

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owner.

IPR2016-01756
Patent 8,571,194 B2

Per Curiam.

TERMINATION
After Institution of Trial
37 C.F.R. § 42.72

The Federal Circuit vacated the Board’s final written decision in this case and remanded to the Board for proceedings consistent with *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d. 1320 (Fed. Cir. 2019). *Uniloc 2017 LLC v. Facebook, Inc.*, No. 18-2251, ECF No. 45 (Fed. Cir. Oct. 31, 2019) (“Remand Order”) (Exhibit 3001). The Federal Circuit’s mandate issued on June 3, 2020. *Id.* at ECF No. 50.

This case was held in abeyance on May 1, 2020, and that abeyance was lifted on October 26, 2021. Papers 40, 41. Pursuant to an email sent to the parties on January 18, 2022 (Exhibit 3002), the parties filed a Joint Proposed Procedure on Remand (Paper 42). The parties state that, in IPR2017-01683, the Board found unpatentable all claims of the patent at issue here— U.S. Patent No. 8,571,194 B2 (“the ’194 patent”)—and the Federal Circuit affirmed that decision. Paper 42, 2. The parties acknowledge that that affirmance “has effect here.” *Id.* Patent Owner proposes filing “an opposed motion to terminate under 37 C.F.R § 42.72.” *Id.* Petitioner asserts that “adverse judgment should be entered under 37 CFR § 42.73(b)(2).” *Id.*

No claims remain in the challenged patent. On March 11, 2019, an *inter partes* review certificate cancelled claims 1–5 based on the results of IPR2017-00597 (Exhibit 3003), and, on March 16, 2022, an *inter partes* review certificate cancelled claims 6–16 based on the results of IPR2017-01683 (Exhibit 3004). Petitioner asserts that adverse judgment should be entered, but judgments have already been entered that, together, resulted in the cancellation of all challenged claims (claims 1, 3–6, 8–11, and 13–15). Thus, under 37 C.F.R. § 42.73(b)(2), Patent Owner is precluded from taking action inconsistent with the prior judgments, including obtaining in any patent a claim that is not patentably distinct from a finally refused or canceled claim.

Because the challenged claims have been canceled, good cause exists to terminate this proceeding.

Accordingly, it is

ORDERED that this proceeding is terminated.

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