Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner,

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owner.

Case IPR2023-00153
U.S. Patent No. 10,346,017
Filing Date: Aug. 13, 2018
Issue Date: July 9, 2019

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner and Patent Owner jointly move to terminate this *inter partes* review ("IPR"). The Board authorized the filing of this Joint Motion in an email dated October 16, 2024.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On August 9, 2022, the United States District Court for the Southern District of Texas found invalid under 35 U.S.C. § 101 all claims of U.S. Patent No. 10,346,017 (the "'017 Patent")—the patent subject to this IPR. *See generally Plotagraph, Inc. v. Lightricks, Ltd.*, 620 F. Supp. 3d 591 (S.D. Tex. 2022). Patent Owner appealed the district court's decision, first to the Court of Appeals for the Federal Circuit—which affirmed the decision (*see Plotagraph, Inc. v. Lightricks, Ltd.*, Case No. 2023-1048, slip op. (Fed. Cir. Jan. 22, 2024); Ex. 3002)—and then to the Supreme Court of the United States—which denied Patent Owner's petition for writ of certiorari (*see Plotagraph, Inc. v. Lightricks, Ltd.*, Case No. 24-312 (U.S. 2024), https://www.supremecourt.gov/search.aspx?filename=/docket/docketfiles/html/public/24-312.html), thereby rendering final the invalidity of all claims of the '017 Patent, including all claims subject to this IPR. Because no valid claims subject to this IPR currently exist, this IPR is therefore rendered moot and, accordingly, should be terminated.

Additionally, because the parties move for termination on grounds of mootness, rather than pursuant to a written settlement agreement between the parties, no such written settlement agreement need be filed with the Office pursuant to pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Dated: Oct. 17, 2024

/Robert Greeson/
Robert Greeson (Reg. No. 52,966)
Lead Counsel for Petitioner

Dated: Oct. 17, 2024

/Shawn Hunter/
Shawn Hunter (Reg. No. 36,168)
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), the undersigned certifies that on October 17, 2024, a copy of this Joint Motion to Terminate *Inter Partes* Review was served on Patent Owner via email (by consent) to:

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