

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NU MARK LLC,
Petitioner,

v.

FONTEM HOLDINGS 1 B.V.,
Patent Owner.

Case IPR2016-01303
Patent 8,365,742

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317**

IPR2016-01303

U.S. Patent No. 8,365,742

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Nu Mark LLC (“Nu Mark”) and Patent Owner Fontem Holdings 1 B.V. (“Patent Owner”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate the IPR2016-01303 proceeding.¹

On December 27, 2016, Patent Owner and Petitioner Nu Mark notified the Board that they reached a settlement agreement resolving all disputes between them involving the patent-at-issue in the IPR2016-01303 proceeding, and further requested guidance and permission to file a motion to terminate the IPR2016-01303 proceeding. There are no other agreements, oral or written, between Patent Owner and Petitioner Nu Mark made in connection with, or in contemplation of, the termination of the IPR2016-01303 proceeding. On December 29, 2016, the Board authorized Patent Owner and Petitioner Nu Mark to file a joint motion to terminate and a joint request to treat the settlement agreement as business confidential.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy (including counterparts) of the settlement agreement is filed herewith. Because the settlement agreement is confidential, Patent Owner and Petitioner Nu Mark respectfully request that it be treated as business confidential information and kept

¹ The Board has not yet issued a decision as to whether trial will be instituted; therefore, the IPR2016-01303 proceeding is still in its preliminary proceeding stage. 37 C.F.R. § 42.2.

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separate from the underlying patent file, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

As stated in 35 U.S.C. § 317(a), because Petitioner Nu Mark and Patent Owner are jointly requesting termination of the IPR2016-01303 proceeding, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner Nu Mark.

I. TERMINATION OF THE *INTER PARTES* REVIEW PROCEEDING IS APPROPRIATE

An *inter partes* review (IPR) “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). “If 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).” *Id.*

There is an expectation that an IPR will be terminated after the filing of a settlement agreement because “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding. . . .” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“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.”). The expectation of termination in connection with settlement is due to the adjudicatory nature of IPR proceedings, as contrasted with the examinational nature of the *inter partes* reex-

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amination proceedings they replaced. *See, e.g., Idle Free Systems Inc. v. Bergstrom Inc.*, IPR2012-00027, Paper 26 at 6 (June 11, 2013) (“An *inter partes* review is more adjudicatory than examinational, in nature.”); *Abbott Labs v. Cordis Corp.*, 710 F.3d 1318, 1326 (Fed. Cir. 2013) (“In 2011, Congress replaced *inter partes* reexamination with a new proceeding called *inter partes* review.... The purpose of this reform was to ‘convert[] *inter partes* reexamination from an examinational to an adjudicative proceeding,’”) (citations omitted).

Here, the IPR2016-01303 proceeding should be terminated in its entirety because of the strong public policy and expectation that IPRs will terminate upon settlement prior to a decision on the merits. The IPR2016-01303 proceeding is still in its preliminary stage as the Board has not yet issued a decision as to whether a trial will be instituted. As such, termination would save significant further expenditures of resources by the Board and the parties.

The IPR2016-01303 proceeding should also be terminated because the parties jointly request termination. Patent Owner and Petitioner Nu Mark have resolved the IPR2016-01303 proceeding and related litigation through settlement.

Termination of the IPR2016-01303 proceeding in view of settlement also provides a measure of certainty as to the outcome, promoting settlements and creating a timely, cost-effective alternative to litigation. And such termination is consistent with the adjudicatory nature of IPRs. Once termination is effected, there

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will be no counter-party in this proceeding and no need for an adjudicatory proceeding.

For at least those reasons discussed above, Patent Owner and Petitioner Nu Mark respectfully request that the Board terminate the IPR2016-01303 proceeding.

II. MATTERS RELATED TO THE *INTER PARTES* REVIEW PROCEEDING

The patent-at-issue in the IPR2016-01303 proceeding is the subject of several federal district court litigations. There are two other petitions for IPR of the patent-at-issue. *See* IPR2016-01268 and IPR2016-01532. The settlement agreement has resolved all disputes involving the patent-at-issue between Patent Owner and Petitioner Nu Mark.

A. Case No. 1:16-CV-01261 (M.D.N.C.) Relates to the *Inter Partes* Review Proceeding

Patent Owner filed two patent infringement suits against Petitioner Nu Mark in the United States District Court for the Central District of California (*Fontem Ventures BV et al. v. Nu Mark LLC*, Case No. 2:16-cv-02291 and *Fontem Ventures BV et al. v. Nu Mark LLC*, Case No. 2:16-cv-04537). Those cases were transferred to the Middle District of North Carolina (*Fontem Ventures BV et al. v. Nu Mark LLC*, Case No. 1:16-cv-01261 and *Fontem Ventures BV et al. v. Nu Mark LLC*, Case No. 1:16-cv-01259, respectively). In Case No. 1:16-cv-01261, Patent Owner accused Petitioner Nu Mark of infringing the patent-at-issue in addition to seven

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