

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ACTIV FINANCIAL SYSTEMS, INC.,

Petitioner,

v.

IP RESERVOIR, LLC and  
EXEGY, INC.

Patent Owner.

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Case No. IPR2020-01010  
U.S. Patent No. 10,062,115

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**JOINT REQUEST FOR TERMINATION PURSUANT TO 35 U.S.C. §317(A)**

Pursuant to 35 U.S.C. §317(a) and 37 C.F.R. §42.74, the parties to this proceeding, Petitioner ACTIV Financial Systems, Inc. (“ACTIV” or “Petitioner”) and Patent Owner Exegy, Inc. (“Exegy” or “Patent Owner”) (collectively “the Parties”), jointly request termination of the present *inter partes* review.

The Parties have resolved their disputes and, pursuant to a Settlement Agreement, Mutual Releases and Covenants Not to Sue (“the Agreement”), that resolves their disputes, now move to terminate this IPR. In accordance with 37 C.F.R. §42.20(b), the Parties jointly sought authorization to file this motion and received such authorization from the Board on July 13<sup>th</sup>, 2021.

Termination is proper for at least the following reasons:

1) The Board has not yet “decided the merits of the proceeding ***before the request for termination is filed.***” 35 U.S.C. §317(a) (emphasis added); 77 Fed. Reg. at 48,768 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement unless the Board has already decided the merits of the proceeding.”). In this proceeding, no Final Written Decision has been entered and, in fact, the parties have not completed briefing on the merits.

2) The Parties are jointly requesting termination. 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding”).

3) The Parties have settled their disputes and agreed to voluntary dismissal of the pending related district court litigation between the Parties regarding the patent-at-issue. That case is *Exegy, Inc., et al. v. ACTIV Financial Services, Inc.*, Case No. 1:19-cv-02858 (JJT) (N.D. Ill.), as noted in the Parties' Mandatory Notices. Simultaneous with this Motion, the Parties have also moved to terminate three additional IPR proceedings, the only other proceedings pending between the Parties.

4) With the above-referenced dismissal and terminations, all pending proceedings that involve one of the patents involved in the pending, related district court litigation between the Parties will end. No litigation or proceeding involving the challenged patent is contemplated between the Parties.

5) Terminations, forgoing a Final Written Decision, have been granted even where oral argument had already taken place before the Board. *See Callidus Software Inv. v. Versata Software, Inc., et al.*, CBM2013-00052, Paper 50 (PTAB Nov. 24, 2014); *Clio USA, Inc. v. Procter and Gamble Co.*, IPR2013-00438, Paper 57 (PTAB Oct. 31, 2014). Here, oral argument has not even been set.

6) Pursuant to the Agreement, the Parties are required to seek authorization from the Board to file this Request for Termination, and have received such authorization. Petitioner has also agreed not to participate in the IPR proceeding moving forward.

The Agreement, Exhibit 2101, has been made in writing, and a true and correct copy shall be filed with the Office as business confidential information pursuant to 35 U.S.C. §317(b) and 37 C.F.R. §42.74(b)-(c). The Parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review.

For the foregoing reasons, the Parties jointly and respectfully request that the Board terminate the instant proceeding.

Dated: July 14, 2021

Respectfully submitted,

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***Attorney for Patent Owner, Exegy, Inc.***

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. 42.6(e), I certify that on this 14<sup>th</sup> day of July, 2021, a true and correct copy of the foregoing **Joint Request For Termination** was served by electronic mail on Petitioner's lead and backup counsel at the following addresses:

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