

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WORLD PROGRAMMING LIMITED,

Petitioner,

v.

SAS INSTITUTE, INC.,

Patent Owner.

Case No. IPR2019-01458

U.S. Patent 7,170,519

**PETITIONER'S UNOPPOSED MOTION TO DISMISS THE PETITION
AND TERMINATE THE PROCEEDING BEFORE INSTITUTION**

I. INTRODUCTION

On December 9, 2019, the Board authorized Petitioner World Programming Limited to file a motion to dismiss its petition for inter partes review and terminate the proceeding. This proceeding is in its preliminary phase. Patent Owner SAS Institute has filed a Preliminary Response but the Board has yet to reach the merits and issue a decision on institution. World Programming requests that the Board to dismiss its petition and terminate IPR2019-01458 to preserve the Board's and parties' resources and to achieve a just, speedy, and inexpensive resolution to this dispute that does not cause prejudice to SAS Institute. SAS Institute does not oppose this motion.

II. PROCEDURAL HISTORY

The petition for inter partes review was filed on August 5, 2019. This proceeding is related to a district court action entitled *SAS Institute Inc. v. World Programming Limited, et al.*, which is pending in the United States District Court for the Eastern District of Texas and is assigned Case No. 2:18-cv-00295. The patent at issue in this proceeding is one of four patents currently asserted against World Programming. The district court action is set for a jury trial in August 2020.

III. ARGUMENT

Good cause exists to dismiss World Programming's petition for inter partes review and terminate this proceeding. Termination will preserve the Board's and

the parties' resources, and would expeditiously resolve World Programming's request, furthering the purpose of IPR challenges. 37 C.F.R. § 42.1(b). This proceeding is in its preliminary stage as the Board has not yet reached the merits and issue a decision on institution. SAS Institute does not oppose termination and will not be prejudiced by termination.

The Board "may terminate a trial without rendering a final written decision, where appropriate..." 37 C.F.R. § 42.72. The Rules governing IPR proceedings "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). In determining whether a termination request is "appropriate," the Board has looked primarily to the stage of the proceedings when a request is made, and has repeatedly granted pre-institution termination. *See, e.g.*, IPR2014-00905, Paper 7 at 1 (Aug. 26, 2014) (granting unopposed motion to terminate stating that a "decision on the Petition ... has not yet been rendered. Under these circumstances, we determine that it is appropriate ... to terminate this proceeding without rendering a final written decision.")

The Board has repeatedly stated in other decisions that the stage of the proceeding is the most relevant factor to be considered in addressing a termination request. *Cf.* IPR2013-00016, Paper 31 at 3 (Dec. 11, 2013) (holding that "in view of the advanced stage of this proceeding, rather than terminate this proceeding, the Board will proceed to a final written decision" despite the joint nature of the

motion); IPR2015-00035, Paper 30 at 4 (June 25, 2015) (“The instant proceeding is not in a preliminary stage; we issued a decision instituting *inter partes* review [two months prior].”). This proceeding is in its preliminary stage and termination is proper.

The Board should grant World Programming’s motion. Such termination will further the purpose of the rules by expeditiously resolving this dispute without subjecting the Board and the parties to unnecessary expense involved in taking IPR2019-01458 through trial. The parties will incur substantial expense in preparing and presenting expert declarants for deposition, submitting substantive briefs and motions, and presenting at an oral hearing. Because of the procedural posture of the district court action, it is unlikely that a final written decision will issue in this proceeding before the district court action is tried to a jury, and therefore the parties are likely to incur duplicative expenses litigating the same or similar invalidity issues in this proceeding and in the district court. Therefore, World Programming submits that it is more efficient to focus its limited resources on the district court action and termination will not prejudice SAS Institute.

In addition, the Board will also have to expend substantial resources if it were to decline to terminate IPR2019-01458. It will likely be requested to address various procedural disputes, address potential requests for additional discovery, preside over an oral hearing, and draft a substantive decision on institution and a

final written decision on the merits. All of these resources can be spared by terminating IPR2019-01458. Termination will reduce the overall burden of this dispute on the Board. Thus, termination will secure the “the just, speedy, and inexpensive resolution” of the proceeding without prejudice to SAS Institute, and SAS Institute does not oppose the Board terminating IPR2019-01458.

IV. CONCLUSION

The Board should dismiss World Programming’s petition and terminate IPR2019-01458.

Date: December 16, 2019

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