

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYTE – VISUAL CONCEPTION LTD.,

Petitioner

v.

SLYCE ACQUISITION INC.,

Patent Owner.

U.S. Patent No. 9,152,624

Inter Partes Review No. IPR2020-00881

**SYTE – VISUAL CONCEPTION LTD. AND SLYCE ACQUISITION
INC.’S JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F. R. § 42.74, Petitioner Syte – Visual Conception Ltd. (“Syte”) and Patent Owner Slyce Acquisition Inc. (“Slyce”) jointly request termination of Inter Partes Review of U.S. Patent No. 9,152,624 (the “‘624 Patent”), Case No. IPR2020-00881.

The parties have reached a settlement agreement regarding the ‘624 Patent and have agreed to terminate this IPR2020-00881 as well as IPR2020-00880. No other IPRs are known to be pending against the ‘624 Patent. In accordance with 37 C.F.R. § 42.00(b), the parties received authorization from the Board, on October 8, 2020, to file this motion by October 13, 2020.

Termination of this proceeding is proper for at least the following reasons:

- The district court litigation, *Slyce Acquisition Inc., v. Syte-Visual Conception Ltd., et al.*, Case No. 6:19-CV-00257-ADA (W.D. Tex), involving the ‘624 Patent, has been settled. No other cases involve the ‘624 Patent, and the parties do not contemplate any litigation or proceeding involving the ‘624 Patent in the foreseeable future.
- The parties are jointly requesting termination. 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“There are strong public policy reasons to factor settlement between the parties to a proceeding.”).

- The Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a); 77 Fed. Reg. 48,768 (“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.”). This proceeding is still in its early stage and IPR2020-00881 has not been instituted.

This Settlement Agreement has been made in writing and a true and correct copy will be filed with this request as Exhibit 1120. Concurrently with this motion, the parties are submitting a joint request to treat the agreement as business confidential information and be kept separate from the files of the above captioned IPR pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceeding.

Therefore, Syte and Slyce respectfully request termination of Inter Partes Review of U.S. Patent No. 9,152,624, Case No. IPR2020-00881.

Date: October 8, 2020

Respectfully submitted,

/Guy Yonay/

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