UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NATIONAL BEEF PACKING COMPANY, LLC,
Petitioner

v.

INSTITUTE FOR ENVIRONMENTAL HEALTH, INC.,
Patent Owner

Case No. IPR2024-00186
Patent No. 9,637,771

JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner National Beef Packing Company, LLC ("National Beef" or "Petitioner") and Patent Owner Institute for Environmental Health, Inc. ("IEH" or "Patent Owner") hereby provide notice that they have reached a settlement that resolves all underlying disputes between National Beef and IEH with respect to U.S. Patent Nos. 7,534,584 ("the '584 Patent"); 8,822,143 ("the '143 Patent"); 9,637,771 ("the '771 Patent"); and 9,845,486 ("the '486 Patent"), including *inter partes* reviews, IPR2024-00183, IPR2024-00185, IPR2024-00186, and IPR2024-01156, (collectively "IPRs"), all of which are pending before the Patent Trial and Appeal Board ("PTAB") of the U.S. Patent and Trademark Office, and *Inst. for Envtl. Health, Inc. v. Nat'l Beef Packing Co., LLC*, No. 1:23-cv-00826 (D. Del.). The Parties therefore jointly request termination of all four IPRs.

I. BACKGROUND

On August 1, 2023, IEH sued National Beef for infringement of the above-listed four patents in the following pending litigation: *Inst. for Envtl. Health, Inc. v. Nat'l Beef Packing Co., LLC*, No. 1:23-cv-00826 (D. Del. Aug. 1, 2023). On February 6, 2025, that district court stayed the case for two months.

National Beef filed a petition (Paper 1) in all four IPRs in July 2024. *Inter partes* review was instituted on January 13, 2025 in all four IPRs. *See, e.g.*, IPR2024-00183, Paper 8. Oral argument is currently scheduled for October 16, 2025. *See id.*, Paper 9. The final written decisions in the four IPRs are due in about 11 months.

The parties signed a settlement agreement by February 19, 2025 that requires the termination of all four IPRs. While the litigation remains pending, the parties plan to pursue dismissal of the litigation pursuant to their settlement agreement.

II. 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." 37 C.F.R. § 42.72 similarly provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. § 317(a)." The Trial Practice Guide also observes that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding" and that the 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." 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

The settlement puts the above-listed IPRs in the same posture as every other case in which the parties reach a settlement and seek termination before a final written decision. The Board has terminated countless cases in such posture and should do so here for each above-listed IPR. *See, e.g.*, *Toyota Motor Corp. v. Blitzsafe Tex. LLC*, IPR2016-00421, Paper 28, at 2-3 (Feb. 21, 2017) (granting motion to terminate even after all substantive papers were filed, "particularly in light of the fact that a final written decision is not due until more than four months from now"); *Plaid Techs., Inc. v. Yodlee, Inc.*, IPR2016-00273, Paper 29, at 2 (Feb. 8, 2017) (granting motion to terminate because "[t]he parties' joint motions to terminate were filed prior to the oral hearings in these cases"); *Apex Med. Corp. v. Resmed Ltd.*, IPR2013-00512, Paper 39, at 2 (Sept. 12, 2014) (granting joint motion to terminate after submission of the petitioner's reply because "the record is not yet closed, and the Board has not yet decided the merits of this proceeding"); *Volusion, Inc. v. Versata Software, Inc., et al.*, CBM2013-00018, Paper 52, at 2-3 (June 17, 2014) (granting motion to terminate after oral argument).

III. TERMINATION IS APPROPRIATE

Termination is proper under 35 U.S.C. § 317(a) because the parties have settled their dispute regarding each of the above-listed IPRs and are jointly requesting termination. Also, the petitioner will no longer participate in the above-listed IPRs and no petitioner will remain after termination with respect to National

Beef. For at least these reasons, termination of the IPRs is proper under 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74. Accordingly, termination of the instant IPRs is appropriate under PTAB precedent and would save the Board significant administrative and judicial resources in conducting an oral argument and issuing a final written decision to decide the patentability issues in these cases.

IV. AGREEMENT IN WRITING SUBMITTED TO THE BOARD

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties' Settlement Agreement is being submitted as Exhibit 1065 in IPR2024-00183, IPR2024-00185, and IPR2024-00186 and Exhibit 1036 in IPR2024-01156. The Settlement Agreement is in writing and constitutes the Parties' entire understanding and agreement. The Parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the above-listed IPRs. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in a separate paper filed concurrently herewith, the Parties jointly request that the Settlement Agreement be treated as business confidential information and be kept separate from the underlying patent files.

V. CONCLUSION

For at least the foregoing reasons, the parties respectfully request that the Board promptly grant this motion and terminate IPR2024-00183, IPR2024-00185, IPR2024-00186, and IPR2024-01156.

Dated: March 3, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on March 3, 2025, copies of the foregoing JOINT MOTION TO TERMINATE and all documents filed with it were served via electronic mail, as agreed to by counsel, upon the following counsel for the Petitioner:

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