

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

EYESMATCH LTD. and MEMOMI LABS INC.,  
Patent Owner.

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IPR2022-00489  
Patent 8,982,109 B2

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Before THOMAS L. GIANNETTI, NEIL T. POWELL, and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

DECISION  
Settlement Prior to Institution of Trial  
*37 C.F.R. § 42.74*

## I. BACKGROUND

Meta Platforms, Inc., Instagram, LLC, and WhatsApp Inc. (“Petitioner”) filed a Petition (Paper 2) requesting *inter partes* review of claims 1, 2, 6, 8, 9, and 17 of U.S. Patent No. 8,982,109 B2 (Ex. 1001, “the ’109 patent”). EyesMatch Ltd. and Memomi Labs Inc. (“Patent Owner”) filed a Preliminary Response (Paper 9).

With Board authorization, prior to receiving a decision on institution, Petitioner and Patent Owner filed a “Joint Motion to Terminate Pursuant to 35 U.S.C. § 317” (Paper 10, “Joint Motion”). The Joint Motion seeks termination of this proceeding. *Id.* at 2. Similar motions have been filed in three related proceedings. *Id.*

The parties represent that they have settled their dispute pursuant to a covenant not to sue. *Id.* The parties maintain that there is good cause for granting the Joint Motion. *Id.* at 2–4.

Finally, in a separate motion, the parties jointly request that the Patent Covenant Not-To-Sue Agreement (Ex. 1030, “Settlement Agreement”) be treated as confidential business information and kept separate from the public files, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 11, 1.

## II. DISCUSSION

Under 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. § 317(a).

The parties certify that they have complied fully with 37 C.F.R. § 42.74(b) by filing the written Settlement Agreement, reflected in Exhibit 1030, with the Board, and that there are no other collateral agreements or

understandings made in connection with, or in contemplation of, the termination sought. Joint Motion 4.

The parties represent that pursuant to the Settlement Agreement, the parties have fully resolved their dispute regarding the '109 patent, and a stipulation of dismissal with prejudice of the related district court litigation was granted on June 28, 2022. *Id.* at 3. They further represent that based on the above, the parties do not anticipate any further litigation or proceeding between the parties involving the '109 patent. *Id.*

We find that for the reasons given by the parties, there is good cause to grant the Joint Motion to terminate this proceeding. This case is at an early stage. The Board has not reached a decision whether to institute a trial. “There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . 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.” Consolidated Trial Practice Guide 86 (November 2019).<sup>1</sup>

We also find that there is good cause for granting the joint request to file the Settlement Agreement as confidential. Paper 11.

### III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that the parties’ Joint Motion to Terminate (Paper 10) is *granted* and this case is *terminated*; and

FURTHER ORDERED that the parties’ Joint Request to File Settlement Agreement as Business Confidential Information (Paper 11) is

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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*granted*, and Exhibit 1030 shall remain sealed and kept separate from the public files of the '109 patent, consistent with 37 C.F.R. § 42.74(b).

FOR PETITIONER:

Heidi L. Keefe  
Andrew C. Mace  
COOLEY LLP  
[hkeefe@cooley.com](mailto:hkeefe@cooley.com)  
[amace@cooley.com](mailto:amace@cooley.com)

FOR PATENT OWNER:

Gina Cremona  
TENSEGRITY LAW GROUP LLP  
[gina.cremona@tensegritylawgroup.com](mailto:gina.cremona@tensegritylawgroup.com)