

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SQUARE, INC.,
Petitioner

v.

SENDSIG, LLC,
Patent Owner

Case No.: IPR2020-00930

Patent No.: 6,564,249

Filing Date: October 15, 2001

Issue Date: May 13, 2003

Title: Method and System for Creating and Sending Handwritten or Handdrawn
Messages

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

In accordance with 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board’s authorization granted on November 24, 2020, Petitioner Square, Inc. and Patent Owner SendSig, LLC, jointly move to terminate this *Inter Partes* Review proceeding, No. IPR2020-00930, based on an agreement between the parties.

On November 18, 2020, the parties agreed to resolve their disputes relating to United States Patent No. 6,564,249, to dismiss with prejudice the co-pending litigation (*SendSig, LLC v. Square, Inc.*, No. 1:19-cv-03733-JPB) and request termination of this proceeding. The parties have executed a confidential agreement, and pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the written agreement is submitted concurrently herewith as Exhibit 1020.¹ The parties jointly request under 37 C.F.R. § 42.74(c) that the agreement contained in Exhibit 1020 be treated as business confidential information and be kept separate from the files of the above captioned proceeding. In accordance with the agreement, the co-pending litigation will be dismissed with prejudice. There are no other agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding.

¹ The confidential agreement is being filed via PTAB E2E with access “For Board and Parties Only.”

In view of the resolution between the parties, no dispute remains between the parties as to United States Patent No. 6,564,249, and thus termination of this proceeding is appropriate as the Board has not yet decided the merits of this proceeding, a final written decision has not yet been entered, and no discovery has yet taken place – the Board having decided to institute trial only recently. Termination of this proceeding is also consistent with the “strong public policy reasons favoring settlement between the parties to a proceeding.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

For these reasons, the Parties respectfully request that the Board grant this joint motion for termination.

Dated: December 1, 2020

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned hereby certifies that on this date, a true and correct copy of the foregoing was served via electronic mail on all counsel of record.

Dated: December 1, 2020

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