

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BANK OF AMERICA, N.A.
Petitioner,

v.

NANT HOLDINGS IP, LLC,
Patent Owner.

IPR2021-01080
Patent 8,463,030 B2

Before JAMESON LEE, THOMAS L. GIANNETTI, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

TERMINATION
Settlement After Institution of Trial
37 C.F.R. § 42.74

I. BACKGROUND

Bank of America, N.A. (“Petitioner”) filed a Corrected Petition requesting *inter partes* review of claims 1–4, 6, 7, 19, 21, 25, 26, 29–32, 36, and 37 of U.S. Patent No. 8,463,030 B2 (Ex. 1001, “the ’030 patent”). Paper 9. Nant Holdings IP, LLC (“Patent Owner”) filed a Preliminary Response. Paper 10.

The Board determined that Petitioner established a reasonable likelihood that it would prevail with respect to at least one challenged claim, and instituted *inter partes* review as to all of the challenged claims of the ’030 patent and all of the asserted grounds of unpatentability stated in the Petition. Paper 14.

II. DISCUSSION

After institution, with Board authorization, Petitioner and Patent Owner filed a “Joint Motion to Terminate *Inter Partes* Review Proceeding” (Paper 21, “Joint Motion to Terminate”). The parties represent that Patent Owner has agreed to (a) dismiss all allegations of infringement relating to the ’030 patent with prejudice, and (b) execute a covenant not to sue relating to the ’030 patent. Paper 21, 1. Further, the parties state that Petitioner has agreed to dismiss its counterclaims relating to the ’030 patent with prejudice in the pending district court action involving the ’030 patent and to submit a joint motion to terminate this *inter partes* review proceeding. *Id.* The parties certify that they have complied fully with 37 C.F.R. § 42.74(b) by filing the agreement, reflected in Exhibit 1046 (a stipulated motion to dismiss filed with the district court) with the Board, which agreement reflects final settlement and resolution of all disputes relating to the ’030 patent between the parties, and that there are no other collateral

agreements or understandings made in connection with, or in contemplation of, the termination sought. *Id.* at 3.¹

The parties represent that the district court action involving the '030 patent has been dismissed and the parties contemplate no litigation or proceeding involving the challenged patent in the foreseeable future. *Id.*

This trial is at an early stage. Patent Owner has not filed a response. At this early stage, we determine that termination is warranted for the reasons stated in the Joint Motion to Terminate.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the parties' Joint Motion to Terminate is *granted* and this case is *terminated*.

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¹ Only the first page of the Joint Motion to Terminate is numbered.