UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRANSCORE, LP,
Petitioner,

v.

HAND HELD PRODUCTS, INC.,
Patent Owner.

Case No. IPR2024-00391
Patent No. 8,141,784

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 37 C.F.R. § 42.71(a) and 35 U.S.C. § 317(a), Petitioner Transcore, LP ("Petitioner") and Patent Owner Hand Held Products, Inc. ("Patent Owner") (collectively, the "parties") jointly request termination of this *inter partes* review of U.S. Patent No. 8,141,784 ("the '784 patent"). The parties request the Board grant this Motion because the parties' dispute regarding the '784 patent has been resolved.

The parties notified the Patent and Trial Appeal Board of the parties' settlement on July 1, 2024 and received authorization to file this Motion to Terminate on the same day. In support of this Motion to Terminate, the parties state as follows:

The parties have reached a confidential settlement agreement that resolves all disputes between the parties relating to the '784 patent. Accordingly, the parties agree to terminate the proceedings in IPR2024-00391.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner and Patent Owner have filed herewith a true and correct copy of the confidential settlement agreement between Petitioner and Patent Owner as Exhibit 2001. The settlement agreement is the sole and entire agreement between the parties in connection with, or in contemplation of, terminating this proceeding. There are no collateral agreements, such as other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Because

the settlement agreement is confidential, the parties respectfully request (and concurrently file herewith a request) that it be treated as business confidential information, be kept separate from the underlying patent file, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties concurrently are filing a Joint Request to Treat the Agreement as Business Confidential pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Petitioner and Patent Owner thus respectfully request that the Board grant the parties' Joint Motion to Terminate this IPR proceeding (IPR2024-000391) in its entirety and grant the concurrently filed parties' joint request to treat the settlement agreement between the parties as business confidential information.

Terminating this IPR proceeding would be consistent with the public policy of encouraging settlement in litigation. *See e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986); *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986); Consolidated Trial Practice Guide ("CTPG") at 86 (Nov. 2019). Moreover, terminating this IPR proceeding is appropriate given the Board has not yet "decided the merits of the proceeding." CTPG at 86. In particular, Petitioner filed its petition for *inter partes* review on January 9, 2024. Patent Owner submitted its preliminary response on April 18, 2024, and the parties exchanged further preliminary briefing on May 8, 2024 and May 15, 2024. The Board has not yet issued an institution

decision on this IPR proceeding. Given the parties have now settled their dispute and have reached agreement to terminate this proceeding, the Board can conserve its resources, and those of the parties, by terminating the proceeding now.

Petitioner and Patent Owner are available at the Board's convenience to discuss these issues in more detail or answer any additional questions raised by this joint motion.

Respectfully submitted,

Dated: July 3, 2024

/Joseph E. Palys/
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Dated: July 3, 2024

/Dara M. Kurlancheek/
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CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel for Petitioner a true and correct copy of the foregoing Joint Motion to Terminate by electronic means on the date below at the following address of record:

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Respectfully submitted,

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