

From: [Trials](#)
To: [Tucker, Daniel](#); [Trials](#); [Enrique Iturralde](#)
Cc: [Arner, Erika](#); [Hines, Lisa](#); [Jin, Mingji](#); [Vincent Rubino](#); [Peter Lambrianakos](#)
Subject: RE: IPR2022-00004, -00005 - Request to terminate in view of settlement
Date: Monday, November 14, 2022 3:58:09 PM
Attachments: [image001.png](#)

Counsel:

Per the parties' request, the parties have until Friday November 19th to file the authorized motions for termination and related / supporting documents.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Tucker, Daniel <Daniel.Tucker@finnegan.com>
Sent: Monday, November 14, 2022 3:22 PM
To: Trials <Trials@USPTO.GOV>; Enrique Iturralde <eiturralde@fabricantllp.com>
Cc: Arner, Erika <erika.arnner@finnegan.com>; Hines, Lisa <Lisa.Hines@finnegan.com>; Jin, Mingji <Mingji.Jin@finnegan.com>; Vincent Rubino <vrubino@fabricantllp.com>; Peter Lambrianakos <plambrianakos@fabricantllp.com>
Subject: RE: IPR2022-00004, -00005 - Request to terminate in view of settlement

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Honorable Board,

The parties appreciate the Board's authorization to file the aforementioned motions. The parties are in the process of reviewing and finalizing the draft termination papers and exhibits for submission to the Board. To allow time to finalize these papers and exhibits, the parties respectfully request a brief extension (to this Friday, November 19) to file the authorized motions.

Respectfully,

Daniel Tucker
Counsel for Petitioner

Daniel C. Tucker | [Bio](#)
Partner

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
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From: Trials <Trials@USPTO.GOV>

Sent: Monday, November 7, 2022 4:18 PM

To: Enrique Iturralde <eiturralde@fabricantllp.com>

Cc: Tucker, Daniel <Daniel.Tucker@finnegan.com>; Arner, Erika <erika.arner@finnegan.com>; Hines, Lisa <Lisa.Hines@finnegan.com>; Jin, Mingji <Mingji.Jin@finnegan.com>; Vincent Rubino <vrubino@fabricantllp.com>; Peter Lambrianakos <plambrianakos@fabricantllp.com>; Trials <Trials@USPTO.GOV>

Subject: RE: IPR2022-00004, -00005 - Request to terminate in view of settlement

EXTERNAL Email:

Counsel:

The parties are authorized to file in each of the identified proceedings, within 5 business days, the following: (1) a motion to terminate the proceeding, as a Paper, (2) a true copy of the written settlement agreement and any collateral agreement (including any licensing agreement) made in connection with the termination, as an Exhibit, and (3) a request to treat the written settlement agreement as business confidential under 37 CFR 42.74(c), as part of or as a separate Paper from the motion to terminate. The settlement agreement should be filed "For Board and Parties Only."

In addition, the motion to terminate should include a statement that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding, assuming such statement is correct. If the parties cannot make such statement, the other agreement(s) also should be filed under 37 C.F.R. § 42.74. The motion to terminate should further explain why termination is appropriate and provide the status of any related district court cases or USPTO proceedings with respect to all parties.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial and Appeal Board

From: Enrique Iturralde <eiturralde@fabricantllp.com>

Sent: Monday, November 7, 2022 3:53 PM

To: Trials <Trials@USPTO.GOV>

Cc: daniel.tucker@finnegan.com; erika.arner@finnegan.com; Hines, Lisa <Lisa.Hines@finnegan.com>; mingji.jin@finnegan.com; Vincent Rubino <vrubino@fabricantllp.com>; Peter Lambrianakos <plambrianakos@fabricantllp.com>

Subject: IPR2022-00004, -00005 - Request to terminate in view of settlement

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Honorable Board,

The Parties have settled all pending disputes between the Parties, including IPR2022-00004, IPR2022-00005, and the related district court litigation. Accordingly, the Parties jointly seek authorization to file a motion to terminate the above-referenced proceedings and a joint request to treat the settlement agreement as business confidential information and kept separate pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Counsel for the Parties are generally available for a conference call if necessary.

Respectfully,

Enrique W. Iturralde
Counsel for Patent Owner
Reg. No. 72,883



Enrique W. Iturralde

Partner

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