

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NESPRESSO USA, INC.,
Petitioner,

v.

K-FEE SYSTEM GMBH,
Patent Owner

Case: IPR2024-00304

U.S. Patent No. 11,465,830

**JOINT NOTICE OF SUBMISSION OF AGREEMENT IN SUPPORT OF
JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S.
PATENT NO. 11,465,830 UNDER 37 C.F.R. § 42.72**

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioner and Patent Owner hereby submit the confidential Settlement Agreement as defined by the confidential binding term sheet, filed in this action as Ex. 1077.

Concurrently, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties are filing a Joint Motion to Keep Confidential and Separate (Motion to Keep Confidential) the confidential Settlement Agreement.

The undersigned represent that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding.

The undersigned further represent that Ex. 1078 is a true and accurate copy of the confidential Settlement Agreement between the parties resolving the present proceeding.

On May 19, 2025, the parties informed the Board of the settlement via e-mail and requested authorization to file the Joint Motion and Motion to Keep Confidential. In an email dated May 20, 2025, the Board authorized the filing of this Joint Motion to Terminate and the Motion to Keep Confidential and on June 10, 2025, the Board requested that we file the final fully executed Settlement Agreement.

Per 35 U.S.C. § 317(a), “An *inter partes* review instituted under this chapter

Case IPR2024-00304
Patent No. 11,465,830
Joint Notice of Submission of Agreement

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.” Likewise, 37 C.F.R. § 42.74 states, “The Board may terminate a trial without rendering a final written decision, where appropriate, including ... pursuant to a joint request under 35 U.S.C. 317(a)”. “There are strong public policy reasons to favor settlement between the parties to a proceeding... 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.” Patent Trial and Appeal Board Consolidate Trial Practice Guide, November 2019, page 86.

The Board has not rendered a final decision deciding the merits of this proceeding.

There are no other pending USPTO proceedings regarding the U.S. Patent No. 11,465,830.

In view of the foregoing, Petitioner and Patent Owner respectfully submit the Settlement Agreement and request termination of the *Inter Partes* Review of U.S. Patent No. 11,465,830 with prejudice.

Case IPR2024-00304
Patent No. 11,465,830
Joint Notice of Submission of Agreement

Dated: June 11, 2025

By:/B. Clayton McCraw/

B. Clayton McCraw
Registration No. 68,258
MAYER BROWN LLP
1221 Avenue of the Americas
New York, NY 10020-1001
Telephone: (212) 506-2649
CMcCraw@mayerbrown.com

Amanda Streff Bonner
Registration No. 65,224
Erick Palmer
Registration No. 64,456
MAYER BROWN LLP
71 S. Wacker Drive
Chicago, IL 60606
Telephone: 312-701-8645
Facsimile: 312-701-7711
ASBonner@mayerbrown.com
EJPalmer@mayerbrown.com

Counsel for Petitioner

Respectfully submitted,

By:/Douglas Carsten/

Douglas Carsten (Reg. No. 43,534)
MCDERMOTT WILL & EMERY LLP
18565 Jamboree Road
Suite 250
Irvine, CA 92612-2565
Phone: (949) 620-6111
Fax: (949) 666-9834
dcarsten@mwe.com

Michael P. Chu (Reg. No. 37,112)
MCDERMOTT WILL & EMERY LLP
444 West Lake Street
Suite 4000
Chicago, IL 60606-0029
Phone: (312) 984-5485
Fax: (312) 277-2848
mchu@mwe.com

Ian B. Brooks (Reg. No. 66,709)
MCDERMOTT WILL & EMERY LLP
The McDermott Building
500 North Capitol Street NW
Washington, DC 20001
Phone: (202) 756-8075
Fax: (202) 591-2827
ibrooks@mwe.com

Case IPR2024-00304
Patent No. 11,465,830
Joint Notice of Submission of Agreement

S. Benjamin Pleune (Reg. No. 52,421)
ALSTON & BIRD LLP
101 South Tryon Street
Suite 4000
Charlotte, NC 28280-4000
Phone: (704) 444-1098
Fax: (704) 444-1698
ben.pleune@alston.com

Eric M. Dobrusin (Reg. No. 33,867)
Paul J. Palinski (Reg. No. 71,080)
THE DOBRUSIN LAW FIRM P.C.
29 W. Lawrence St., Suite 210
Pontiac, MI 48342
Telephone: (248) 292-2920
Facsimile: (248) 292-2910
EDobrusin@PatentCo.com
PPalinski@PatentCo.com
EPatmail@PatentCo.com

Counsel for Patent Owner