

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

V.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner

IPR2022-00603
Patent No. 10,804,740

**PETITIONER AND PATENT OWNER'S JOINT MOTION TO
TERMINATE PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Google LLC (“Petitioner”) and Patent Owner Scramoge Technology Ltd. (“Patent Owner”) (collectively, “the Parties”) jointly request termination of this proceeding. The Parties have entered into a written confidential settlement agreement that settles all disputes between them, including those relating to this proceeding and the related district court actions, *Scramoge Technology Ltd. v. Google LLC*, No. 6:21-cv-00616 (W.D. Tex.) and *Scramoge Technology Ltd. v. Google LLC*, No. 6:21-cv-01138 (W.D. Tex.), which were dismissed with prejudice on August 24, 2022. Pursuant to 37 C.F.R. § 42.74, a true copy of the Parties’ settlement agreement (including any other related agreement between the Parties) has been filed as Exhibit 1017. This Joint Motion was authorized by the Board pursuant to e-mail correspondence on August 31, 2022.

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018). “There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . 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.” PTAB Consolidated Trial Practice Guide at 86 (November 2019).

The Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a) (emphasis added); 77 Fed. Reg. 48768 (“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.”). Indeed, the Board has not yet made a decision on institution of this inter partes review. Petitioner filed its petition for inter partes review on February 14, 2022. No motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this inter partes review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (And 35 U.S.C. 317(a) provides “An inter partes review instituted under this chapter 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.”)

As required by statute and as directed by the Board, the parties are filing concurrently herewith, as a separate submission, a Joint Request to Treat Settlement Agreement as Business Confidential and to Keep Separate, pursuant to 35 U.S.C. § 317(b), along with the true copy of the written settlement agreement, which includes all agreements between the Parties related to this proceeding (Ex. 1017). The Parties

request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patent, and be made available only to Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). The Parties certify that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

Accordingly, the Parties respectfully request that that the Board grant the Parties' Joint Motion to Terminate.

Dated: September 1, 2022

Respectfully submitted,

/Naveen Modi/
Naveen Modi
Counsel for Petitioner
Reg. No. 46,224
PAUL HASTINGS LLP
2050 M Street NW
Washington, DC 20036
Phone: 202-551-1700

/Brett Cooper/
Brett Cooper
Counsel for Patent Owner
Reg. No. 55,085
Russ, August & Kabat
12424 Wilshire Blvd. 12th Floor
Los Angeles, CA 90025
Tel.: 310-826-7474

CERTIFICATE OF SERVICE

I hereby certify that on September 1, 2022, a copy of the foregoing Petitioner Google LLC and Patent Owner's Joint Motion to Terminate Pursuant To 35 U.S.C. § 317 was served by electronic means upon the following:

Brett Cooper (bcooper@raklaw.com)
Reza Mirzaie (rmirzaie@raklaw.com)
Russ, August & Kabat
12424 Wilshire Blvd. 12th Floor
Los Angeles, CA 90025

rak_scramoge@raklaw.com

Respectfully submitted,

Dated: September 1, 2022

By: /Naveen Modi/

Naveen Modi (Reg. No. 46,224)
Counsel for Petitioner