

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner,

v.

ISIX IP LLC,
Patent Owner.

IPR2024-00615
U.S. Patent No. 6,308,178

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Pursuant to the Board’s authorization email dated January 13, 2025, Petitioner SAP America, Inc. and Patent Owner Isix IP LLC jointly move under 35 U.S.C. § 317(a) to terminate IPR2024-00615 with respect to Petitioner and without adverse judgment and without a final written decision. Such relief is appropriate because the Board has authorized the filing of this motion, the parties agree to this outcome, institution was only recently granted on September 26, 2024 (Paper 19), no final written decision has yet issued, and the parties have not conducted any post-institution activities such as depositions or briefing.

I. BACKGROUND AND STATUS OF RELATED PROCEEDINGS

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014). Each of these issues is discussed below in turn.

(1) Brief Explanation

The parties have reached an agreement to terminate this IPR proceeding because the parties have resolved their dispute relating to U.S. Patent No. 6,308,178 (“178 Patent”). Specifically, Petitioner and Patent Owner have entered into a settlement

agreement (“the Settlement Agreement”). Pursuant to 37 C.F.R. § 42.74(b), Petitioner has filed herewith a true copy of the confidential settlement agreement. Ex. 1017.

There are no collateral 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 are filing concurrently herewith a request that the settlement agreement be treated as business confidential information, be kept separate from the underlying patent files, and be made available only as provided in 37 C.F.R. § 42.74(c).

(2) Related Litigation

The '178 Patent is the subject of the following lawsuit (the “Lawsuit”) where Petitioner is a party:

Isix IP LLC v. SAP America, Inc., 2:23-cv-00237-JRG-RSP (E.D. Tex.).

Per the Settlement Agreement, the parties filed a joint stipulation to dismiss the Lawsuit. An order dismissing the lawsuit issued on January 10, 2025.

(3) Related Proceedings Before the Office

There are no related proceedings currently before the Office.

(4) Status of Related Litigation and Proceedings Before the Office

Pursuant to a settlement agreement, the parties agreed to file a joint motion to terminate Petitioner’s IPR related to the '178 Patent. Further, the Lawsuit has been dismissed.

II. STATEMENT OF RELIEF REQUESTED

Due to the resolution of the parties' dispute relating to the '178 Patent that is the subject of this IPR proceeding, the parties jointly request termination of IPR2024-00615 with respect to Petitioner and in total under 35 U.S.C. § 317(a). The requested relief is appropriate for at least the following three reasons.

First, the parties have met the statutory requirement that they file a joint request to terminate before the Office has decided the merits of the proceeding. 35 U.S.C. § 317(a). Under § 317(a), 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 proceeding before the request for termination is filed." The Office has not decided the merits of this IPR proceeding, and there are no other preconditions of § 317(a).

Second, as noted above, with termination, the parties have resolved their disputes relating to the '178 Patent. See Exhibit 1017.

Third, this IPR proceeding is in its early stages (Patent Owner has not yet filed its Response, Petitioner has not yet filed its Reply, no expert depositions have taken place) and the parties have no other pending requests for relief.

Accordingly, good cause exists to terminate this proceeding.

III. CONCLUSION

For these reasons, the parties respectfully request termination of this IPR.

Dated: January 14, 2025

Respectfully submitted,

/Jeffri A. Kaminski /

Jeffri A. Kaminski
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Registration No. 42,709

/Cabrach J. Connor /

Cabrach J. Connor
Lead Counsel for Patent Owner
Registration No. 53,837

Exhibit List

Ex. 1017	Settlement Agreement
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.71(a), the undersigned certifies that on January 14, 2025, a complete and entire copy of this “JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317(a)” was made on all counsel of record by electronic mail (by agreement of the parties) and by filing this document through the Patent Trial and Appeal Board’s P-TACTS System.

/Jeffri A. Kaminski /

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Lead Counsel for Petitioner

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