

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EVERNOTE CORPORATION, Petitioner,

v.

TALSK RESEARCH.,
Patent Owner

Case IPR2017-01154
Patent 7,178,097

JOINT MOTION TO TERMINATE

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.74, and the Board's authorization provided on January 9, 2018, Petitioner Evernote Corporation ("Petitioner") and Patent Owner TALSK RESEARCH, INC. ("Patent Owner") (collectively the "Parties") jointly request termination of Inter Partes Review No. IPR2017-01154 pursuant to settlement. As there are no other petitioners in this proceeding and the proceeding is still at an early stage, the Parties respectfully submit that termination of this proceeding is appropriate.

STATEMENT OF FACTS

Petitioner filed its petition in this proceeding for Inter Partes Review of U.S. Patent No. 7,178,097 (the "'097 Patent") on March 24, 2017. No other petitions related to the '097 Patent are pending. The IPR was instituted on September 28, 2017. The deadline for Patent Owner to file a Patent Owner Response in this proceeding is currently January 12, 2018. Petitioner and Patent Owner have reached a Settlement Agreement to end their disputes in this proceeding and the underlying litigation. Pursuant to 35 U.S.C. § 317(b) and 37 CFR § 42.74(b), the agreement between the Parties is in writing, constitutes the entire understanding and agreement between the Parties, and a copy of the Settlement Agreement is submitted herewith as Confidential Exhibit 1023.

The Parties jointly request that the settlement agreement filed as Exhibit 1023 be treated as business confidential information and kept separate from the

underlying patent file, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to maintain confidentiality of the settlement agreement.

ARGUMENT

I. GOOD CAUSE EXISTS TO TERMINATE THE ABOVE-CAPTIONED IPR

The Parties have resolved their disputes with regard to the '097 Patent. The Parties' agreement with regard to the '097 Patent is memorialized in the document filed concurrently herewith as Confidential Exhibit 1023. Termination of this proceeding is proper because the IPR is in its early stages. The Board has not "decided the merits of the proceeding before the request for termination is filed." *See* 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 ("The Board expects that a proceeding will terminate after filing of a settlement agreement, unless the Board has already decided the merits of the proceeding."). Though this IPR has been instituted, the Patent Owner has not yet filed its Patent Owner Response, Petitioner has not yet filed its Reply, and the Board has not yet decided the merits of the proceeding at the time this motion for termination is filed. The Parties submit that termination of this proceeding will preserve the Board's resources and obviate the need for any more Board involvement in this matter. Lastly, dismissal of the Petition and termination of the above-captioned IPR is a just and fair resolution.

II. IDENTITY AND STATUS OF PARTIES IN RELATED LITIGATION INVOLVING THE PATENT

This '097 Patent was the subject of the following litigation in the Northern District of California: *Talsk Research, Inc. v. Evernote Corporation*, No. 3:17-cv-05576 (N.D. Cal.). This case was dismissed on January 8, 2018.

III. IDENTITY AND STATUS OF ANY RELATED PROCEEDINGS BEFORE THE OFFICE

The Parties are not aware of any other proceedings related to the '097 Patent.

CONCLUSION

For at least the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this Inter Partes Review.

Respectfully submitted by:

Dated: January 10, 2018

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