

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GAMELOFT, INC.,

Petitioner

v.

INVENTOR HOLDINGS, LLC

Patent Owner

Case No. IPR2015-01771

U.S. Patent No. 8,784,198

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to the Patent Trial and Appeal Board's e-mail on October 26, 2015 authorizing filing of the present joint motion, Petitioner Gameloft, Inc. ("Petitioner") and Patent Owner, Inventor Holdings, LLC ("Patent Owner") (collectively "Parties") jointly request termination of the present *inter partes* review proceeding, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74 (b), on the basis that final judgment has been entered in the district court proceeding.

The Parties have reached an agreement resolving the dispute in the above-captioned *inter partes* review. On September 30, 2015, the district court in the litigation *Inventor Holdings, LLC v. Gameloft, Inc., et al.* entered a decision finding all claims of the '198 Patent invalid under 35 U.S.C. §101. The claims invalidated include all of the claims challenged in this proceeding. Copies of the district court opinion and order entered on September 30, 2015 are attached as Exhibits 1010 and 1011.

In addition, Patent Owner has agreed not to appeal the district court judgment. As such, the judgment is final, and the parties agree that the present proceeding is moot and should be terminated because all challenged claims have been found invalid under 35 U.S.C. §101. Also submitted and attached as Exhibit 1012 is a stipulation filed in the district court reflecting the Parties' understanding and agreement that the judgment is final and that Patent Owner will not appeal the decision. Exhibit 1013 is a docket entry reflecting an oral order of the Court

entering the Parties' stipulation. The stipulation was filed jointly by the Parties (and unrelated defendants) and endorsed by the district court and sets forth the Parties' understanding and agreement as required by 35 U.S.C. §317(b). Collectively, the Parties agree that Exhibits 1010-1013 resolve the disputes between them in the above-captioned petition for *inter partes* review relating to the '198 Patent. The Parties are aware of no other pending litigation involving the patent at issue.

Termination, here, is appropriate as to Petitioner because (1) the dispute with respect to the '198 Patent is over, (2) the present proceeding is moot in light of the district court's order, and (3) the parties have agreed to terminate this proceeding. In addition, Patent Owner has not filed a preliminary response and the Board has not made a decision on institution. *See* 35 U.S.C. § 317(a). In other words, the Board has not yet decided the merits of this proceeding. Further, Gameloft represents that it will no longer participate even if the Board does not terminate the above-captioned *Inter Partes* Review. This means that Gameloft will file no further papers, will not conduct any cross examination of any Patent Owner witnesses, and will not be participating in any oral argument.

Termination is also appropriate with respect to Patent Owner. The parties are moving jointly that this *inter partes* review proceeding be terminated with respect to Patent Owner. In addition, (1) the parties have settled all disputes between them as to the patent at issue in this proceeding, (2) this proceeding is in

its earliest stages as a preliminary response has not been filed, and (3) the merits of the petition have not been considered.

Patent Owner represents that all actions pending in the district court have been concluded and no further actions are contemplated as the '198 Patent was found unpatentable. Patent Owner is not aware of any other IPR or CBM proceedings involving the '198 Patent.

For at least the above reasons, the Parties, therefore, jointly and respectfully request that the above-captioned *inter partes* review be terminated.

Date: October 27, 2015

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Joint Motion to Terminate *Inter Partes* Review per 37 C.F.R. § 42.8 was served on October 27, 2015, to counsel listed below via email:

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