

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, INC.,
Petitioner,

v.

MONKEYMEDIA, INC.,
Patent Owner.

Case IPR2018-00059
Patent 9,247,226 B2

Before MARC S. HOFF, LYNNE E. PETTIGREW, and
KAMRAN JIVANI, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Limit the Petition
37 C.F.R. §§ 42.1(b), 42.5(a)

The parties to this proceeding have filed, with our prior authorization,
a Joint Motion to Limit the Petition. Paper 24 (“Mot.”). For the reasons

discussed below, we grant the Joint Motion, and withdraw Grounds 2 and 3 of the Petition from consideration in this *inter partes* review.

BACKGROUND

Unified Patents, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–12 of U.S. Patent No. 9,247,226 B2 (Ex. 1001, “the ’226 patent”). Paper 2. On April 16, 2018, we instituted *inter partes* review of claims 1 and 7 on Ground 1 asserted in the Petition (obviousness over Lavallee, Gibson, Strickland, and Cohen), but declined to institute review on Grounds 2 and 3 asserted in the Petition (obviousness of claims 1–10 over Davenport and Efrat, and obviousness of claims 11 and 12 over Davenport, Efrat, and Bartok). Paper 15, 36.

On April 24, 2018, the Supreme Court issued its decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Subsequent to that decision, MONKEYmedia, Inc. (“Patent Owner”) filed a statutory disclaimer of claims 1 and 7 pursuant to 37 CFR § 1.321(a). Paper 18; Ex. 2010.

On May 15, 2018, the parties notified the Board by email that they had reached agreement to resolve this *inter partes* review. *See* Paper 25, 2. Specifically, the parties agreed that Patent Owner would request adverse judgment as to instituted claims 1 and 7, and that the parties would stipulate to a joint withdrawal/waiver of the currently non-instituted grounds and claims, thereby warranting termination of the IPR. *See id.* The Board authorized the parties to file such a joint Motion to Limit the Petition, and authorized Patent Owner to file a Motion for Adverse Judgment as to claims 1 and 7, in a teleconference on May 18, 2018. *See id.* The Board subsequently issued an order confirming that authorization. Paper 20. The parties filed the instant Joint Motion to Limit the Petition on June 5, 2018.

ANALYSIS

The parties jointly request the withdrawal of Grounds 2 and 3 of the Petition from consideration in this review, and request that the Board limit its consideration to Ground 1. Mot. 1. Under the circumstances presented here, we find it is appropriate to grant the parties' joint request. Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this *inter partes* review in a just, speedy, and inexpensive manner. See 37 CFR 42.1(b); *Apotex Inc. v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19). Accordingly, we grant the parties' Joint Motion to Limit the Petition. The obviousness challenges to claims 1–10 over Davenport and Efrat (i.e., Ground 2) and to claims 11 and 12 over Davenport, Efrat, and Bartok (i.e., Ground 3) are removed from this proceeding. The Petition is limited to review of claims 1 and 7 on the ground of obviousness over Lavalley, Gibson, Strickland, and Cohen.

ORDER

For the reasons discussed above, it is:

ORDERED that the parties' Joint Motion to Limit the Petition is *granted*;

FURTHER ORDERED that Grounds 2 and 3 of the Petition are hereby withdrawn from consideration in this *inter partes* review; and

FURTHER ORDERED that the Petition is limited to review of claims 1 and 7 on Ground 1 asserted in the Petition.

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