

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.,
Petitioner,

v.

SILVER STATE INTELLECTUAL TECHNOLOGIES, INC.
Patent Owner.

Case No. IPR2018-00889

Patent 7,343,165 B2

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the two parties to this case, Petitioner Facebook, Inc. (“Facebook” or “Petitioner”) and Patent Owner Silver State Intellectual Technologies, Inc. (“Silver State” or “Patent Owner”) (collectively “the Parties”), jointly request termination of *inter parties* review (IPR) of U.S. Patent No. 7,343,165 (“the Patent”), Case No. IPR2018-00889.

For the Board’s convenience, it is noted that a substantially identical Joint Motion like this one is being filed in IPR2018-00888.

The petition for IPR2018-00889 was filed on April 3, 2018. All of the claims challenged in the petition were held patent-ineligible under 35 USC §101 in the related district court litigation, and the district court’s judgment became final after Patent Owner did not appeal by April 23, 2018. Because the district court’s final judgment resolved the disputes between the Parties regarding the Patent, the Parties 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 written authorization from the Board on June 8, 2018.

Termination is proper for at least the following reasons:

- 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 48768 (“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 fact, the Board has not even rendered a decision whether to institute trial yet. This supports the propriety of terminating this proceeding. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012). And 35 U.S.C. 317(a) provides that “[a]n inter partes review instituted under this chapter 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.”

- The Parties are jointly requesting termination. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding”).
- The pending related district court litigation between the Parties regarding the Patent is *Silver State Intellectual Technologies, Inc. v. Facebook Inc.*, 4:17-cv-03349-JSW (N.D. Cal.), as noted in the Petition’s Mandatory Notices. Because of the final judgment in that litigation holding patent-ineligible under 35 USC §101 all claims challenged in this IPR, the Parties have fully resolved their dispute regarding the Patent and do not anticipate any further litigation or proceeding between the Parties involving the Patent.

In accordance with the Board’s June 8, 2018 Order, a copy of the district court order holding the challenged claims patent-ineligible under 35 USC §101 is

being filed as Exhibit 1008.

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.

Date: June 14, 2018

Respectfully submitted,

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/ Heidi L. Keefe /
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Date: June 14, 2018

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**Lead Counsel for Patent Owner Silver
State Intellectual Technologies, Inc.**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the following document(s)
was served on the date signed below:

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317

The names and addresses of the parties being served are as follows:

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Respectfully submitted,

/ Heidi L. Keefe /

Date: June 14, 2018