

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

STARBUCKS CORPORATION ET AL.

Petitioners

v.

FALL LINE PATENTS, LLC

Patent Owner

CASE IPR2019-00610
PATENT 9,454,748

**JOINT MOTION TO TERMINATE WITH RESPECT TO STARBUCKS
CORPORATION 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, Petitioner Starbucks Corporation (“Starbucks”) and Patent Owner Fall Line Patents, LLC (“Fall Line”) jointly move to terminate the present *inter partes* review proceeding with respect to Starbucks, 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. The remaining petitioners, American Multi-Cinema, Inc. and AMC Entertainment Holdings, Inc. (“AMC”), Boston Market Corporation (“Boston Market”), Mobo Systems, Inc., d/b/a OLO Online Ordering (“Olo”), McDonald’s Corporation and McDonald’s USA (“McDonald’s”), Panda Restaurant Group, Inc. and Panda Express Inc. (“Panda”), and Papa John’s International, Inc., Star Papa LP, and Papa John’s USA, Inc. (“Papa John’s”), consent to and do not oppose termination of Starbucks from this proceeding. This motion was authorized by e-mail from the Board on June 26, 2019

Termination with respect to Starbucks is appropriate in the instant proceeding because the dispute between Starbucks and Fall Line 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), the parties are filing, concurrently herewith, a true copy of their executed written agreement as Exhibit 2005. 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 12), the parties request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), that the agreement be treated as confidential business information and kept separate from the public files of the involved patent.

The related proceeding in the District Court for the Eastern District of Texas, *Fall Line Patents, LLC v. Starbucks Corporation* (6:18-cv-00411) has been dismissed, and Starbucks has been terminated from the consolidated lead case *Fall Line Patents, LLC v. Zoe's Kitchen, Inc. et al.* (6:18-cv00407), which remains pending. The following related district court action also remain pending: *Fall Line Patents, LLC v. AMC Entertainment Holdings, Inc. et al.* (6:18-cv-00408), *Fall Line Patents, LLC v. Boston Market Corporation* (6:18-cv-409), *Fall Line Patents, LLC v. McDonald's Corporation, et al.* (6:18-cv-00412), *Fall Line Patents, LLC v. Panda Restaurant Group, Inc. et al.* (6:18-cv-00413), *Fall Line Patents, LLC v. Papa John's International, Inc.* (6:18-cv-00415). Regarding proceedings before the Patent Office, IPR2018-00043, filed by Unified Patents, Inc. against the '748 patent, has been instituted and a final written decision issued on April 4, 2019.

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). (emphasis added).

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 10, 2019. No public interest factors militate against termination of this proceeding with respect to Starbucks.¹

For the foregoing reasons, Starbucks and Fall Line respectfully request that the instant proceeding be terminated with respect to Starbucks.

Dated: June 26, 2019

Respectfully submitted,

/s/ Tara D. Elliott

/s/ Matthew J. Antonelli

¹ This Motion requests termination of the IPR with respect to Starbucks only, and does not request termination of the IPR as to the other petitioners.

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