

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.
Petitioner

v.

CHECKSUM VENTURES, LLC.
Patent Owner

IPR2019-00491
U.S. 8,301,906

**JOINT MOTION TO DISMISS
UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.71(a)**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a), Petitioner Unified Patents Inc. (“Unified”) and Patent Owner Checksum Ventures LLC (“Checksum”) jointly request termination of the *Inter Partes* Review of U.S. Patent 8,301,906 in IPR2019-00491.

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The Parties are concurrently filing a copy of the settlement agreement as EX1022 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The undersigned represents that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding and that EX1022 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

On April 1, 2019 the Parties informed the Board of the settlement via e-mail and requested authorization to file a joint motion to terminate the proceeding with respect to both the Patent Owner and the Petitioner. As set forth in an e-mail dated April 3, 2019, the Board authorized the filing of the requested joint motion to terminate this proceeding as to both parties. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

Public policy favors terminating the present *inter partes* review proceeding. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide stresses that “[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, 46,768 (Aug. 14, 2012).

Dismissing this IPR petition and terminating review promotes the congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680 (Aug. 14, 2012). Permitting termination as to all parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-

effective alternative to litigation.

Additionally, termination of this IPR is appropriate as the Board has not reached a decision on institution, and it has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Unified filed its petition for *inter partes* review on December 31, 2018. The parties have now settled their dispute, and have reached agreement to terminate this *inter partes* review. The USPTO can conserve its resources through terminating the proceedings now, removing the need for the Board to further consider the arguments, to issue an Institution Decision, or to render a Final Decision. Furthermore, no other party’s rights will be prejudiced by the termination of this proceeding.

Therefore, Unified and CryptoPeak respectfully request termination of this *Inter Partes* Review of U.S. Patent 8,301,906 (IPR2019-00491).

Date: April 4, 2019

Respectfully submitted,

/s/ Roshan S. Mansinghani

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