

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIBERTY MUTUAL INSURANCE COMPANY, LIBERTY MUTUAL
TECHNOLOGY GROUP, INC., LIBERTY MUTUAL HOLDING COMPANY
INC., LIBERTY MUTUAL GROUP INC., LIBERTY MUTUAL PLANO LLC,
COMPARION INSURANCE AGENCY, LLC, IRONSHORE HOLDINGS (U.S.)
INC.,

and

COMERICA INCORPORATED
Petitioners,

v.

INTELLECTUAL VENTURES I LLC
Patent Owner.

Case No. IPR2025-00201
U.S. Patent No. 7,949,785

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Petitioners Liberty Mutual Insurance Company, Liberty Mutual Technology Group, Inc., Liberty Mutual Holding Company Inc., Liberty Mutual Group Inc., Liberty Mutual Plano LLC, Comparion Insurance Agency, LLC, Ironshore Holdings (U.S.) Inc., and Comerica Incorporated (“Petitioners”) and Patent Owner Intellectual Ventures I LLC (“Patent Owner”) (collectively, “the Parties”) have resolved their dispute and jointly request termination of IPR2025-00201 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on January 28, 2025.

Patent Owner’s Exhibit List is appended as Appendix A to this document.

I. STATEMENT OF FACTS

The Parties have reached an agreement to resolve this *inter partes* review (IPR) proceeding. The Parties are filing the pertinent document resolving the proceeding concurrently with this joint motion, along with a “Joint Request That the Resolution Document Be Treated as Business Confidential and Be Kept Separate Under 35 U.S.C. § 317(b).”

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.”

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

(1) Brief Explanation

Termination is appropriate in this case because the Parties have resolved their dispute relating to U.S. Patent No. 7,949,785 (“the ‘785 Patent”). A “Joint Request That the Resolution Document Be Treated as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b)” is being filed concurrently with this motion. Additional details are provided below.

(2) Related Litigation

(a) The ‘785 Patent is subject to the following now-resolved lawsuits with Petitioners as parties:

(1) *Intellectual Ventures I LLC et al. v. Liberty Mutual Holding Company Inc., et al.*, No. 23-cv-525 (E.D. Tex. November 15, 2023);

(2) *Intellectual Ventures I LLC et al. v. Comerica Incorporated*, No. 23-cv-524 (E.D. Tex. November 15, 2023);

(3) *Intellectual Ventures I LLC et al. v. JP Morgan Chase Bank, National Association et al.*, No. 23-cv-523 (E.D. Tex. November 15, 2023)

These cases were consolidated, with Case No. 23-cv-523 as the lead case.

(b) The ‘785 Patent is subject to the following pending lawsuits, where Petitioners are *not* a party:

(1) *Intellectual Ventures I LLC et al., v. American Airlines, Inc.*, No. 24-cv-980 (E.D. Tex. November 2, 2024);

(2) *Intellectual Ventures I LLC et al., v. Southwest Airlines, Co.*, No. 24-cv-277 (W.D. Tex. November 2, 2024);

(3) *Assurant, Inc. v. Intellectual Ventures I LLC, et al.*, No. 24-cv-344 (D. Del. March 15, 2024).

(3) Related Proceedings Before the Office

In addition to IPR2025-00201, the Parties are aware of:

(1) *an ex parte* reexamination request filed by Unified Patents, LLC on May 22, 2024 (Control No. 90/019,519); and

(2) IPR2025-00786 filed by American Airlines, Inc. et al.

(4) Status of Related Litigation and Proceedings Before the Office

Pursuant to the Resolution Document (Ex. 2001 and Ex. 2002) the lawsuits listed above in Section I(2)(a) were dismissed on January 16, 2025.

The other lawsuits listed above in Section I(2)(b) are currently pending.

Ex parte reexamination of the ‘785 Patent was ordered on June 14, 2024 and a Non-Final Office Action was issued on October 8, 2024. Patent Owner filed a response to the Non-Final Office Action on January 8, 2025. On March 6, 2025, a “Notice of Intent to Issue a Reexam Certificate” was issued that confirmed claim 30 and 34. The remainder of the claims were not subject to reexamination.

IPR2025-00786 was filed on April 11, 2025 and has not been awarded a filing date.

II. STATEMENT OF RELIEF REQUESTED

Due to the resolution of the disputes between Patent Owner and Petitioners relating to the patent that is the subject of this IPR proceeding, the ‘785 Patent, the Parties jointly request termination of IPR2025-00201 under 35 U.S.C. § 317(a).

First, the Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under § 317(a), an *inter partes* review “shall” be terminated upon a joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of § 317(a).

Second, as noted, the Parties have resolved the disputes in this proceeding relating to the ‘785 Patent. A true copy of the document resolving the disputes related to the ‘785 Patent is filed concurrently herewith. See Exhibit 2001 and Exhibit 2002; 37 CFR § 42.74(b). The parties have requested that the resolution document be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c).

Third, this IPR proceeding is in its early stages, and a decision as to whether to institute the IPR has not yet been issued by the Board.

Finally, a termination of this proceeding will conserve the Board's resources and obviate the need for any more Board involvement in this matter.

Termination is appropriate at this stage and in view of the resolution of this dispute between Petitioners and Patent Owner. An *inter partes* review shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceedings before the request for termination is filed. 35 U.S.C. § 317(a). Accordingly, good cause exists to terminate this proceeding because (1) Petitioners and Patent Owner have resolved their disputes regarding the '785 Patent; (2) this proceeding is still at an early stage because the Office has not yet decided the merits of the proceeding; and (3) terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

III. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR of the '785 Patent.

Respectfully submitted,

Dated: April 18, 2025

By: /Brandon R. Theiss/
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Registration No. 70,507

Counsel for Patent Owner

Dated: April 18, 2025

By: / Joshua D. Curry/
Joshua D. Curry
Registration. No. 65,478
Counsel for Petitioner

APPENDIX A
PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Resolution Document (CONFIDENTIAL)
2002	Resolution Document (CONFIDENTIAL)

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **JOINT MOTION TO TERMINATE** was served via email (as consented to by counsel) on **April 18, 2025** to lead and backup counsel of record for Petitioner as follows:

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