

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Playtika Ltd., Playtika Holding Corp., and Aristocrat Technologies, Inc.,

Petitioners,

v.

NEXRF Corp.,

The Patent Owner.

Case No. IPR2021-00951¹
U.S. Patent No. 8,747,229

**JOINT MOTION TO TERMINATE TRIAL
PURSUANT TO 35 U.S.C. § 317(a)**

¹ Aristocrat Technologies, Inc. was joined as a party to this proceeding via Motion for Joinder in IPR2022-00408.

LIST OF EXHIBITS

Exhibit	Description
Ex-1001	U.S. Patent No. 8,747,229 (the '229 patent)
Ex-1002	Prosecution File History of U.S. Patent No. 8,747,229
Ex-1003	Declaration of Stacy A. Friedman
Ex-1004	Curriculum Vitae of Stacy A. Friedman
Ex-1005	U.S. Patent No. 7,470,196 B1 (“Joshi”)
Ex-1006	European Patent Application No. EP 0 934 765 A1 (“Agasse”)
Ex-1007	U.S. Patent No. 5,918,013 (“Mighdoll”)
Ex-1008	<i>Reserved</i>
Ex-1009	Australian Patent No. 721645 (“Finlayson”)
Ex-1010	David Ohlson, Lasseters On-Line, “Internet Gambling” (May 6-7, 1999).
Ex-1011	Access Systems PTY Ltd., Submission to The Productivity Commission Inquiry into Australia’s Gambling Industries (Oct. 1998).
Ex-1012	U.S. Patent No. 6,874,084 (“Dobner”).
Ex-1013	John R. Smith et al., Content-Based Transcoding of Images in the Internet (1998).
Ex-1014	<i>Reserved</i>
Ex-1015	Complained Filed in <i>NEXRF Corp. v. Playtika Ltd.</i> , Case No. 3:20-cv-604-MMD-CLB (D. Nev.)
Ex-1016	Henrik Frystyk Nielson, et al., Network Performance Effects of HTTP/1.1, CSS1, and PNG, note 24-June 1997 (“Neilson”).
Ex-1017	U.S. Patent No. 6,409,602 (“Wiltshire”)
Ex-1018	As-filed Application of U.S. Patent Application No. 09/688,501
Ex-1019	E-mail Correspondence
Ex-1020	Playtika’s Motion to Dismiss Filed on Feb. 18, 2021
Ex-1021	<i>Reserved</i>
Ex-1022	NEXRF’s Notice of Appeal
Ex-1023	Federal Circuit’s Rule 36 Judgment
Ex-1024	Federal Circuit’s Mandate

I. INTRODUCTION

Petitioners Playtika Ltd. and Playtika Holding Corp. (“Playtika”), and Aristocrat Technologies, Inc. (collectively, “Petitioners”), and Patent Owner NEXRF Corp. (“NEXRF” or “Patent Owner”) jointly request the Board to terminate trial in this *inter partes* review in light of the Federal Circuit’s Rule 36 judgment affirming the Nevada District Court’s decision, which invalidated all claims of the ’229 patent under 35 U.S.C. § 101. All unpatentability grounds presented before the Board are now moot in view of the Federal Circuit’s issuance of a formal mandate, and NEXRF’s representation that it will not request review by the Supreme Court.

II. BACKGROUND FACTS

A timeline of events regarding the ’229 patent is provided below.

1. February 18, 2021: In a district court proceeding, Playtika filed a motion to dismiss NEXRF’s complaint, arguing *inter alia* that the ’229 patent is patent ineligible under 35 U.S.C. § 101. Ex-1020.
2. May 26, 2021: Playtika filed a petition for *inter partes* review of the ’229 patent.
3. July 7, 2021: The district court granted Playtika’s motion to dismiss, holding that all asserted patents, including the ’229 patent, are patent ineligible under § 101. Ex-2006.

4. July 13, 2021: NEXRF appealed the district court's judgment to the Federal Circuit. Ex-1022.
5. December 6, 2021: The Board instituted the *inter partes* review of the '229 patent, IPR2021-00951. *See* Paper 14.
6. January 6, 2022: Aristocrat Technologies, Inc. filed IPR2022-00408 challenging the '229 patent on the same grounds, using the same prior art and evidence. IPR2022-00408 has been joined to this proceeding. Paper 23.
7. May 13, 2022: The Federal Circuit issued a Rule 36 judgment, affirming the district court's determination that the '229 patent is patent-ineligible under § 101. Ex-1023.
8. June 21, 2022: The Federal Circuit issued a formal mandate, indicating that its Rule 36 judgment is final. Ex-1024.

NEXRF's deadline to appeal the Federal Circuit's Rule 36 judgment to the Supreme Court is August 11, 2022, but NEXRF has represented that it will not request review by the Supreme Court.

III. ARGUMENTS

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). The Board has broad authority to dismiss the Petition and terminate an *inter partes* review proceeding in all appropriate circumstances. See 37 C.F.R. § 42.72 (“[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).”); see *Facebook, Inc. v. EveryMD.com LLC*, IPR2017-02027, Paper 24 at 5 (P.T.A.B. Oct. 9, 2018).

Termination of this *inter partes* review is appropriate because the Federal Circuit’s patent ineligibility decision mooted all unpatentability grounds presented before the Board. In a parallel proceeding, the district court held, and the Federal Circuit affirmed through a Rule 36 judgment, that all claims of the ’229 patent are patent ineligible under § 101. See Ex-2006, Ex-1023. NEXRF did not request rehearing, and the Federal Circuit issued a formal mandate, indicating that the judgment is final. See Ex-1024. NEXRF’s counsel subsequently represented, and hereby confirms, that it will not appeal the Federal Circuit’s decision to the Supreme Court. Thus, the Federal Circuit’s Rule 36 affirmance is the final determination of the invalidity of the ’229 patent, which is not subject to any further review. Under these circumstances, it would be wasteful for the Board to continue to adjudicate unpatentability of the ’229 patent in this proceeding. Termination is also consistent with the Board’s practice. See e.g., *Facebook*,

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