

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JACS Solutions, Inc.,
Petitioner

v.

Global Tel*Link Corporation,
Patent Owner.

IPR2024-00484
U.S. Patent No. 9,030,292

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner JACS Solutions, Inc. and Patent Owner Global Tel*Link Corporation (collectively, “Parties”) jointly move for an order terminating the *inter partes* review filed January 25, 2024, directed to Patent No. 9,030,292 (“the ’292 Patent”) and assigned case number IPR2024-00484. The Board authorized the instant motion by e-mail on March 15, 2024.

The case has not progressed past the initial filing of the petition. The Office has entered a notice of filing.

The Parties have settled their dispute and have reached agreement to terminate this proceeding. A true and correct copy of the Parties’ written, executed Settlement Agreement is attached as Exhibit 1019.

The Parties request, under separately filed joint motion, that the Settlement Agreement be maintained as business confidential under 37 C.F.R. § 42.74(c).

1. Termination is Appropriate

Termination is proper because the Parties are jointly requesting termination, the review is still in its early stages, and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” As noted in the Patent Office Trial Practice Guidelines, “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.” The Parties have executed the

Settlement Agreement made in connection with the termination of this petition for *inter partes* review. Exhibit 1019. Accordingly, termination is appropriate here.

The Parties understand that if the Board terminates this petition for *inter partes* review, no estoppel under 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d)(1) will attach to Petitioners. The Parties understand that if the Board terminates this petition for *inter partes* review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

2. Status of Related District Court Litigation

The '292 Patent is the subject of pending litigation *Global Tel*Link Corporation v. JACS Solutions, Inc.*, No. 23-500 (D. Del.). On February 14, 2024, the Parties jointly filed to dismiss with prejudice. The district court ordered dismissal with prejudice on February 15, 2024. There are no other pending proceedings between the Parties relating to the '292 Patent.

For these reasons the Parties jointly request termination of IPR2024-00484.

Date: March 25, 2024

Respectfully submitted,

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Date: March 25, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(1), the undersigned certifies that, on March 25, 2024, a copy of the Joint Motion to Terminate Proceeding and accompanying Exhibit 1019 were served via email on counsel for Patent Owner as follows:

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