### UNITED STATES PATENT AND TRADEMARK OFFICE

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#### BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BUNGIE, INC., Petitioner,

v.

WORLDS INC., Patent Owner.

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Case IPR2015-01264 (Patent 7,945,856 B2) Case IPR2015-01319 (Patent 8,082,501 B2) Case IPR2015-01321 (Patent 8,145,998 B2)

PATENT OWNER WORLDS INC.'S RESPONSE ON REMAND FROM CAFC



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Astoria Fed. Sav. & Loan Ass'n v. Solimino, 501 U.S. 104 (1991)1	3
Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc., IPR2013-00453, Paper 88 (PTAB Jan. 6, 2015)2	9
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Commil USA, LLC v. Cisco Sys., Inc., 135 S. Ct. 1920 (2015)1	6
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Guenther v. Holmgreen, 738 F.2d 879 (7th Cir. 1984)	7
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Nestle USA Inc. v. Steuben Food, Inc., 884 F.3d 1350 (Fed. Cir. 2018)	6, 7
Unified Patents v. Realtime Adaptive Streaming, LLC, IPR2018-00883, Paper 29 (PTAB Oct. 11, 2018)	25
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