UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HARTMANN US INC. and THE HAPPY GROUP INC.,

Petitioners

v.

MAURICE J.P. TABONE,

Patent Owner

IPR2024-01216
U.S. Patent No. 11,225,365

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.71(a) and 42.72, Petitioners Hartmann US Inc., Brødrene Hartmann A/S, and The Happy Group Inc. (collectively, the "Petitioners") and Patent Owner Maurice J. P. Tabone ("Tabone") (collectively, the "Parties") jointly request termination of this *inter partes* review (IPR) of U.S. Patent 11,225,365 ("the '365 patent"). The Board has discretion to "grant, deny, or dismiss any petition or motion." 37 C.F.R. § 42.71(a). The Parties respectfully request that the Board grant this Motion because the Parties' dispute with respect to the '365 patent has been resolved.

Tabone asserted the '365 patent against Petitioners in *Maurice J.P. Tabone v. Hartmann US Inc., et al.*, 4:23cv-0986 (E.D. Mo. filed August 8, 2023) ("the co-pending litigation"). The Parties have reached a confidential Settlement Agreement (Ex.1040) that resolves all disputes between the parties relating to the '365 patent. Therefore, the Parties agree to terminate the IPR proceeding in IPR2024-01216.

On September 18, 2024, the Parties filed a Stipulation of Dismissal with Prejudice in the co-pending litigation to dismiss all claims with prejudice from the co-pending litigation. Ex.1041. On September 19, 2024, by a docket text order, the district court judge presiding over the co-pending litigation ordered that the co-pending litigation be dismissed with prejudice. Therefore, the Parties' dispute with respect to the '365 patent is fully resolved. The Settlement Agreement (Ex.1040)

is the sole and entire agreement between Petitioners and Tabone made in connection with, or in contemplation of, terminating the co-pending litigation and this IPR proceeding.

The undersigned certify that there are no other collateral agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the co-pending litigation and this IPR proceeding, and that Ex.1040 represents a true and accurate copy of the Settlement Agreement between the Parties.

On October 7, 2024, the Parties informed the Board of their agreement via email and requested authorization to file a joint motion to terminate the *inter partes* review with respect to both Parties. As set forth in an email dated October 7, 2024, the Board authorized the filing of the requested joint motion to terminate this IPR proceeding as to both Parties. Accordingly, the Parties jointly request termination of the present IPR proceeding.

Public policy favors terminating the present IPR proceeding. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g.*, *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit

places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between Parties). Further, the Board's Trial Practice Guide indicates that "[t]here are strong public policy reasons to favor settlement between the Parties to a proceeding." Consolidated Trial Practice Guide, at 86 (Nov. 2019).

Terminating this IPR promotes the congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012). Permitting termination as to all Parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation.

Additionally, termination of this IPR is appropriate as the Board has not yet "decided the merits of the proceeding." Consolidated Trial Practice Guide, at 86. Petitioners filed their IPR Petition on August 1, 2024. Tabone has not filed a Patent Owner's Preliminary Response, and the Board has not issued an institution decision for this IPR proceeding. The Parties have not submitted any further briefs in response to the Petition. The Parties have now settled their dispute and have reached agreement to terminate this IPR. The Board can conserve its resources

through terminating this IPR proceeding now, removing the need for the Board to render an institution decision or final written decision.

The Parties are concurrently filing a copy of the confidential Settlement Agreement as Ex.1040 along with a request to treat it as confidential business information pursuant to 35 U.S.C § 317(b) and 37 C.F.R. § 42.74(c).

Therefore, the Parties respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: October 14, 2024

/Eugene Goryunov/
Eugene Goryunov
Counsel for Petitioners
Registration No. 61,579

/Maurice J P Tabone/
Maurice Joseph Paul Tabone
Pro Se Patent Owner

PETITIONERS' UPDATED EXHIBIT LIST

October 14, 2024

Ex.1001	U.S. 11,225,365
Ex.1002	Prosecution History of U.S. Appl. 11,225,365
Ex.1003	Declaration of Thomas Dunn under 37 C.F.R. §1.68
Ex.1004	*Curriculum Vitae* of Thomas Dunn
Ex.1005	Prosecution History of U.S. Appl. 12/449,556
Ex.1006	WO 2008/098288
Ex.1007	AU 2007900654
Ex.1008	AU 2007902246
Ex.1009	U.S. 2005/0238764
Ex.1010	WO 2006/001696
Ex.1011	U.S. 1,254,276
Ex.1012	U.S. 3,854,581
Ex.1013	U.S. 3,951,292
Ex.1014	EP 1 558 504
Ex.1015	U.S. 4,625,906
Ex.1016	WO 2003/086905
Ex.1017	Complaint in *Maurice J.P. Tabone v. Hartmann US Inc., et al.*, 4:23-cv-0986 (E.D. Mo.) (Aug. 8, 2023)
Ex.1018	U.S. 10,287,070
Ex.1019	Prosecution History of U.S. 10,287,070
Ex.1020	FR 2 441 549
Ex.1021	U.S. 4,280,648
Ex.1022	Reserved
Ex.1023	Reserved
Ex.1024	Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)

Ex.1025	Patent Owner's Infringement Contentions for U.S. 11,225,365, served in *Maurice J.P. Tabone v. Hartmann US Inc., et al.*, 4:23-cv-0986 (E.D. Mo.)
Ex.1026	Reserved
Ex.1027	Reserved
Ex.1028	Reserved
Ex.1029	U.S. 3,285,491
Ex.1030	U.S. 3,298,594
Ex.1031	Definition of "unitary," American Heritage Dictionary (1985)
Ex.1032	Definition of "unitary," Merriam Webster Collegiate Dictionary (1995)
Ex.1033	U.S. 4,986,414
Ex.1034	U.S. 4,582,248
Ex.1035	U.S. 5,860,528
Ex.1036	"What Are the Dimensions of an Egg?," Dimensions of Stuff, *available at*: https://dimensionofstuff.com/what-are-the-dimensions-of-an-egg/ (last accessed June 25, 2024)
Ex.1037	Comparison of claims 1-10 and 28-30 of the '365 patent
Ex.1038	Comparison of claims 11-27 of the '365 patent
Ex.1039	U.S. 3,648,916
Ex.1040 **(NEW)**	Settlement Agreement
Ex.1041 **(NEW)**	Stipulation of Dismissal with Prejudice, *Maurice J.P. Tabone v. Hartmann US Inc., et al.*, 4:23-cv-0986, Dkt. 44 (E.D. Mo.) (Sept. 18, 2024)

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service	October 14, 2024
Manner of service	Electronic Service: mauricetabone@gmail.com
Documents served	**Joint Motion to Terminate *Inter Partes* Review; Joint Request to Treat Settlement Agreement as Business Confidential Information and Be Kept Separate; Exhibits 1040 and 1041**
Persons served	Maurice J. P. Tabone 33 Stockton Avenue Moorebank, NSW, 2170 Australia

/Eugene Goryunov/
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