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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VIVINT, INC.,  
Petitioner,

v.

FRACTUS S.A.,  
Patent Owner,

Case IPR2024-00087  
U.S. Patent No. 8,738,103

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**JOINT MOTION TO TERMINATE PURSUANT TO  
35 U.S.C. § 317 AND 37 C.F.R. § 42.72**

**I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Petitioner Vivint, Inc. (“Vivint”) and Patent Owner Fractus S.A. (“Fractus”) jointly move to terminate this *inter partes* review proceeding in light of the parties’ settlement of their dispute related to the subject patent, U.S. Pat. No. 8,738,103. The filing of this Joint Motion was authorized by the Board in its email of February 12, 2024. The parties are submitting this joint motion to terminate this proceeding, along with a true copy of the related Settlement Agreement (Ex. 1010). Given that Vivint is the only Petitioner in this *inter partes* review proceeding, the Settlement Agreement effectively resolves all disputes related to U.S. Patent No. 8,738,103 (“the ’103 patent”), and this entire proceeding should be dismissed as to both Petitioner and Patent Owner.

**II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED**

On January 31, 2024, Petitioner and Patent Owner reached an agreement resolving the underlying dispute in the above-captioned *inter partes* review. Ex. 1010. Accordingly, termination of this IPR proceeding is appropriate because all disputes between the parties regarding the ’103 patent have been resolved. Motions to terminate based on a joint request are routinely granted in the pre-institution

timeframe.<sup>1</sup> Accordingly, termination is appropriate because an institution decision has not yet issued.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement Agreement resolving the dispute in the above-captioned *inter partes* review is being submitted as Ex. 1010 by the parties, along with a request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

### **III. STATUS OF RELATED PROCEEDINGS**

Related to the present proceeding are *inter partes* reviews IPR2024-00088 and IPR2024-00089. Petitioner and Patent Owner are concurrently filing joint motions to terminate these proceedings.

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<sup>1</sup> See, e.g., *Mylan Pharms. Inc. v. Qualicaps Co., Ltd.*, IPR2017-00203 (P.T.A.B. Dec. 19, 2017) (Paper 60 at 2); *Nike, Inc. v. Point 3 Basketball, LLC*, IPR2016-00396 (P.T.A.B. Feb. 22, 2017) (Paper 20 at 3); *Am. Megatrends, Inc. v. Kinglite Holdings Inc.*, IPR2016-00114 (P.T.A.B. Dec. 13, 2016) (Paper 22 at 2).

Also related to the present proceeding is *Fractus, S.A. v. Vivint, Inc.*, 2:22-cv-00413 (E.D. Tex.) (“the Litigation”). Petition at 1. Termination of IPR2024-00087 will conform with the understanding of the litigants and the Court in the Litigation as the Parties have filed a joint motion to dismiss the Litigation with prejudice.

The ’103 patent is also being asserted in *Fractus, S.A. v. ADT LLC*, 2:22-cv-412 (E.D. Tex.) (“the ADT Litigation”). Petition at 1. The defendant in the ADT Litigation, ADT LLC, is not a party to this proceeding. Therefore, termination of this proceeding with respect to Petitioner should result in termination of the entire proceeding. *See* 35 U.S.C. § 317(a).

Aside from the proceedings identified above, the Parties are unaware of any other pending related proceedings regarding the involved patent before the Board, or any other matter before the USPTO (or any other tribunal) that would be affected by the requested termination of this proceeding.

#### **IV. CONCLUSION**

For at least the reasons set forth above, Petitioner and Patent Owner submit that termination of this *inter partes* review is appropriate. Pursuant to 35 U.S.C. § 317(a), because the *inter partes* review is being terminated with respect to the Petitioner, no estoppel pursuant to 35 U.S.C. § 315(e) shall attach to Petitioner Vivint.

Petition for *Inter Partes* Review  
of U.S. Patent No. 8,738,103

Dated: February 15, 2024

Respectfully submitted,

By:       /Jared J. Braithwaite/      

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, together with all exhibits and other papers filed therewith, was served via email (as previously consented to by counsel) on February 15, 2024, to the attorneys of record for the Patent Owner at the following address:

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Dated: February 15, 2024

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