

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBALFOUNDRIES U.S., INC. and GLOBALFOUNDRIES, INC.,

Petitioners,

v.

OAK IP LLC,

Patent Owner.

Case No.: IPR2025-00889

U.S. Patent No. 10,090,395

JOINT MOTION TO TERMINATE PROCEEDINGS

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioners GLOBALFOUNDRIES U.S., INC. and GLOBALFOUNDRIES, INC. and Patent Owner OAK IP LLC jointly request that this *inter partes* review proceeding involving U.S. Patent No. 10,090,395 (“the ’395 patent”) be terminated based on a settlement between Petitioner and Patent Owner (“the Parties”) with respect to the ’395 patent and other patents owned by Patent Owner.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing of the instant motion on September 9, 2025. Guidance as to the content of a motion to terminate is provided in IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above

requirements and is accompanied by the Parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 35 C.F.R. § 42.74 (b).

a. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because the Board has not decided whether to institute this *inter partes* review proceeding, no patent owner response or further papers have been filed, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. Under 35 U.S.C. § 317(a), this proceeding “shall be terminated with respect to [] [P]etitioner” because the parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” Further, termination with respect to all parties is appropriate because the Parties have resolved all of their underlying disputes with respect to the '395 patent, including the related district court proceeding and co-pending IPRs.

b. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigations are/were related to the '395 patent:

Caption	Number	Court	Status
<i>Oak IP LLC v. GlobalFoundries Inc. et al.</i>	1:25-cv-00142	DDE	Dismissed

c. Related Proceedings Currently Before the Office

The same Parties are before the Board in connection with IPR2025-01052

and IPR2025-01129. Similar Motions to Terminate those proceedings are being filed concurrently herewith.

d. Current Status of Each Such Related Litigation of Proceeding With Respect to Each Party in the Litigation or Proceeding

Sections II.b and II.c above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding.

III. SETTLEMENT AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties' settlement agreement (Release Agreement dated August 20, 2025) is in writing, and a true and correct copy is being filed concurrently herewith as OAK Exhibit 2001.¹ There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of these proceedings. The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the settlement agreement, Ex. 2001, as business confidential information and keep them separate from the files of the '395 patent.

¹ The settlement agreement is being filed via the P-TACTS system with access to the "Parties and Board Only."

IV. CONCLUSION

For all these reasons, the Parties respectfully request termination of this proceeding.

Respectfully submitted,

Dated: September 10, 2025

/Scott C. Weidenfeller/
Scott C. Weidenfeller (Reg. No. 54,531)
Covington & Burling LLP,
One CityCenter
850 Tenth Street NW
Washington, DC 20001
sweidenfeller@cov.com

Attorneys for Petitioner

/Tarek N. Fahmi/
Tarek N. Fahmi (Reg. No. 41,402)
Ascenda Law Group, PC
2150 N First St., Suite 420
San Jose, CA 95131

tarek.fahmi@ascendalaw.com

Attorneys for Patent Owner

EXHIBIT LIST

Exhibit No.	Description
2001	Release Agreement dated August 20, 2025 (Parties & Board Only)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing
JOINT MOTION TO TERMINATE PROCEEDINGS

and its associated exhibits was served on 9/10/2025, by filing this document
through the PTAB P-TACTS System as well as by delivering a copy via
email directed to the attorneys of record for the Petitioner at the following
address:

Scott C. Weidenfeller
Anupam Sharma
Peter P. Chen

Covington & Burling LLP
One CityCenter, 850 Tenth Street
NW
Washington, DC 20001

Email:
sweidenfeller@cov.com
asharma@cov.com
pchen@cov.com
GF-Oak-IPR@cov.com

Respectfully submitted,

Dated: September 10, 2025

/Tarek N. Fahmi/

Tarek N. Fahmi

Reg. No. 41,402

Ascenda Law Group, PC
2150 N. First St., Suite 420
San Jose, CA 95131
Tel: 866-877-4883
Email: patents@ascendalaw.com