Filed: July 12, 2024

On behalf of **Cala Health, Inc.**
By: Joshua J. Stowell
Brian C. Barnes
KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 Main Street, 14th Floor
Irvine, CA 92614
Tel.: 949-760-0404
Fax: 949-760-9502
Email: BoxCalaHealth300@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CALA HEALTH, INC.,
Petitioner,

v.

EMKINETICS INC.,
Patent Owner.

IPR2024-00743
U.S. Patent 11,628,300

AUTHORIZED JOINT MOTION TO DISMISS THE PETITION U.S. PATENT 11,628,300

Petitioner Cala Health, Inc. ("Petitioner") and Patent Owner EMKinetics Inc. ("Patent Owner") jointly move to dismiss the *inter partes* review of claims 1-17 of U.S. Patent No. 11,628,300 ("the '300 patent," Ex. 1001), IPR2024-00743, and terminate these proceedings prior to determination as to whether to institute trial.

The Board authorized the Parties to file this motion on July 11, 2024. Under 37 C.F.R. § 42.72, "[t]he Board may terminate a trial without rendering a final written decision, where appropriate." Additionally, pursuant to 37 C.F.R. §§ 42.5 and 42.71(a), the Board has authority to "take up petitions or motions for decisions in any order" and to "grant, deny, or dismiss any petition or motion" or enter any appropriate order. *See also Samsung Elecs. Co., Ltd., et al v. Nvidia Corp.*, IPR2015-01270, Paper 11 (P.T.A.B. Dec. 9, 2015).

The Board should exercise its discretion to dismiss the Petition and terminate this IPR for several reasons. First, the parties have entered into a confidential settlement agreement ("Settlement Agreement") that will resolve the parties' instant dispute regarding the validity of the '300 patent. The Board's authorization email stated this motion "should include a copy of the parties' settlement agreement." However, the parties have not submitted the confidential Settlement Agreement herewith, and jointly request that the Board grant this motion without requiring such submission, because no trial has been instituted in

the present IPR and, therefore, the submission of the Settlement Agreement is not required. *Samsung Elecs. Co. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7 (PTAB Aug. 3, 2021); *see also* Patent Trial and Appeal Board Rules of Practice for Briefing Discretionary Denial Issues, and Rules for 325(d) Considerations, Instituting Parallel and Serial Petitions, and Termination Due to Settlement Agreement, 81 F.R. 28693 (proposed April 19, 2024) (noting, with respect to 35 U.S.C. 135(e), 317(b), and 327(b), that "by their own terms these statutory provisions do not expressly govern AIA pre-institution settlement").

Second, this proceeding is still in its preliminary stages. A Petition for *inter partes* review was filed on March 29, 2024 (Paper No. 1). The deadline for Patent Owner to file a Preliminary Response has not passed and the Board has not yet issued its institution decision. Terminating the proceedings at this early stage would preserve both the Board's and parties' resources. The Board has found that the early stage of the proceeding and the preservation of Board and party resources weights in favor of dismissal in similar circumstances. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 at 2-4 (P.T.A.B. Dec. 9, 2015) (granting motion to dismiss IPR proceedings prior to institution decision); *Regeneron Pharms., Inc. v. Novartis Pharm. AG,* IPR2020-01318, Paper 17 at 3 (P.T.A.B. Dec. 7, 2020) (granting unopposed motion to terminate IPR before institution decision).

Accordingly, the parties respectfully request that the Board grant this Motion to dismiss the Petition and terminate IPR2024-00743.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 12, 2024

By: */Joshua J. Stowell/*
Joshua J. Stowell (Reg. No. 64,096)
Brian C. Barnes (Reg. No. 75,805)

Attorneys for Petitioner,
CALA HEALTH, INC.

LAW OFFICES OF DAVID A. GERASIMOW, P.C.

Dated: July 12, 2024

By: */David Gerasimow/*
David Gerasimow (Reg. No. 57,512)
Eran Steinberg (Reg. No. 53,637)

Attorneys for Patent Owner,
EMKINETICS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **AUTHORIZED JOINT MOTION TO DISMISS THE PETITION** is being served on July 12, 2024, via FedEx Priority Overnight service on counsel for Patent Owner EMKinetics Inc. of U.S. Patent No. 11,628,300.

David Gerasimow, Reg. No. 57,512
The Law Offices of David A. Gerasimow, P.C.
211 W. Wacker Dr., Ste. 1717
Chicago, IL 60606
Telephone: 312-919-4254
Email: dave@gerasimowlaw.com

Eran Steinberg, Reg. No. 53,637
137 Granville Way
San Francisco, CA 94127
Telephone: 415-902-7026
Email: venture@eransteinberg.com

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: July 12, 2024

By: */Joshua J. Stowell/*
Joshua J. Stowell (Reg. No. 64,096)
Brian C. Barnes (Reg. No. 75,805)
Customer No. 20,995

Attorneys for Petitioner,
CALA HEALTH, INC.