UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILOODA CO., LTD. and JEISYS MEDICAL INC.,
Petitioners

v.

SERENDIA, LLC,
Patent Owner

U.S. PATENT NO. 9,775,774

Case No. IPR2024-00383

JOINT MOTION TO TERMINATE ILOODA'S PARTICIPATION IN THE PROCEEDING AND JOINT REQUEST TO KEEP THE SETTLEMENT AGREEMENT SEPARATE AND CONFIDENTIAL AND ACCESSIBLE ONLY TO THE BOARD, ILOODA, AND SERENDIA

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization by email dated April 3, 2024, Petitioner Ilooda Co., Ltd. ("Ilooda") and Patent Owner Serendia, LLC ("Serendia") jointly move to terminate the present *inter partes* review proceeding with respect to Ilooda in light of the settlement of their dispute regarding U.S. Patent No. 9,775,774 ("the '774 patent"); and jointly request to keep the copy of the settlement agreement filed along with this paper (Confidential Exhibit 1026) separate and confidential and accessible only to the Board, Ilooda, and Serendia.

The parties have filed a true and complete copy of the settlement agreement along with this paper, as required by 35 U.S.C. § 317(b). *See* Confidential Exhibit 1026. The moving parties certify that there are no other agreements or understandings between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding with respect to Ilooda.

I. PROCEDURAL BACKGROUND

The Petition in this proceeding was filed on January 9, 2024 by Petitioners Ilooda and Jeisys. The Patent Owner's preliminary response is due on April 23, 2024. *See* Paper No. 4. The Board has not yet issued a decision on institution.

On February 28, 2024, Ilooda and Serendia entered into a settlement agreement that resolves the dispute between Petitioner Ilooda and non-party Cutera,

Inc. ("Cutera") and Patent Owner Serendia regarding the '774 patent. *See* Confidential Exhibit 1026. On April 1, 2024, Ilooda, Cutera, and Serendia filed a joint motion to terminate the ITC investigation (*Certain Dermatological Treatment Devices and Components Thereof*, Inv. No. 337-TA-1356) as to Respondents Ilooda and Cutera based on settlement and requested the Administrative Law Judge limit service of the settlement agreement to Serendia, Ilooda, and the Commission Investigative Staff. The motion has not been granted yet.

The parties contacted the Board on April 3, 2024 by email, to request authorization to file a joint motion to terminate and joint request to keep the copy of the settlement agreement filed as Confidential Exhibit 1026 separate and confidential and accessible only to the Board, Ilooda, and Serendia. The Board authorized these filings in a responsive email on April 3, 2024.

The parties note that Petitioner Jeisys is not a party to the settlement agreement. Therefore, the parties are not requesting termination of the proceeding as to Jeisys. Additionally, the settlement agreement is being filed as "Only to Board" so that Jeisys does not have access to it.

II. GOOD CAUSE EXISTS TO TERMINATE THE ABOVE-CAPTIONED IPR AS TO PETITIONER ILOODA

First, Petitioner Ilooda and Patent Owner Serendia jointly request that this *inter partes* review be terminated with respect to Ilooda, in light of the settlement of

their dispute regarding the ’774 patent.

Under 35 U.S.C. § 317(a), “[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.” Additionally, as the Board has explained:

> 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. 35 U.S.C. §§ 317(a), 327.

Consolidated Trial Practice Guide (November 2019), page 86 § II.N.

Termination of the present *inter partes* review with respect to Ilooda is appropriate because the moving parties have settled their entire dispute regarding the ’774 patent and the Office has not yet decided the merits of the proceeding. Other factors weigh in favor of terminating this IPR proceeding as to Ilooda. First, the above-captioned petition is in its early phase, and the Board has not yet made a decision regarding institution of the petition, and no decisions on the merits of the proceeding have been made. Dismissal of the proceedings at this early stage promotes the Congressional goal to establish a more efficient and streamlined patent system that limits unnecessary and counterproductive litigation costs. *See* 37 C.F.R. § 42.1(b).

The Board regularly grants motions to terminate under similar circumstances. *See, e.g. RPC Formatec GMBH v. Trudell Medical Int'l*, Case Nos. IPR2014-01040, IPR2014-01127, Paper 10 (Oct. 24, 2014) (granting joint motion to terminate); *Samsung Electronics Co., Ltd. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7 (PTAB, Aug. 3, 2021) (same); *Huawei Technologies Co., Ltd. v. Verizon Patent and Licensing Inc.*, IPR2021-00616, -00617, Paper 9 (PTAB, Sept. 9, 2021) (same).

Further, termination of the proceeding as to Ilooda is a just and fair resolution. Ilooda and Serendia agree that neither Ilooda and Serendia will be prejudiced by the termination. Moreover, the remaining Petitioner, Jeisys, has confirmed that it does not object to the termination of this proceeding as to Ilooda. Finally, Ilooda and Serendia will benefit from preserving resources that would otherwise be expended if this motion is denied.

Therefore, Petitioner Ilooda and Patent Owner Serendia respectfully submit this *inter partes* review should be terminated with respect to Ilooda.

III. JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION

Petitioner Ilooda and Patent Owner Serendia jointly request that the settlement agreement filed as Confidential Exhibit 1026 (a) be treated as business confidential information; (b) be kept separate from the file of the involved patent; (c) be accessible only to the Board, Ilooda, and Serendia, and not accessible to

Petitioner Jeisys; and (d) be made available only as permitted pursuant to the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

35 U.S.C. § 317(b) provides that:

> At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause

Likewise, 37 C.F.R. § 42.74(c) provides that:

> A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:
> (1) To a Government agency on written request to the Board; or
> (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

The present request, which is being filed along with the Settlement Agreement, is timely and in accordance with the foregoing authority. Petitioner Jeisys does not oppose this request.

Therefore, Petitioner Ilooda and Patent Owner Serendia respectfully submit that this request for confidential treatment should be granted.

Date: April 9, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Joint Motion to Terminate Ilooda's Participation in the Proceeding and Joint Request to Treat Settlement Agreement as Business Confidential Information was served, together with Confidential Exhibit 1026, by electronic mail on the following counsel of record for Patent Owner:

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Additionally, the foregoing Joint Motion was served (without the confidential exhibit), by electronic mail on the following counsel of record for Petitioner Jeisys Medical Inc.:

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Date: April 9, 2024

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