
UNITED STATE PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC., INSTAGRAM, LLC, WHATSAPP INC.
Petitioner,

vs.

EYESMATCH LTD., MEMOMI LABS INC.
Patent Owner.

Case No. IPR2022-00489
Patent No. 8,982,109 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 parties to this proceeding, Petitioners Meta Platforms, Inc., Instagram, LLC, and WhatsApp Inc. (“Petitioners”) and Patent Owners EyesMatch Ltd. and Memomi Labs Inc. (“Patent Owners”), jointly request termination of *inter parties* review of U.S. Patent No. 8,982,109 B2 (“the Patent”), Case No. IPR2022-00489.

For the Board’s convenience, it is noted that substantially identical Joint Motions like this one are being filed in all four of the ongoing proceedings between these parties (*i.e.*, IPR2022-00370, IPR2022-00371, IPR2022-00489, and IPR2022-00490).

The parties have resolved their disputes, and pursuant to the Patent Covenant Not-To-Sue Agreement (“Agreement”) that resolves their disputes, now move to terminate this proceeding. In accordance with 37 C.F.R. 42.20(b), the parties jointly sought authorization to file this motion, and received such authorization from the Board by email dated June 29, 2022.

Termination is proper for at least the following reasons:

1. 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.”). Though this proceeding was filed December 30,

2022, no institution decision has been rendered by the Board. 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.”

2. 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”).

3. The related district court litigation between the parties regarding this Patent was *EyesMatch Ltd. and Memomi Labs Inc. v. Facebook, Inc., Instagram, LLC and WhatsApp LLC*, Case No. 1:21-cv-00111-RGA-JLH (D. Del. January 28, 2021). The parties are unaware of any other pending related proceedings regarding the Patent before the Board, or any other matter before the USPTO that would be affected by the requested termination of this proceeding.

Pursuant to the Agreement, the parties have fully resolved their dispute regarding the Patent, and a stipulation of dismissal with prejudice of the related district court litigation was granted on June 28, 2022. Based on the above, the parties do not anticipate any further litigation or proceeding between the parties involving the Patent.

Terminations, forgoing a Final Written Decision, are commonly granted at the present stage of proceedings where no institution decision has issued, and have been granted even where oral argument had already taken place before the Board. *See Callidus Software Inc. v. Versata Software, Inc.*, et al., CBM2013-00052, Paper 50 (Nov. 24, 2014) (terminating proceeding after Oral Argument); *Clio USA, Inc. v. Procter and Gamble Co.*, IPR2013-00438, Paper 57 (Oct. 31, 2014) (same); *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00017, Paper 53 (June 17, 2014) and CBM2013-00018, Paper 52 (June 17, 2014) (same).

Pursuant to the Agreement, the parties are required to seek authorization from the Board to file this Motion to Terminate and have received such authorization.

The Agreement, Exhibit 1030, has been made in writing, and a true and correct copy shall be filed with this Office. 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: July 5, 2022

Respectfully submitted,

/ Heidi L. Keefe /

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Date: July 5, 2022

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317** and related documents, are being served via electronic mail on the 5th day of July 2022, upon Patent Owner by serving counsel of record for the Patent Owner as follows:

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/ Heidi L. Keefe /

Date: July 5, 2022