

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT AND TRIAL AND APPEAL BOARD

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GSN GAMES, INC., f/k/a WORLDWINNER.COM, INC.,  
Petitioner,

v.

BALLY GAMING, INC.,  
Patent Owner.

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Case No. CBM2015-00155  
Patent No. 5,816,918

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**JOINT MOTION TO TERMINATE PROCEEDING**  
**PURSUANT TO 35 U.S.C. § 327(a)**

Pursuant to 35 U.S.C. § 327(a), Petitioner GSN Games, Inc., f/k/a Worldwinner.com Inc. (“GSN”) and Patent Owner, Bally Gaming Inc. (“Bally”) jointly request termination of the Covered Business Method Review of U.S. Patent No. 5,816,918, Case No. CBM2015-00155.

This Joint Motion was authorized by the Board pursuant to an email from Andrew Kellogg, Supervisory Paralegal to Patent Owner and counsel for Petitioner on April 27, 2016.

This CBM review was only recently instituted in January 21, 2016. Patent owner has not yet filed a Response. There has been no discovery. The parties’ Settlement Agreement has now been made in writing, and a true and correct copy shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 327(b). The parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. §42.74(c) and a joint request to that effect is being filed concurrently herewith.

As stated in 35 U.S.C. § 327(a), because GSN and Bally jointly request this termination as to Petitioner GSN, no estoppel under 35 U.S.C. 325(e) shall attach to GSN.

**1. Appropriateness of Termination.**

Termination is appropriate with respect to both Petitioner and Patent Owner for several reasons. First, the statutory condition for termination under § 327(a) is satisfied—this joint request for termination is being filed before the Office has decided the merits of the proceeding.

Second, the parties have settled their dispute. On April 19, 2016, GSN and Bally entered into a Settlement Agreement resolving all issues relating to their dispute.

Third, given that all judicial or administrative matters that would affect or be affected by a decision in this proceeding have been terminated, the merits of the petition have not been determined, no motions or other matters are outstanding, and concluding these proceedings at this early juncture promotes the Congressional goal to establish a more efficient and streamlined patent system, the Patent Owner's and Petitioner's joint request to terminate should be granted.

**2. Settlement Agreement.**

The Settlement Agreement between the parties was made in writing. A true and correct copy of the Settlement Agreement is being filed with this Office as business confidential information pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. §

42.74(b)-(c), along with a separate joint motion to keep the Settlement Agreement confidential.

### **3. Estoppel.**

As stated in 35 U.S.C. § 327(a), because GSN and Bally request this termination, as to Petitioner GSN (and any real parties in interest or privy to GSN), no estoppel under 35 U.S.C. § 325(e) shall attach to GSN. As provided in 37 C.F.R. § 42.73(d)(3), because no adverse judgment has been entered, as to Patent Owner Bally, no estoppel under 37 C.F.R. § 42.73(d)(3) shall attach to Bally.

In view of the foregoing GSN and Bally respectfully request termination of the Covered Business Method Review of U.S. Patent No. 5,816,918, Case No. CBM2014-00155. Mr. Ted Cannon, back-up counsel for Petitioner, has authorized the undersigned to file this motion with Petitioners' concurrence and joinder.

Respectfully submitted,

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