

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELECTRONIC ARTS INC.,
Petitioner,

v.

WHITE KNUCKLE GAMING, LLC,
Patent Owner,

Case No. IPR2016-00634

Patent 8,540,575

JOINT MOTION TO TERMINATE UNDER 35 U.S.C. § 317(a)

I. INTRODUCTION

As authorized in the Patent Trial and Appeal Board's (the "Board") May 3, 2017 email, (Ex. 2038) and pursuant to 35 U.S.C. § 317(a), Patent Owner and Petitioner jointly and respectfully request that the inter parties review ("IPR") of U.S. Patent No. 8,540,575 (the "'575 patent") be terminated.

The parties seek termination under 35 U.S.C. § 317(a) because the IPR is now moot. All the claims of the '575 patent have been invalidated under 35 U.S.C. § 101 in related district court litigation and have been statutorily disclaimed by the Patent Owner under Rule 1.321(a). Petitioner and Patent Owner desire to terminate the IPR to avoid unnecessary expense and to conserve judicial resources.

II. ARGUMENT

1. Brief Explanation As To Why Termination Is Appropriate

Petitioner filed its petition for IPR on February 18, 2016 challenging all of the claims of the '575 patent. (Paper 1.) On September 2, 2016, the Board issued its Decision on Institution and instituted review of all the challenged claims. (Paper 6.) Patent Owner filed its Response on December 17, 2016 (Paper 19) and Petitioner filed its Reply on March 17, 2017 (Paper 22). On April 28, 2017, the Board scheduled oral hearing for May 17, 2017. (Paper 26).

The '575 patent is involved in litigation in the District of Utah, (Case No.: 1:15-cv-00150). On June 7, 2016, the district court entered a judgment of invalidity

of all the claims of the ‘575 patent under 35 U.S.C. § 101 as being an abstract idea. On July 1, 2016, Patent Owner appealed the district court’s decision to the United States Court of Appeals for the Federal Circuit. On April 6, 2017, the Federal Circuit affirmed the district court’s ruling of invalidity under § 101 (Case No. 16-2286, Document 53).

In anticipation of this Joint Motion for Termination, Patent Owner waived its rights to petition for rehearing and writ of certiorari of the Federal Circuit decision. (Ex. 2238). In addition, Patent Owner filed a statutory disclaimer under Rule 1.321(a) disclaiming all the claims of the ‘575 Patent. (Ex. 2039)

Termination of this proceeding is proper under 35 U.S.C. § 317(a) because the Board has not yet decided the merits of the proceeding. Further, after this termination no other Petitioner remains in this proceeding and the parties are unaware of any other pending matter before the USPTO related to the ‘575 Patent. In addition, further USPTO proceedings related to the ‘575 patent are unnecessary due to the Patent Owner’s statutory disclaimer of all the claims and the finding of invalidity under § 101 by the district court. Patent Owner’s waiver of rights to a rehearing or writ of certiorari in the related district court litigation will result in finality for the district court’s judgment of invalidity under 35 U.S.C. § 101. Accordingly, the parties respectfully request that the Board terminate the *inter partes* review of U.S. Patent No. 8,540,575.

DATE: May 8, 2017

Respectfully submitted,

By /Andrew S. Hansen/

Andrew S. Hansen

Reg. No. 56,370

Lead Counsel for Patent Owner

By /Gerard M. Donovan/

Gerard M. Donovan

Reg. No. 67,771

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that, on May 8, 2017, I caused a true and correct copy of the following materials:

- **Joint Motion to Terminate**
- **Patent Owner's Updated Exhibit List**
- **Exhibits 2238-2239**

To be served via electronic mail on the following attorneys of record:

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/s/ Andrew S Hansen

Andrew S. Hansen
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Lead Counsel for Patent Owner

UPDATED EXHIBIT LIST (37 C.F.R. § 42.63(e))

Exhibit	Description
2201	US Patent 8,540,575
2202	Pisanich
2203	FIFA 09 article – EA announces “in-game” updates (investor.ea.com)
2204	FIFA 09 article – aktualne.cz
2205	FIFA 09 article – aktualne.cz (English translation)
2206	FIFA 09 article – Live Season Guide (fifaencyclopedia).com
2207	FIFA 09 article – PSU forum – praising in-game updates (psu.com)
2208	FIFA 09 article – Taringa
2209	FIFA 09 article – Taringa (translation)
2210	FIFA 09 article – discussing player form fluctuation (softpedia.com)
2211	FIFA 09 article – user comments on Adidas Live (Eurogamer.net)
2212	FIFA 09 article – EA release on making FIFA 09 (youtube.com)
2213	FIFA 09 article (ign.com)
2214	FIFA 09 article – Wikipedia article for “FIFA 09” (Wikipedia.org)
2215	FIFA 09 blog – producer Joe Booth (fifa.com)
2216	NBA Live 09 article (gamezone.com)
2217	NBA Live 09 article (g4tv.com)
2218	NBA Live 09 article – producer blog by Sean O’Brien (easports.com)
2219	NBA Live 09 article – EA Sports news (easports.com)
2220	NBA Live 09 forum – forum discussion (operationsports.com)
2221	NBA 2K9 article – living rosters announcement (2ksports.com)
2222	NBA 2K9 article – feature list – (operationsports.com)
2223	NBA 2K9 article – reviews – (ign.com)
2224	NBA 2K9 article – living rosters (wired.com)
2225	NBA Live 10 article – dynamic season hands on (gamespot.com)
2226	Wikipedia article – 1999 Steelers (Wikipedia.com)
2227	Wikipedia article – FIFA series (Wikipedia.com)
2229	FIFA News
2230	Wikipedia entry for “patch_(computing)”

2231	Screen Shots PlayoffWeek1 Update
2232	Screen Shots Super Bowl Update
2233	ESPN article regarding Nick Lowery of the Rams
2234	Deposition transcript of David Crane
2235	Deposition transcript of Ryan Ferwerda
2236	Declaration of David Jones
2237	Declaration of Andrew Hansen
2238	PTAB email authorizing joint motion to terminate
2239	Patent Owner's statutory disclaimer