

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WILLIAM HILL U.S. HOLDCO, INC. and BRANDYWINE BOOKMAKING
LLC,

Petitioners,

v.

CG TECHNOLOGY DEVELOPMENT, LLC,

Patent Owner.

Case IPR2019-00319
Patent 9,240,098

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

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74, Petitioners, William Hill U.S. Holdco, Inc. and Brandywine Bookmaking LLC, and Patent Owner CG Technology Development, LLC, jointly request termination of Case No. IPR2019-00319, directed to U.S. Patent No. 9,240,098 (“the ’098 patent”).

The parties have settled their disputes involving the ’098 patent, including this proceeding and the related district court litigation, *CG Technology Development, LLC v. William Hill Holdco, Inc.*, Case No. 1:18-cv-00533-RGA, in the United States District Court for the District of Delaware, subject to the terms and conditions set forth in the agreements submitted herewith as Exhibit 2039. The parties have, accordingly, agreed to jointly request termination of this proceeding.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties’ agreements are in writing, and true and correct copies of the parties’ agreements are submitted herewith as Exhibit 2039. The parties request that each of the agreements be treated as business confidential information, and kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). A request for treatment of the agreements as confidential business information is submitted herewith.

I. Background

On November 12, 2018, Petitioners filed a petition for *inter partes* review before the United States Patent Trial and Appeal Board (the “Board”), requesting

review of the '098 patent in IPR2019-00319. Paper 1. The Board issued its decision to institute on May 30, 2019. Paper 14. In accordance with the parties' joint stipulation to modify due dates, Paper 22, Patent Owner timely filed its patent owner response on October 21, 2019 and Petitioners' reply brief is currently due on December 23, 2019. Paper 24. Briefing in this case is not scheduled to be completed until February 21, 2020 and oral argument is currently scheduled for February 27, 2020. Accordingly, the Board has not yet decided the merits of this proceeding.

Subject to the terms and conditions set forth in the agreements submitted herewith as Exhibit 2039, the parties reached an agreement that settles their disputes involving the '098 patent, including this proceeding and in the related district court litigation. The parties' agreements have been made in writing, and true and correct copies are submitted as Exhibit 2039, which the parties have requested be treated as business confidential information. On December 9, 2019, the parties notified the Board of the resolution and requested authorization to file a joint motion to terminate this proceeding as to both Petitioners and Patent Owner. The Board authorized the filing of the requested joint motion to terminate this proceeding on December 11, 2019.

II. Argument

A. Petitioners Should Be Terminated from This Review

Under 35 U.S.C. § 317(a), “an 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 here are jointly requesting termination of this proceeding and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” The Board should terminate Petitioners from the proceeding under § 317(a).

B. Termination as to Patent Owner Is Appropriate

The Board has the discretion to terminate an *inter partes* review in its entirety when no petitioner remains in the proceeding. 35 U.S.C. § 317(a). Petitioners will no longer participate and should be terminated from this proceeding, and accordingly the parties respectfully request that the Board exercise its discretion to terminate this proceeding altogether.

The parties agree that this proceeding should also be terminated with respect to Patent Owner. Specifically, the parties have conferred and mutually determined that it is in the best interests of the parties to request termination of IPR2019-00319 involving the '098 patent.

Termination of this proceeding is appropriate as briefing is not yet complete and the Board has not yet “decided the merits of the proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012); *Medline Industries, Inc. v. Paul Harmann AG*, IPR2013-00173, Judgment Termination of the Proceeding (Paper 44) (terminating a fully briefed IPR as to all parties without rendering any final written decision); *Atrium Medical Corp. v. Davol Inc.*, IPR2013-00186, Judgment (Paper 75) (terminating IPR as to all parties where briefing complete but no final decision on merits has been rendered). Here, briefing is not scheduled to be completed until February 21, 2020, and this joint motion is presented before Petitioners’ reply brief is due on December 23, 2019 and well in advance of the scheduled oral argument date, February 27, 2020. *See* Papers 15, 22.

Termination of this proceeding will also conserve the time and resources of the parties and Board, which can be put to other uses. No interest will be served by continuing this proceeding, because there are no longer any adverse positions to be resolved. Now that the parties have reached an agreement resolving this IPR proceeding, there is no public interest served by continuing this case.

C. Status of Related District Court Litigation

Patent Owner asserted the ’098 patent, as well as U.S. Patent Nos. 9,269,224; 10,096,207 and 9,076,305, against Petitioners in the U.S. District Court

for the District of Delaware in *CG Technology Development, LLC v. William Hill Holdco, Inc.*, Case No. 1:18-cv-00533-RGA. The case has been stayed pending the IPR proceedings.¹ The parties have agreed to resolve this case and will move for its dismissal in due course according to the terms set forth in the agreements submitted herewith as Exhibit 2039. There is no other pending litigation involving the '098 patent.

D. Future Participation by the Parties

In the event that the Board does not terminate the proceeding in its entirety, Petitioners and Patent Owner reserve their rights to continue to participate in this proceeding, including completing depositions and briefing, as well as presenting argument at the oral hearing currently scheduled on February 27, 2020.

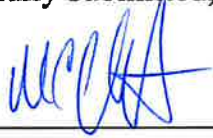
¹ Petitioners also filed petitions for *inter partes* review directed to U.S. Patent Nos. 9,269,224 and 10,096,207, Case Nos. IPR2019-00317 and IPR2019-00320 respectively. Joint motions to terminate each of those proceedings have been concurrently submitted.

III. Conclusion

For these reasons, Petitioners and Patent Owner jointly request that the Board terminate IPR2019-00319.

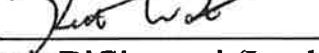
Respectfully submitted,

Dated: December 13, 2019

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317** was served electronically on December 13, 2019 via e-mail directed to counsel of record for the Petitioner at the following:

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