

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IGT
Petitioner,

v.

ARISTOCRAT TECHNOLOGIES
AUSTRALIA PTY LTD.
Patent Owner

Case No. IPR2016-01170
Patent No. 7,326,113

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

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of October 3, 2016, Petitioner IGT and Patent Owner Aristocrat Technologies Australia Pty Ltd. jointly move to terminate the present *inter partes* review proceeding in light of the parties' settlement of their dispute insofar as it relates to U.S. Patent No. 7,326,113 ("the '113 patent"). The parties are filing, concurrently herewith, a true and complete copy of their written Settlement Agreement dated September 29, 2016, including Exhibits A-F thereto ("Settlement Agreement") (Confidential Exhibit 2003) in connection with this matter as required by the statute. The Settlement Agreement completely settles the parties' controversy and their dispute relating to the '113 patent as between Patent Owner and IGT, the Petitioner and real party-in-interest in the present proceeding, who was named as a Counterclaim Defendant in the U.S. district court litigation captioned *IGT v. Aristocrat Technologies, Inc.*, Case No. 2:15-cv-00473-GMN-GWF (United States District Court for the District of Nevada).

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioner, including any other collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b), other than the Settlement Agreement, including Exhibits A-F thereto.

The parties request that the Settlement Agreement (Confidential Exhibit 2003) be treated as business confidential information and kept separate from the file of the '113 patent. A joint request to treat the Settlement Agreement, including Exhibits A-F thereto, as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently herewith.

Termination with Respect to Inter Partes Review Proceeding

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.”

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). Each element is addressed below:

As for requirement (1), termination is appropriate in this proceeding because the parties have settled their dispute with respect to the '113 patent, and have agreed to terminate this *inter partes* review. The applicable statute, 35 U.S.C. § 317(a), 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.” In this case, the *inter partes* review is not at a stage in which the Office would have a complete enough record on which to make a decision on the merits. Although the Patent Owner’s Preliminary Response has been filed, the Board has not determined whether to institute trial. Moreover, as recognized by the rules of practice before the Board:

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.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As for requirements (2) and (4), the table below identifies parties in district court litigations involving the ’113 patent, and discusses the current status of these related litigations with respect to each party to the litigation. *See Heartland Tanning, Inc.*, Paper No. 26, at *2.

Case Caption	Parties	Current Status of Each Related Litigation With Respect to Each Party to the Litigation or Proceeding
<i>IGT v. Aristocrat Technologies, Inc.</i> , Case No. 2:15-cv-00473-GMN-GWF (United States District Court for the District of Nevada)	IGT, Aristocrat Technologies, Inc., Aristocrat Technologies Australia Pty Ltd, Aristocrat International Pty Ltd.	The parties will be filing a Stipulation and Order of Dismissal.

As for requirements (3) and (4), no other related *Inter Partes* Review proceedings for the '113 patent are currently before the U.S. Patent & Trademark Office.

Finally, as discussed above, the Settlement Agreement fully resolves all litigation and proceedings between the parties to this IPR proceeding relating to the '113 patent. The parties will be filing a Stipulation and Order of Dismissal in the district court litigation involving Petitioner IGT pursuant to Paragraph 2 of the Settlement Agreement.

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated.

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