

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIVINT SMART HOME, INC. and NRG ENERGY, INC.,
Petitioners

v.

MALIKIE INNOVATIONS LTD.,
Patent Owner

Case No. IPR2026-00120
U.S. Patent No. 11,119,756

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a) and authorization provided by the Director on December 18, 2025 (EX3101 at 1), Petitioners Vivint Smart Home, Inc. and NRG Energy, Inc., (“Petitioners”) and Patent Owner Malikie Innovations Ltd. (“Patent Owner”) (collectively, the “Parties”) jointly request termination of this *inter partes* review of U.S. Patent 11,119,756 (“the ’756 Patent”), case no. IPR2026-00120.

I. Background

On November 14, 2025, Petitioners filed a petition for *inter partes* review, challenging the ’756 Patent (Paper 3). On November 26, 2025, the PTAB issued a Notice of Filing Date Accorded to Petition and Time For Filing Patent Owner Preliminary Response (Paper 7).

The Parties have entered into a settlement agreement (the “Agreement”) that fully resolves their dispute concerning the ’756 Patent. As a result of the Agreement, Patent Owner’s claims against Petitioner in the following related lawsuit have been dismissed with prejudice: *Malikie Innovations Ltd. and Key Patent Innovations Ltd. v. Vivint Smart Home, Inc. and NRG Energy, Inc.*, Case No. 2:25-cv-00555 (E.D. Tex). The Parties have also agreed to jointly request termination of the present *inter partes* review.

The Parties are concurrently filing a copy of the confidential Agreement as Exhibit 2001 along with a request to treat it as confidential business information

pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Ex. 2001 is being filed as “Parties and Board Only.”

Pursuant to 37 C.F.R. § 42.74(b), there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding, and Ex. 2001 represents a true and accurate copy of the agreement between the Parties that resolves the present proceeding.

II. Termination is Appropriate

The Parties respectfully submit that termination is appropriate. The relevant statutory provision on termination provides that an *inter partes* review “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a).

Termination is appropriate as the Director has not yet “decided the merits of the proceeding.” Consolidated Trial Practice Guide, 86. Petitioner filed its petition for *inter partes* review on October 8, 2025. The proceeding is in its early stages; trial has not been instituted.

Termination further 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. 48,680 (Aug. 14, 2012). Permitting termination as to all parties provides certainty and fosters an environment that promotes resolutions, creating a timely, cost-effective alternative to litigation.

As noted above, the Parties have reached an Agreement that fully resolves their dispute concerning the '756 Patent, including the district court litigation and requesting termination of this *inter partes* review. The Director will conserve resources if he terminates this *inter partes* review now because termination will obviate the need for further proceedings such as an institution decision, briefing, depositions, and a hearing. Accordingly, under 35 U.S.C. § 317(a), the Parties respectfully submit that the proceeding should be terminated upon this joint request.

Additionally, the Parties respectfully submit that the concurrent request to treat the Parties' Agreement as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) should be granted.

Respectfully submitted,

Date: December 22, 2025

/Patrick Colsher/

Patrick Colsher

Lead Counsel for Patent Owner

Registration No. 74,955

/Patrick D. McPherson/

Patrick D. McPherson

Lead Counsel for Petitioners

Registration No. 46,255

PATENT OWNER'S EXHIBIT LIST

Ex. 2001	[<i>Confidential</i>] Patent License Agreement
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing was served via email on December 22, 2025, upon the following counsel of record for Petitioner:

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Dated: December 22, 2025

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