

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOYMILES USA, INC.,

Petitioner,

v.

CYBOENERGY, INC.,

Patent Owner.

CASE: IPR2024-01106

U.S. PATENT NO. 8,786,133

JOINT MOTION TO TERMINATE PROCEEDING

Pursuant to 37 C.F.R. § 42.74, and the authorization provided in the Board's email of October 23, 2024, Petitioner Hoymiles USA, Inc. and Patent Owner CyboEnergy, Inc., by and through their respective counsel of record, jointly request termination of this proceeding, IPR2024-01106, directed to U.S. Patent No. 8,786,133 ("the '133 Patent").

Petitioner and Patent Owner have settled their dispute regarding the '133 Patent, including this proceeding and Patent Owner's assertion of the '133 Patent in the related district court litigation against Petitioner: *CyboEnergy, Inc. v. Hoymiles USA, Inc.*, No. 2:23-cv-00311 (E.D. Tex.). That case is currently pending and was stayed by joint motion of the parties on October 1, 2024. The parties do not anticipate further litigation between them concerning the '133 Patent.

Good cause exists to terminate this proceeding because the parties have settled their dispute regarding the '133 Patent, and the proceeding is still ongoing with significant work still to be done, including the Board's Institution Decision and, to the extent that Institution is granted, the Patent Owner's Reply, possible motions to exclude, preparation for and participation in the oral argument, and the Board's preparation of the Final Written Decision. Terminating the proceeding now would thus serve the interests of judicial economy and the mutual interest of the parties.

A true and correct copy of the parties' settlement agreement will be filed as Exhibit 1011, along with a Joint Motion to Treat the Settlement Agreement as

Business Confidential Information. Pursuant to 35 U.S.C. § 317(b), the parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceedings beyond the settlement agreement in Exhibit 1011.

Date: October 23, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on October 23, 2024, a true and correct copy of this Joint Motion to Terminate Proceeding was served on the following counsel for Patent Owner by electronic mail:

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