

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MUNCHKIN, INC.,  
Petitioner,

v.

SKIP HOP, INC.,  
Patent Owner.

Case No. IPR2016-00536

Patent No. 9,060,653 B2

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**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW**

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Pursuant to 35 U.S.C. § 317(a), the Petitioners Munchkin, Inc. and Skip Hop, Inc. (collectively, the “Parties”) jointly request termination of this *inter partes* review proceeding IPR 2016-00536 involving U.S. Patent No. 9,060,653.

Termination of this review is appropriate because the parties have settled their dispute and have reached an agreement to, among other things, file a motion to terminate this review. *See* Ex. 2003 (Settlement Agreement (submitted as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)). “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012)).

Termination of this proceeding is appropriate because it “conserves the Board’s resources, promotes efficiency, and minimizes unnecessary costs.” *The Brinkman Corp. v. A&J Mfg., LLC*, No. IPR2015–00056, slip op. at 2 (PTAB Dec. 21, 2015) (Paper 26); *see also Asml Netherlands B.V. v. Energetiq Tech., Inc.*, No. IPR2015–01277 (PTAB June 13, 2016) (Paper 32) (terminating both parties in proceedings at advanced stage post-institution of trial).

Additionally, as part of the Settlement Agreement, Petitioner has agreed that it will take no further action in furtherance of the IPR. (*See* Ex. 2003, § 2.3.)

Termination also serves the PTAB's overarching goal of "secur[ing] the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1.

**Copy of Settlement Agreement**

A true unredacted copy of the Parties' written Settlement Agreement, executed November 2, 2016, is being filed as Exhibit 2004 contemporaneously with this joint motion to terminate. (Ex. 2003.) The settlement agreement is between the Petitioner Munchkin, Inc. and Skip Hop, Inc., the owner of the '653 Patent. Both parties have the full authority to enter into the settlement. (*See* Ex. 2003 at § 5.1).

There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

The Settlement Agreement has been filed as a confidential document for access by the "Parties and Board Only." The parties desire that the Settlement Agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request for such is being filed contemporaneously.

**Other Proceedings Involving the '653 Patent**

The '653 Patent under review is the subject of a pending district court litigation in *Skip Hop Inc. v. Munchkin Inc.*, No. 2:15-cv-06339 (C.D. Cal.) (the "District Court Matter"). Pursuant to the Settlement Agreement, the Parties are

contemporaneously filing a joint stipulation of dismissal of the District Court Matter.

Respectfully submitted on,

November 3, 2016,

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