

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION,

Petitioner,

v.

BUNKER HILL TECHNOLOGIES, LLC

Patent Owner

IPR2026-00250

U.S. Patent No. 10,549,648

JOINT MOTION TO TERMINATE PROCEEDING

Toyota Motor Corporation (“Petitioner” or “Toyota”) and Bunker Hill Technologies, LLC (“Patent Owner”) (Petitioner and Patent Owner collectively referred to as the “Settling Parties”), have reached and executed a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.5(a), and the Board’s authorization via email on August 5, 2026 (EX3001), the Settling Parties jointly move to terminate the present *inter partes* review (“IPR”) proceeding as a result of the executed settlement between Patent Owner on the one hand and Petitioner on the other hand. There are no petitioners other than Toyota in the present IPR proceeding.

The Settling Parties are filing concurrently herewith a request that the settlement agreement between Patent Owner and Toyota (submitted as EX1013) be treated as business confidential information and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The settlement agreement is being filed as “Available Only to Parties and Board” to preserve the confidentiality of the agreement.

I. STATEMENT OF FACTS

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 (July 28, 2014).

Patent Owner filed a lawsuit against Toyota alleging infringement of, *inter alia*, U.S. Patent No. 10,549,648 (“the ’648 patent”) in the United States District Court for the Eastern District of Texas (*Bunker Hill Technologies, LLC v. Toyota Motor Corporation et al.*, Case No. 2:25-cv-01133). Toyota challenged the ’648 patent in the current IPR proceeding, which was instituted on July 14, 2026. *See* Paper 13.

The Settling Parties have reached and executed a final written agreement (the “Settlement Agreement”) to resolve their dispute. Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as EX1013. The Settlement Agreement is being filed electronically as “Available Only to Parties and Board.” A Joint Request to Treat Final Settlement Agreement of Patent Owner and Toyota as Business Confidential Information is being filed concurrently with this Joint Motion to Terminate Proceeding to treat the Settlement Agreement as business confidential information and keep it separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Settlement Agreement contains confidential information of the Settling Parties.

The parties in the parallel district court action filed a Joint Stipulation for Dismissal with Prejudice, which was granted by the court on August 3, 2026. *Bunker*

Hill Technologies, LLC v. Toyota Motor Corporation et al., Case No. 2:25-cv-01133, Dkt. 42 (E.D. Tex. Aug. 3, 2026). Patent Owner is unaware of any pending or threatened litigation, administrative proceeding, or other dispute involving U.S. the '648 patent, and neither party is aware of any such proceeding that is presently contemplated in the foreseeable future. Subject to the Settling Parties' Settlement Agreement, Patent Owner nevertheless reserves all rights and remedies afforded by the Patent Act, including those arising under 35 U.S.C. § 281, in the event that future acts of infringement are later discovered. This reservation reflects only the preservation of statutory rights and should not be construed as indicating that any future litigation or administrative proceeding is currently planned, anticipated, or contemplated.

II. TERMINATION IS APPROPRIATE

The Settling Parties request termination of this IPR proceeding and respectfully submit that such termination is justified. "There are strong public policy reasons to favor settlement between the parties to a proceeding." Trial Practice Guide § II.N. "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. § 317(a)). There are no other preconditions of 35 U.S.C. § 317(a). Under § 317(a), a decision on the merits is something beyond a decision instituting trial or a decision offering preliminary guidance.

The Board should terminate this proceeding in view of the Settling Parties' joint request for the following reasons.

First, the present motion is being submitted prior to Patent Owner's response to the Petition, Petitioner's reply, Patent Owner's sur-reply, oral argument, or a final written decision. Accordingly, the Settling 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).

Second, the Settling Parties have reached a settlement as to all disputes in this proceeding and as to the '648 patent. A true and correct copy of the Settlement Agreement is being filed concurrently herewith. No other such agreements or understandings, written or oral, exist between or among the Settling Parties relating to this proceeding. The Settling Parties thus satisfy the requirements of 35 U.S.C. § 317(b).

Third, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Trial Practice Guide § II.N. "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. § 317(a)). Termination would save further significant expenditure of resources by the Settling Parties and the Board. Termination upon settlement would also further the purpose of IPR proceedings, which seek to provide an efficient and less costly alternative

forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an IPR would continue regardless of settlement.

III. CONCLUSION

For the foregoing reasons, the Settling Parties respectfully request termination of this IPR proceeding.

Date: August 7, 2026

Respectfully submitted,

/John F. Presper/

John F. Presper
Counsel for Petitioner
Registration No. 53,483

/Tarek N. Fahmi/

Tarek N. Fahmi
Counsel for Patent Owner
Registration No. 41,402