IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARM LIMITED,
Petitioner,

v.

ICPILLAR LLC,
Patent Owner.

Case No. IPR2024-00476

U.S. Patent No. 8,924,899

JOINT MOTION TO TERMINATE PROCEEDING

PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R § 42.72

Petitioner's Exhibit List

Exhibit #	*Description*
1001	U.S. Patent No. 8,924,899 ("the '899 patent")
1002	Prosecution History for U.S. Patent No. 8,924,899 (downloaded from PAIR)
1003	Declaration of Dr. Henry Houh.
1004	U.S. Patent No. 5,870,588 ("Rompaey")
1005	U.S. Pat. Appl. No. 2008/0222581 ("Banerjee")
1006	*CoWare-a design environment for heterogeneous hardware/software systems*, K. Van Rompaey, D. Verkest, I. Bolsens and H. De Man, Proceedings EURO-DAC '96, Geneva, Switzerland, pp. 252-257 (1996).
1007	*CoWare—A design environment for heterogeneous hardware/software systems,* Verkest, D., Van Rompaey, K., Bolsens, I. et al. Des Autom Embed Syst 1, 357–386 (1996).
1008	ICPillar Preliminary Infringement Contentions, '899 Patent.
1009	U.S Pat. No. 5,197,016 ("Sugimoto")
1010	U.S. Patent No. 4,922,432 ("Kobayashi")
1011	Fletcher, William I., An Engineering Approach to Digital Design, Prentice-Hall, Inc., pp. 491-505 (1984) (excerpts)
1012	ICPillar Opening Claim Construction Brief
1013	Arm Opening Claim Construction Brief.
1014	Complaint in *ICPillar v. ARM Ltd. et al,* 1:23-cv-282 (WDTX)
1015	Scheduling Order in *ICPillar v. ARM Ltd. et al,* 1:23-cv-282 (WDTX)

Exhibit #	***Description***
1016	Pacer Docket in *Sable Networks, Inc. et al v. Cloudflare, Inc.*, case 6:21-cv-00261, WDTX.
1017	Pacer Docket in *Demaray LLC v. Samsung Electronics Co., Ltd.*, case 6:20-cv-00636, WDTX.
1018	[this exhibit intentionally blank]
1019	[this exhibit intentionally blank]
1020	*Sotera* Stipulation
1021	Settlement Agreement – Confidential

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, and the Board's authorization provided on November 12, 2024, Petitioner Arm Limited ("Arm" or "Petitioner") and Patent Owner Icpillar LLC ("Icpillar" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached a settlement agreement and jointly request termination of the *inter partes* review of U.S. Patent No. 8,924,899 ("the '899 Patent"), Case No. IPR2024-00476, with the United States Patent and Trademark Office.

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the Parties relating to the '899 Patent. In March 2023, Patent Owner filed suit in district court against Petitioner asserting patent infringement based on *inter alia* the '899 Patent. *ICPillar LLC. v. ARM Ltd, et. al*., Case No. 1:23-cv-00282 (WDTX) (the "Litigation"). (filed March 14, 2023). On October 11, 2024, the Parties entered into a Settlement Agreement. The Settlement Agreement requires the termination of this proceeding, IPR2024-00476. An *inter partes* review 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 proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, "no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy

of the petitioner." *See id*. No other petitioners remain in this *inter partes* review, and no Final Written Decision on the merits has been entered. For at least these reasons, termination of the *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a).

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).

III. 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 1021. 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 this *inter partes* review. 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 file.

IV. Conclusion

Termination of the proceeding is a just and fair resolution. The Parties agree that neither Arm nor Icpillar will be prejudiced by the termination of this proceeding. Finally, the Parties will benefit from preserving resources that would otherwise be expended if this motion is denied. For at least the foregoing reasons, the Parties respectfully request that the Board terminate *Inter Partes* Review IPR2024-00476.

Dated: November 12, 2024

Respectfully submitted,

/Kevin P. Anderson/

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CERTIFICATE OF SERVICE

The undersigned certifies that on November 12, 2024, a complete and entire copy of this Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C.§ 317 and 37 C.F.R § 42.72 was served by filing this document through the P-TACTS System as well as delivering a copy via electronic mail upon the following:

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