

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC.
Petitioner

v.

HYPERMEDIA NAVIGATION LLC
Patent Owner

Case IPR2019-00344
U.S. Patent No. 9,772,814

JOINT MOTION TO TERMINATE PROCEEDING

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, and the authorizing email communication from Andrew Kellogg of January 15, 2019, Petitioner Facebook, Inc. (“Facebook”) and Patent Owner Hypermedia Navigation, LLC (“Hypermedia”) jointly request termination of *Inter Partes* Review IPR2019-00344 seeking review of U.S. Patent No. 9,772,814 (“the ’814 Patent”).

II. STATEMENT OF FACTS

Review has not been instituted in this matter. Facebook’s petition for review was accorded the filing date of November 16, 2018. Hypermedia has not filed a preliminary response and one is not due until March 7, 2019. Effective December 31, 2018, the parties reached settlement of certain adversarial matters between them (“Settlement Agreement,” *see infra*). Specifically, the parties agreed to terminate the following adversarial matters:

- An action in the United States District Court for the Northern District of California, Case No. 4:17-cv-5383-HSG, regarding Hypermedia’s allegation of infringement of the ’814 Patent and U.S. Patent Nos. 7,383,323, 7,383,324, 7,424,523, 7,478,144, 7,769,830, 8,250,173, 9,083,672, and 9,864,575; and the alleged invalidity and unenforceability of those patents; and

- This *Inter Partes* Review action and *Inter Partes* Review actions pertaining the other above-listed patents.

III. ARGUMENT

A. Termination of this IPR is Appropriate

The Board should terminate this proceeding for at least the following reasons.

First, the statutory condition for termination under 35 U.S.C. § 317(a) is satisfied – this joint request for termination is being filed before the Board has decided the merits of the proceeding. Indeed, the Board has not yet issued a decision on the petition to institute a review.

Second, the parties have agreed to terminate this proceeding, in connection with their Settlement Agreement.

Third, the merits of the petition have not been determined, no motions or other matters are outstanding, and concluding this review at this early juncture promotes efficient use of the resources of the Board and saves expense for the parties.

B. A True Copy of the Parties' Settlement Agreement is Filed Herewith

The parties' Settlement Agreement has been made in writing, and a true and correct copy is filed herewith as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), as Exhibit 2001. A Joint Request to File a Settlement Agreement as Business Confidential Information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is also being filed herewith.

C. Estoppel

No estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner Facebook pursuant to 35 U.S.C. § 317(a).

D. Summary

For the foregoing reasons, Facebook and Hypermedia jointly and respectfully request termination of Case No. IPR2019-00344 involving U.S. Patent No. 9,772,814.

DATE: JANUARY 18, 2019

Respectfully submitted,
Cooley LLP

By: /Heidi L. Keefe/
Heidi L. Keefe
Reg. No. 40,673
Counsel for Petitioner

DATE: JANUARY 18, 2019

Respectfully submitted,
Wach LLP

By: /Michael L. Wach/
Michael L. Wach
Reg. No. 54,517
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Section 42.6, that a complete copy of the attached **JOINT MOTION TO TERMINATE PROCEEDING** and related documents, are being served via electronic mail on the 18th day of January, 2019, upon the Patent Owner's attorneys of record in this proceeding as follows:

Michael L. Wach (Reg. No. 54,517)
mikewachsr@gmail.com
WACH LLC

Jason M. Perilla (Reg. No. 65,731)
jason.perilla@thomashorstemeyer.com
THOMAS | HORSTEMEYER LLP

Adam L. Baumli (Reg. No. 64,433)
adam@baumlilawfirm.com
BAUMLI LAW FIRM PLLC

DATED: January 18, 2019

/ Heidi L. Keefe /
Heidi L. Keefe
Reg. No. 40,673

COOLEY LLP
ATTN: Patent Docketing
1299 Pennsylvania Ave. NW, Suite 700
Washington, D.C. 20004
Tel: (650) 843-5001
Fax: (650) 849-7400