

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEALS BOARD

EP FAMILY CORP.

Petitioner,

v.

OFFICE KICK, INC.

Patent Owner.

IPR2025-00497
Patent 11,910,926 B1

**PETITIONER EP FAMILY CORP. AND PATENT OWNER OFFICE KICK,
INC.'S JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317**

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LISTING OF EXHIBITS

Exhibit No.	Description
1018	May 28, 2025 Authorization to File Motion to Terminate
1019	Settlement Agreement

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, Petitioner EP Family Corp. (“Petitioner”) and Patent Owner Office Kick, Inc. (“Patent Owner”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate this proceeding (IPR2025-00497) in its entirety.

The parties notified the Board of the parties’ settlement on May 27, 2025, and received authorization to file this Motion to Terminate on May 28, 2025. *See Exhibit 1018.*

II. STATEMENT OF FACTS

In support of the Motion to Terminate Proceeding, Petitioner and Patent Owner state as follows: Petitioner initially filed its petition for *inter partes* review on January 23, 2025, and Patent Owner subsequently filed a preliminary response on April 28, 2025. Before the Board could decide whether or not to institute *inter partes* review, Petitioner and Patent Owner settled their dispute and all litigation relating to US Patent No. 11,910,926 (“’926 Patent”). The parties also agreed to move to terminate this *inter partes* review.

The parties’ Settlement Agreement has been made in writing, and a true and correct copy will be concurrently filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b) as **Exhibit 1019**. There are no other collateral agreements. Because the settlement agreement is confidential, Petitioner and Patent Owner respectfully request that it be treated as business confidential information, be kept separate from the underlying patent file, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c).

III. RELATED LITIGATION

As previously mentioned, the parties have reached an agreement to settle the federal litigation in *EP Family Corp. v. Office Kick, Inc.*, Case No. 2:24-cv-00667 AB (PVC), in the Central District of California.

IV. LEGAL STANDARD

The statutory provision on a settlement relating to *inter partes* reviews provides that 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 proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). This same statutory provision also provides that, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).

Notably, the Board “may terminate a trial without rendering a final written decision, where appropriate.” 37 C.F.R. § 42.72. The rules governing *inter partes* review proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Id.* § 42.1(b). In determining whether a termination request is “appropriate,” the Board primarily examines the stage and nature of the proceedings. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, Case IPR2015-01270, Paper 12 at 3 (PTAB Dec. 9, 2015). Proceedings that are in their preliminary proceeding stages—i.e., before the Board issues an institution decision—are well-suited for termination. *See id.* (granting opposed motion to terminate proceeding during the preliminary proceeding stage of underlying IPR proceeding); *HTC Corp. v. Patentmarks Commc’ns, LLC*, Case IPR2014-00905,

Paper 7 at 3 (PTAB Aug. 26, 2014) (granting unopposed motion to terminate noting that a “decision on the Petition . . . has not yet been rendered. Under these circumstances, we determine that it is appropriate . . . to terminate this proceeding without rendering a final written decision.”). Because IPR2025-00497 is in the preliminary proceeding phase, termination would be proper.

Further, the Board has clearly stated that there is an expectation that proceedings, such as IPR2025-00497, will be terminated after the filing of a settlement agreement. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (emphasis added); *Zimmer Biomet Holdings, Inc. v. Four Mile Bay, LLC*, No. IPR2018-00052, at *1 (P.T.A.B. July 9, 2018); *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter 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 proceeding before the request for termination is filed.”).

As it will be shown, the circumstances at hand more than conform to the regulations and underlying policy considerations promulgated by both the Board and 35 U.S.C. § 317(a).

V. ARGUMENT

The Board should grant the parties’ motion because 1) the Board has not yet decided the merits of the proceeding or whether or not to even institute *inter partes* review; and 2) terminating the proceeding would adhere to the underlying policy considerations of the Board to curb unnecessary and counterproductive litigation.

A. The Board Has Not Yet Decided on the Merits of the Proceeding

As a threshold matter, the Board has not yet decided the merits of the proceeding or whether or not to even institute *inter partes* review. No oral argument has occurred and no final decision on any of the merits of the Petition has been issued. Therefore, IPR2025-00497 is well suited for termination. *See HTC Corp. v. Patentmarks Commc'ns, LLC*, Case IPR2014-00905, Paper 7 at 3.

Additionally, in other proceedings, the Board has granted motions to terminate proceedings that were further along than the one at hand. For example, in *Petroleum Geo-Services Inc. v. WesternGeco LLC*, the Board terminated the proceeding in its entirety after oral argument had already been conducted, and after the parties requested permission to move to terminate five days before the statutory one-year deadline and filed their motion to terminate (as authorized by the Board) two days before the statutory deadline. *See Petroleum Geo-Services Inc. v. WesternGeco LLC*, IPR2016-00407, Paper 29 at 2, 3—4 (July 5, 2017) (granting termination of the entire proceeding even though “the Board was ready to issue a final written decision.”); *see also, e.g., Taiwan Semiconductor Mfg. Co. Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-01862, Paper 39 (Jan. 24, 2019) (granting termination of proceeding in view of settlement two months after oral argument); *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00018, Paper 52 at 2 (June 17, 2014) (granting full termination of proceeding after oral argument); *Lam Research Corp. v. Flamm*, IPR2015-01764, Paper 27 at 4, 6 (Dec. 15, 2016) (granting full termination of proceeding after oral argument despite “extremely advanced nature”

of proceeding, when “substantial resources—both on the part of the Board, as well as the parties—have been invested in this matter”).

Indeed, the Board has stated that there is an expectation that proceedings such as this will be terminated after the filing of a settlement agreement. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (emphasis added); *Zimmer Biomet Holdings, Inc. v. Four Mile Bay, LLC*, No. IPR2018-00052, at *1 (P.T.A.B. July 9, 2018); *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter 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 proceeding before the request for termination is filed.”) For at least the reasons discussed herein, the Board’s expectation that such proceedings should be terminated is proper and well justified in the case of IPR2025-00497.

B. Terminating the Proceeding Would Adhere to the Board’s Underlying Policy Considerations

Applying the Board’s expectation that these proceedings should be terminated promotes the Congressional goal of “establish[ing] a more efficient and streamlined patent system” that, *inter alia*, “limit[s] unnecessary and counterproductive litigation costs.” *See Changes to Implement Inter partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, Final Rule, 77 Fed. Reg. 48680, 48680 (Aug. 14, 2012). By permitting termination of review proceedings upon settlement of the disputes of all parties prior to a decision on the merits, the Patent Office provides a

measure of certainty as to the outcome of such proceedings – helping to promote settlements and creating a timely, cost-effective alternative to litigation. Conversely, should the Board decide to continue the present proceedings, the Congressional goal of speedy and less costly dispute resolutions and the Board’s stated goal of promoting settlement would be stymied (by, *inter alia*, giving patent owners less incentive to resolve disputes, and by adding to the burdens to both patent owners and the Office in addressing any subsequent appeals).

Based on the above, terminating IPR2025-00497 would further the policy considerations of *inter partes* review proceedings by justly and expeditiously resolving the dispute without subjecting the Board and the parties to unnecessary expense involving in taking IPR2025-00497 through trial. The parties will incur substantial expense in preparing and presenting expert declarants for depositions, submitting substantive briefs and motions, and presenting at an oral hearing. The Board will also likely have to expand a significant amount of resources if it declined to terminate IPR2025-00497 by being requested to address various procedural disputes, preside over an oral hearing, and draft a substantive decision on institution and a final written decision on the merits. The aforementioned resources and obligations can be spared by terminating IPR2025-00497 and advance the Board’s policy considerations.

VI. CONCLUSION

Petitioner and Patent Owner respectfully request that the Board grant the parties’ Joint Motion to terminate consideration of instituting *inter partes* review

for IPR2025-00497 and grant the request to treat the settlement agreement between the parties as business confidential information.

Petitioner and Patent Owner are available at the Board's convenience to discuss these related matters in more detail or answer any additional questions raised by the instant Motion.

Respectfully Submitted,

Dated: June 3, 2025

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CERTIFICATE OF COMPLIANCE

I hereby certify that this petition complies with the type-volume limitations of 37 C.F.R. §42.24 because it contains 1562 words (as determined by the Microsoft Word word-processing system used to prepare the petition), excluding the parts of the petition exempted by 37 C.F.R. §42.24.

Dated: June 3, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies pursuant to 37 C.F.R. §§ 42.6 that on June 5, 2025, a true and correct copy of the foregoing PETITIONER EP FAMILY CORP. AND PATENT OWNER OFFICE KICK, INC.'S JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317, [including all Exhibits], was electronically served on the Patent Owner's counsel of record at:

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