

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ETN CAPITAL, LLC, d/b/a BEECH LANE,

Petitioner

v.

FBA OPERATING CO.,

Patent Owner

Case No. IPR2024-01445

US Patent No. 10,890,925

**JOINT MOTION TO TERMINATE INTER PARTES REVIEW
PROCEEDING PURSUANT TO 37 C.F.R. § 42.74 AND 37 C.F.R. §
42.72**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. §§ 42.74 and 42.72, and the Board’s authorization dated June 12, 2025, Petitioner ETN Capital, LLC and Patent Owner FBA Operating Co. (collectively, “the Parties”) hereby jointly move to terminate the *inter partes* review of U.S. Patent No. 10,890,925 (the ‘925 Patent), Case No. IPR2024-01445.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On June 6, 2025, the Parties executed a settlement agreement that resolves the dispute between them concerning the ‘925 Patent. In support of this motion, and as required by 37 C.F.R. § 42.74(b), the Parties are contemporaneously filing a true and correct copy of their written settlement agreement as attachment to this Motion. Termination of this proceeding is appropriate and consistent with the Board’s policy of encouraging settlement. See 37 C.F.R. § 42.5; Consolidated Trial Practice Guide (Nov. 2019), at 86. Additionally, the proceeding is still in its preliminary stage. Petitioner filed its request for *inter partes* review on September 16, 2024 (Paper 2). Patent Owner’s preliminary response was filed on December 30, 2024 (Paper 6), Petitioner’s reply was filed on January 31, 2025 (Paper 7), and Patent Owner’s sur-Reply was filed on February 7, 2025 (Paper 9). On February 28, 2025 (Paper 14), the Board issued an Order instituting the *inter partes* review.

Further, the Parties are jointly requesting termination because the parties have settled their larger dispute concerning the '925 Patent, including in the district court litigation between the parties. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation, and terminating this IPR furthers that purpose. *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.”).

The Parties’ confidential agreement is submitted concurrently herewith. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a Joint Request that the confidential agreement be treated as confidential business information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). A true and correct copy of the confidential agreement is submitted with that Request as Confidential Exhibit 2002.

Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Both Petitioners and Patent Owner support termination of the proceeding.

III. STATUS OF RELATED PROCEEDINGS

Petitioner and Patent Owner settled their dispute concerning the '925 Patent before the United States District Court for the Eastern District of North Carolina, *FBA Operating Co. V. ETN Capital, LLC d/b/a Beech Lane*, Case No. 5:23-cv-505-D-RN, and the United States Court of Appeals for the Federal Circuit, *FBA Operating Co. V. ETN Capital, LLC d/b/a Beech Lane*, Case No. 25-1402.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner respectfully request that the Board terminate this proceeding in its entirety.

Respectfully submitted,

Dated: June 20, 2025

/David Kalish/

David E. Bennett (Reg. No.: 32194)
David D. Kalish (Reg. No.: 42706)
COATS & BENNETT, PLLC
1400 Crescent Green, Suite 300
Cary, North Carolina 27518
Telephone: (919) 854-1844
Facsimile: (919) 719-4885
dbennett@coatsandbennett.com
dkalish@coatsandbennett.com

Attorneys for Petitioner

/Paul Fraulo/

Serge Krimnus (Reg. No. 66392)
Paul L. Fraulo (Reg. No. 72,121)
Thomas H. Stanton (Reg. No. 75,808)
BOCHNER PLLC
1040 Avenue of the Americas,
15th Floor
New York, NY 10018
Telephone: (646) 971-0685
serge@bochner.law
paul@bochner.law
tstanton@bochner.law

Attorneys for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) *et seq.* and 42.105(b), the undersigned hereby certifies that a true copy of the foregoing JOINT MOTION TO TERMINATE INTER PARTES REVIEW PROCEEDING PURSUANT TO 37 C.F.R. § 42.74 AND 37 C.F.R. § 42.72 was served in its entirety via electronic mail upon the Petitioner's attorneys of record:

David E. Bennett - dbennett@coatsandbennett.com

David D. Kalish - dkalish@coatsandbennett.com

Dated: June 20, 2025

/Paul Fraulo/

Serge Krimnus (Reg. No. 66392)

Paul L. Fraulo (Reg. No. 72,121)

Thomas H. Stanton (Reg. No. 75,808)

BOCHNER PLLC

1040 Avenue of the Americas,

15th Floor

New York, NY 10018

Telephone: (646) 971-0685

serge@bochner.law

paul@bochner.law

tstanton@bochner.law

Attorneys for Patent Owner