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Paper No. 38
Date Entered: July 12, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC AMERICA, INC.,
Petitioners,

v.

VIRGINIA INNOVATION SCIENCES, INC.,
Patent Owner.

Case IPR2017-00870 (Patent 7,899,492 B2)
Case IPR2017-00871 (Patent 8,050,711 B2)
Cases IPR2017-00872, -00873 (Patent 9,355,611 B1)
Case IPR2017-00874 (Patent 8,712,471 B2)
Case IPR2017-00875 (Patent 9,286,853 B2)
Cases IPR2017-00876, -00877 (Patent 8,903,451 B2)
Case IPR2017-00878 (Patent 8,948,814 B1)
Case IPR2017-00879 (Patent 9,118,794 B2)[1]

Before JAMESON LEE, MICHAEL W. KIM, TREVOR M. JEFFERSON, BRIAN J. McNAMARA and CHRISTA P. ZADO, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

JUDGEMENT
Granting Joint Motion to Terminate Proceeding
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.73, 42.74

[1] We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

On June 8, 2018, the Board authorized HTC America, Inc. ("Petitioner") and Virginia Innovation Sciences, Inc. ("Patent Owner") to file motions to terminate in the above-identified proceedings. Paper 33.[2] On June 21, 2018, the parties filed a Joint Motion to Terminate in each of the above-identified proceedings. Paper 34 ("Joint Motion" or "Joint Mot.").

The U.S. District Court has determined that the claims of each of the patents involved in the above identified *inter partes* reviews recite subject matter that is ineligible for patent protection under 35 U.S.C. § 101. *Virginia Innovation Sciences, Inc. v. Amazon.com, Inc.*, *Virginia Innovation Sciences, Inc. v. HTC Corporation*, No. 2:16-cv-00060 (E.D. Va.) (transferred to the Alexandria Division under case no. 1:16-cv-01350). The district court's decision has been affirmed by the Court of Appeals for the Federal Circuit under Fed. Cir. R. 36. *Virginia Innovation Sciences, Inc. v. HTC Corp.*, 718 Fed. Appx. 988, 2018 WL 1737020 (Fed. Cir. April 11, 2018) (non-precedential). The parties have jointly agreed to terminate the above-identified proceedings based on Patent Owner's decision not to seek rehearing or appeal of the Federal Circuit's decision. Joint Mot. 2. The parties have submitted their agreement in writing (Ex. 1041, 1042), and represent that the filed copies are true and correct copies. Joint Mot. 2.

[2] For expediency, we refer to the papers in IPR2017-00870. Similar papers were entered in IPR2017-00871 through IPR2017-00879.

Under 35 U.S.C. § 317(a), "[a]n inter partes review instituted under this chapter 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." The Board has not yet decided the merits of the above-identified proceedings, and final written decisions have not been entered. It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains in the *inter partes* review, the Office may terminate the review. The parties have not identified any other related matters. Under these circumstances, the Board determines that it is appropriate to enter judgment[3] and terminate the trials, with respect to both Petitioner and Patent Owner, without rendering final written decisions. *See* 37 C.F.R. §§ 42.5(a), 42.72.

It is, therefore,

ORDERED that the Joint Motions are GRANTED; and

FURTHER ORDERED that these proceedings are terminated as to all parties.

[3] A judgment means a final written decision by the Board, or a termination of a proceeding. 37 C.F.R. § 42.2.

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