status of Related Proceedings Before the USPTO

Petitioner has not filed any further Petition for *Inter Partes* Review related to the ’260 Patent. Patent Owner’s preliminary response in IPR2024-00096 is due on March 18, 2024.

Respectfully submitted,

Dated: March 14, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this **JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 8,775,260 UNDER 37 C.F.R. § 42.72** in connection with IPR2024-00096 to be served via e-mail on March 14, 2024, in its entirety on the following counsel of record for Patent Owner:

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