

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN SHUFANG INNOVATION TECHNOLOGY CO., LTD.;
NENZ ELECTRIC TECHNOLOGY (DONGGUAN) CO., LTD.;
SHENZHEN XINDE TECHNOLOGY CO., LTD.;
PERFORMANCE HEALTH SYSTEMS, LLC;
YONGKANG AIJIU INDUSTRIAL & TRADE CO., LTD.;
ZHEJIANG RED & BLACK TECHNOLOGY CO., LTD.
Petitioner,

v.

HYPER ICE, INC.
Patent Owner.

US Patent No. 10,561,574
Filing Date: October 17, 2019
Issue Date: February 18, 2020
Title: Battery-powered percussive massage device

Post-Grant Review No.: PGR2020-00089

Joint Motion to Terminate Post-Grant Review of
U.S. Patent No. 10,561,574
Under 37 C.F.R. § 42.72

Pursuant to 37 C.F.R. § 42.72, Petitioner, Shenzhen, *et al.*, and Patent Owner, Hyper Ice, Inc., jointly request dismissal and termination for Post-Grant Review (“PGR”) of U.S. Patent No. 10,561,574 (“the ’574 patent”) in PGR2020-00089. Petitioner and Patent Owner have entered into a written confidential agreement that fully resolves this matter. The Parties are concurrently filing a copy of the agreement as Exhibit 1028 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74. 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 Exhibit 1028 represents a true and accurate copy of the confidential agreement between the Parties that resolves the present proceeding. On March 8, 2021, the Parties informed the Board of the resolution via e-mail, and they requested and received Board authorization to file a joint motion to terminate the Petition with respect to both Patent Owner and the Petitioner and a joint motion to keep the agreement confidential. On March 19, 2021, the Parties requested and received from the Board an extension to March 26, 2021, to file their motions. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

Public policy favors terminating the present Petition for PGR. Congress and federal courts have expressed a strong interest in encouraging settlement in

litigation. *See, e.g., Delta Airlines, 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. 48756, 46768 (Aug. 14, 2012). Terminating this petition for PGR early 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. 48680 (Aug. 14, 2012). Permitting termination provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation. Additionally, termination of this petition for PGR is appropriate as the Board 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).

Petitioner filed its petition for Post-Grant Review on September 30, 2020, and the Board issued a notice of filing date accorded on October 19, 2020. Patent Owner filed a Preliminary Response on January 19, 2021. No other substantive papers have been filed. The Parties have now resolved their dispute and reached agreement to terminate this proceeding. Additionally, there are no other pending USPTO proceedings regarding the '574 patent. The USPTO can conserve its resources through terminating now, removing the need for the Board to further consider the arguments and to render an Institution Decision or Final Written Decision.

Therefore, the Parties respectfully request termination of this Post-Grant

Review of U.S. Patent No. 10,561,574.

Dated: March 25, 2021

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