

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ICONEX, LLC,
Petitioner

v.

MAXStick Products Ltd.,
Patent Owner

Case: IPR2019-01119
U.S. Patent No. 8,445,104

**JOINT MOTION TO TERMINATE PURSUANT TO
35 U.S.C. § 317 AND 37 C.F.R. § 42.7**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioner Iconex LLC (“Iconex”) and Patent Owner MAXStick Products Ltd. (“MAXStick”) jointly move to terminate this *inter partes* review proceeding in light of the parties’ settlement of their dispute regarding the challenged patent, U.S. Patent No. 8,445,104. The filing of this Joint Motion was authorized by the Board via email on May 18, 2020. The parties are filing concurrently with this motion, a true copy of their written settlement agreement in connection with this matter as required. 35 U.S.C. § 317 and 37 C.F.R. § 42.74. The settlement effectively resolves all disputes between the parties regarding the challenged patent, and this entire proceeding should be dismissed as to both Petitioner and Patent Owner.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On May 14, 2020, Petitioner and Patent Owner reached an agreement to resolve all present disputes and to avoid any additional disputes regarding the patent challenged in the above-captioned *inter partes* review. Accordingly, termination is appropriate because all disputes between the parties regarding U.S. Patent No. 8,445,104 have been resolved.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), filed separately herewith as Exhibit 1033 is a true copy of the written Settlement Agreement resolving, *inter alia*, the dispute in the above-captioned *inter partes* review. The

parties also are filing separately herewith a request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The parties also hereby certify that there are no collateral agreements or understanding made in connection with, or in contemplation of, the termination of this proceeding pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(b).

For at least these reasons, Petitioner and Patent Owner submit that termination of this *inter partes* review is appropriate.

Dated: May 18, 2020

Respectfully submitted,

By: /s/ Matias Ferrario
 Matias Ferrario (Reg. No. 51,082)

Lead Counsel for Petitioner

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R.**

§ 42.7 has been served electronically via email upon the following:

James R. Muldoon
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Dated: May 18, 2020

By: /s/ Matias Ferrario
Matias Ferrario (Reg. No. 51,082)

Counsel for Petitioner