

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COLLECTIVE MINDS GAMING CO. LTD.

Petitioner,

v.

IRONBURG INVENTIONS LTD.,

Patent Owner.

IPR2018-00354
Patent 8,641,525

**JOINT MOTION TO TERMINATE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72
AND JOINT REQUEST TO KEEP PAPERS SEPARATE
AS BUSINESS CONFIDENTIAL INFORMATION**

Pursuant to 35 U.S.C. §317 and 37 C.F.R. § 42.72, Patent Owner Ironburg Inventions Ltd. and Petitioner Collective Minds Gaming Co. Ltd., (collectively, “the Parties”) jointly request termination of the above-captioned *Inter Partes* Review No. IPR2018-00354 (“the IPR”).

The Parties have settled all of their disputes involving the IPR in a definitive Settlement Agreement executed on or around November 20, 2018. Pursuant to that Settlement Agreement, the Parties have agreed to settle and dismiss their related District Court litigation (*Ironburg Inventions Ltd. v. Collective Minds Gaming Co. Ltd.*, Case No. 1:16-cv-04110-TWT (N.D. Geo.)) and all proceedings before the Patent Trial and Appeal Board (IPR2018-00354, IPR2018-00355, IPR2018-00356, and IPR2018-00357).

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Settlement Agreement made in contemplation of termination of the proceeding is in writing, and a true and correct copy of such document is being filed herewith electronically with access to “Parties and Board Only” as confidential EX2023. No other such agreements, written or oral, exist between or among the parties.

The Parties hereby jointly request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the above captioned IPR pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

I. Background

On January 3, 2018, Petitioner filed a request for *Inter Partes* Review of claims 1-11 and 13-20 of U.S. Patent No. 8,641,525 (the “’525 Patent”). See IPR2018-00354, Paper 2. On June 7, 2018, the Board instituted *Inter Partes* Review in IPR2018-00354 on claims 1-11 and 13-20. See IPR2018-00354, Paper 11. On September 14, 2018, Patent Owner filed a response. See IPR2018-00354, Paper 14. Petitioner has not yet filed a reply.

On January 3, 2018, Petitioner filed a request for *Inter Partes* Review of claims 1-2, 9-10, 15-18 and 21-24 of U.S. Patent No. 9,352,229 (the “’229 Patent”). See IPR2018-00355, Paper 2. On July 5, 2018, the Board instituted *Inter Partes* Review in IPR2018-00355 on claims 1-2, 9-10, 15-18 and 21-24. See IPR2018-00355, Paper 11. Patent Owner has not yet filed a response and Petitioner has not yet filed a reply.

On January 3, 2018, Petitioner filed a request for *Inter Partes* Review of claims 1-20 of U.S. Patent No. 9,089,770 (the “’770 Patent”). See IPR2018-00356, Paper 2. On June 7, 2018, the Board instituted *Inter Partes* Review in IPR2018-00356 on claims 1-20. See IPR2018-00356, Paper 11. On September 14, 2018, Patent Owner filed a response. See IPR2018-00356, Paper 14. Petitioner has not yet filed a reply.

On January 3, 2018, Petitioner filed a request for *Inter Partes* Review of claims 1, 9-10, 18-19, 21-24, 26 and 28-30 of U.S. Patent No. 9,289,688 (the “‘688 Patent”). See IPR2018-00357, Paper 1. On July 9, 2018, the Board instituted *Inter Partes* Review in IPR2018-00357 on claims 1, 9-10, 18-19, 21-24, 26 and 28-30. See IPR2018-00357, Paper 7. Patent Owner has not yet filed a response. Petitioner has not yet filed a reply.

On or around November 20, 2018 the Parties agreed to settle all of their disputes involving the ‘525 Patent, the ‘229 Patent, the ‘770 Patent and the ‘688 Patent, including all litigation and Patent Office proceedings related thereto.

On December 3, 2018, the Parties informed the Board of the settlement and requested authorization to file a joint motion to terminate the proceeding with respect to both the Patent Owner and the Petitioner. On December 4, 2018, the Board authorized the filing, on or before December 20, 2018, of the requested joint motion to terminate this proceeding as to both parties. The Board additionally authorized the parties to include with the joint motion to terminate a request to treat the Settlement Agreement as business confidential information.

The ‘525 and ‘770 Patents are currently the subject of an appeal to the United States Court of Appeals for the Federal Circuit, Case No. 18-1432, from *Inter Partes* Review proceedings IPR2016-00948 and IPR2016-00949, respectively, filed by Valve Corporation. Dkt. 44. On July 30, 2018, Patent Owner

filed its Appellant's Opening Brief. On October 11, 2018, Valve Corporation filed its Cross-Appellant Opening Brief. Dkt. 53. On December 11, 2018, Patent Owner filed its Reply and Response Brief. Dkt. 57. Moreover, the '688 and '229 Patents are currently the subject of pending *Inter Partes* Review proceedings IPR2017-00858 and IPR2017-01928, respectively, filed by Valve Corporation. Oral hearing concluded in both proceedings and a final written decision has not yet issued. These proceedings are unaffected by the Parties' settlement agreement.

II. Termination as to Patent Owner and Petitioner Is Appropriate

Termination of the IPR is appropriate as the Board has not yet "decided the merits of the proceeding" on the proceedings noted above. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012); 35 U.S.C. § 317(a). Furthermore, Petitioner has not yet filed any replies.

Notably, no dispute remains between the Parties involving the '525, '229, '770 and '688 Patents:

- i. the Parties have agreed to jointly request termination of the instituted *Inter Partes* Review, IPR2018-00354, IPR2018-00355, IPR2018-00356 and IPR2018-00357; and

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