

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC. and
CHOICE HOTELS INTERNATIONAL, INC.

Petitioners

v.

FALL LINE PATENTS, LLC

Patent Owner

CASE IPR2018-00535
PATENT 9,454,748

**JOINT MOTION TO TERMINATE PROCEEDINGS
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74(a)-(b), Petitioners Uber Technologies, Inc. (“Uber”) and Choice Hotels International, Inc. (“Choice”) and Patent Owner Fall Line Patents, LLC (“Fall Line”) jointly move to terminate the present *inter partes* review proceeding in light of the parties’ resolution of their dispute relating to U.S. Patent No. 9,454,748 (“the ’748 Patent”) and the executed written agreement regarding the parties’ resolution.

Termination with respect to Petitioners and Patent Owner is appropriate in the instant proceeding because the dispute between the parties has been resolved. The Board has not issued a decision regarding whether to institute *inter partes* review, and this proceeding is at a sufficiently early stage.

As required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties are filing, concurrently herewith, a true copy of the executed settlement agreements between Fall Line and Uber (Exhibit 2001) and Fall Line and Choice (Exhibit 2002). There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding. By separate paper (Paper 11), the parties request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), that the agreements be treated as confidential business information and kept separate from the public files of the involved patent.

The related proceedings in the District Court for the Eastern District of Texas, *Fall Line Patents, LLC v. Choice Hotels Int’l, Inc.* (6:17-cv-00407) and *Fall Line*

Patents, LLC v. Uber Technologies, Inc. (6:17-cv-00408) (both consolidated with 6:17-cv-00202) have been dismissed. There are no other pending district court actions in which the ‘748 Patent is asserted. Regarding proceedings before the Patent Office, IPR2018-00043, filed by Unified Patents, Inc. against the ‘748 Patent, has been instituted and is currently pending.

The applicable statute, provides that an *inter partes* review proceeding “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). Moreover, strong public policy considerations favor settlement between parties to an *inter partes* review proceeding. Indeed, the Office Patent Trial Practice Guide provides:

N. Settlement. There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the 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.

The Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14 2012).

Here, the Board has not decided the merits of the proceeding, and the deadline for the Board’s institution decision is August 7, 2018. No public interest factors

militate against termination of this proceeding with respect to both Petitioners and Patent Owner in light of the circumstances of this proceeding.

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated with respect to both Petitioners and Patent Owner.

Dated: July 13, 2018

Respectfully submitted,

/s/ Jonathan I. Detrixhe

Jonathan I. Detrixhe
Registration No. 68,556
jdetrixhe@reedsmith.com
John P. Bovich (*pro hac vice*)
Reed Smith LLP
101 Second Street #1800
San Francisco, CA 94105

Gerard M. Donovan (Reg. #67,771)
gdonovan@reedsmith.com
Reed Smith, LLP
1301 K Street, NW
Suite 1000 – East Tower
Washington, DC 20005

Counsel for Petitioners

/s/ Matthew J. Antonelli

Terry L. Watt (Reg. No. 42214)
terry.watt@crowedunlevy.com
Crowe & Dunlevy
321 South Boston, Suite 500
The Kennedy Bldg.
Tulsa, OK 74103
Telephone: 918/592 9800
Fax: 918/592-9801

Matthew J. Antonelli (Reg. No. 45973)
matt@ahtlawfirm.com
Michael E. Ellis (Reg. No. 72628)
michael@ahtlawfirm.com
Larry D. Thompson, Jr. (Reg. No. 43952)
larry@ahtlawfirm.com
ANTONELLI, HARRINGTON &
THOMPSON LLP
4306 Yoakum Blvd., Suite 450
Houston, TX 77006
Telephone: 713/581-3000

*Counsel for Patent Owner Fall Line
Patents, LLC*

CERTIFICATION OF SERVICE (37 C.F.R. §§ 42.6(e), 42.105(a))

The undersigned hereby certifies that the above-captioned document has been served in its entirety this 13th Day of July, 2018, on all counsel of record via email.

/s/ Michael D. Ellis

Reg. No. 72,628
4306 Yoakum Blvd., Ste. 450
Antonelli, Harrington & Thompson LLP
Houston, TX 77006

Counsel for Patent Owner Fall Line
Patents, LLC