

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HL Klemove Corporation,  
Petitioner

v.

Foras Technologies Ltd.,  
Patent Owner

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Case IPR2024-00813  
U.S. Patent 7,502,958

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**JOINT MOTION TO TERMINATE PROCEEDINGS**

### TABLE OF EXHIBITS

| Exhibit  | Description                                                                                                                              |
|----------|------------------------------------------------------------------------------------------------------------------------------------------|
| Ex. 1001 | U.S. Patent No. 7,502,958 to Michaelis et al. (“the ’958 Patent”)                                                                        |
| Ex. 1002 | Declaration of Dr. Michael C. Brogioli                                                                                                   |
| Ex. 1003 | Curriculum Vitae of Dr. Michael C. Brogioli                                                                                              |
| Ex. 1004 | Prosecution History of the ’958 Patent                                                                                                   |
| Ex. 1005 | U.S. Patent Application Publication No. US 2003/0126498A1 to Bigbee et al., filed January 2, 2002, published July 3, 2003 (“Bigbee”)     |
| Ex. 1006 | U.S. Patent Application Publication No. US 2004/0123201 A1 to Nguyen et al., filed December 19, 2002, published June 24, 2004 (“Nguyen”) |
| Ex. 1007 | Reserved                                                                                                                                 |
| Ex. 1008 | U.S. Patent No. 7,085,959 B2 to Safford, filed July 3, 2002, published August 1, 2006 (“Safford”)                                        |
| Ex. 1009 | U.S. Patent No. 7,296,181 B2 to Safford, filed April 6, 2004, published November 13, 2007 (“Safford-181”)                                |
| Ex. 1010 | U.S. Patent Application Publication No. US 2002/0144177 A1 to Kondo et al., filed January 31, 2002, published October 3, 2002 (“Kondo”)  |
| Ex. 1011 | U.S. Patent No. 6,516,429 B1 to Bossen, filed November 4, 1999, published February 4, 2003 (“Bossen”)                                    |
| Ex. 1012 | U.S. Patent No. 6,158,015 to Klein, filed March 30, 1998, published December 5, 2000 (“Klein”)                                           |

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| Ex. 1013 | U.S. Patent Application Publication No. US 2005/017216 A1 to Fox et al., filed January 21, 2004, published August 4, 2005 (“Fox”)            |
| Ex. 1014 | U.S. Patent No. 7,404,105 B2 to Arai, filed August 16, 2004, published July 22, 2008 (“Arai”)                                                |
| Ex. 1015 | U.S. Patent No. 6,675,324 B2 to Marisetty et al., filed September 27, 1999, published January 6, 2004 (“Marisetty”)                          |
| Ex. 1016 | U.S. Patent Application Publication No. US 2003/0074601 A1 to Schultz et al., filed September 28, 2001, published April 17, 2003 (“Schultz”) |
| Ex. 1017 | U.S. Patent Application Publication No. 2003/0126142 A1 to Tu et al., filed December 31, 2001, published July 3, 2003 (“Tu”)                 |
| Ex. 1018 | U.S. Patent No. 5,915,082 to Marshall et al., filed June 7, 1996, published June 22, 1999 (“Marshall”)                                       |
| Ex. 1019 | U.S. Patent No. 5,904,733 to Jayakumar, filed July 31, 1997, published May 18, 1999 (“Jayakumar”)                                            |
| Ex. 1020 | Reserved                                                                                                                                     |
| Ex. 1021 | Reserved                                                                                                                                     |
| Ex. 1022 | Advanced Configuration and Power Interface Specification, Revision 2.0, July 27, 2000 (“ACPI 2.0”)                                           |
| Ex. 1023 | Intel® Itanium® Architecture Software Developer’s Manual, Volume 2: System Architecture, Revision 2.1, October 2002                          |
| Ex. 1024 | Reserved                                                                                                                                     |
| Ex. 1025 | Prosecution History of U.S. Patent No. 7,356,733                                                                                             |

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| Ex. 1026 | Request for <i>Ex Parte</i> Reexamination of the '958 Patent, Control No. 90/019,245 (Sept. 1, 2023)                                               |
| Ex. 1027 | Office Action in Ex Parte Reexamination of the '958 Patent, Control No. 90/019,245 (Mar. 19, 2024)                                                 |
| Ex. 1028 | Foras Technologies Ltd.'s Answer, Affirmative Defenses, and Counterclaims, <i>HL Klemove Corp. v. Foras Techs. Ltd.</i> , E.D. Va. (Feb. 12, 2024) |
| Ex. 1029 | Joint Stipulation of Dismissal, <i>HL Klemove Corp. v. Foras Techs. Ltd.</i> , No. 2:23-cv-00647-EWH-RJK (E.D. Va.) (May 2, 2024)                  |
| Ex. 1030 | Joint Motion to Dismiss, <i>Foras Techs. Ltd. v. Denso Corp. et al.</i> , No. 2:23-cv-00150-JRG (E.D. Tex.)                                        |

## **I. PRECISE RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317(a), Petitioner HL Klemove Corporation (“HL Klemove”) and Patent Foras Technologies Ltd. (“Foras”) (collectively, “the Parties”) agree and jointly request that the instant *inter partes* review proceeding (IPR2024-00813) involving U.S. Patent No. 7,502,958 (“the ’958 patent”) be terminated. The Parties further request that HL Klemove’s Motion for Joinder filed April 19, 2024 be withdrawn.

## **II. BACKGROUND**

On April 19, 2024, HL Klemove filed a Petition for *Inter Partes* Review in the instant proceeding. Paper 2. HL Klemove concurrently filed a Motion for Joinder Under 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22 and 42.122(b), requesting to join the instant proceeding with IPR2023-01373, *BMW of N. Am., LLC et al. v. Foras Techs. Ltd.* Paper 3. The Board has not ruled on HL Klemove’s Motion for Joinder.

On May 2, 2024, pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(ii), all claims and counterclaims asserted by the Parties against each other and relating to the ’958 patent were dismissed via a joint stipulation filed in the United States District Court for the Eastern District of Virginia. *HL Klemove Corp. v. Foras Techs. Ltd.*, No. 2:23-cv-00647-EWH-RJK (E.D. Va.), Dkt. 26. A true copy of the Parties’ Joint Stipulation of Dismissal has been filed as Exhibit 1029. Similarly, Foras and HL Klemove’s customers (*i.e.*, Kia Corp. and Kia America Inc.) have

stipulated to dismissal of all claims for relief against each other and relating to the '958 patent. *Foras Techs. Ltd. v. Denso Corp. et al.*, No. 2:23-cv-00150-JRG (E.D. Tex.), Dkt. 64. A true copy of the stipulation between Foras and the Kia entities has been filed as Exhibit 1030. The Parties certify that there are no other agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding. This Joint Motion was authorized by the Board pursuant to e-mail correspondence on June 4, 2024.

All other *inter partes* review proceedings that relate to the '958 patent are listed below, and are not affected by this motion.

- IPR2023-01373, *BMW of N. Am., LLC et al. v. Foras Techs. Ltd.*
- IPR2024-00823, *Valeo SE et al. v. Foras Techs. Ltd.*
- IPR2024-00727, *ZF Friedrichshafen AG et al. v. Foras Techs. Ltd.*

### **III. REASONS FOR GRANTING THE MOTION**

A petitioner and a patent owner may terminate an instituted proceeding with respect to the petitioner by filing a written agreement with the Board, unless the Board has already decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). Furthermore, pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). Indeed, “[t]here are strong public policy reasons to favor

settlement between the parties to a proceeding” and “[t]he 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.” PTAB Consolidated Trial Practice Guide at 86 (November 2019) (“Practice Guide”).

In the instant proceeding, no patent owner preliminary response or patent owner response has been filed, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. Moreover, the Board has not ruled on HL Klemove’s Motion for Joinder. No other motions are outstanding in this proceeding. No other proceedings related to the ’958 patent will be affected by this motion. Accordingly, no other party’s rights will be prejudiced by the termination of this proceeding. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings.

For the foregoing reasons, the Parties respectfully request that that the Board grant the Parties’ Joint Motion to Terminate Proceedings.

Dated: June 5, 2024

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Respectfully Submitted,

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