

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIGHTRICKS LTD.,
Petitioner,

v.

PLOTAGRAPH, INC. and SASCHA CONNELLY,
Patent Owner.

IPR2023-00153 (Patent 10,346,017 B2)
IPR2023-00154 (Patent 10,621,469 B2)
IPR2023-00568 (Patent 11,182,641 B2)¹

Before PATRICK R. SCANLON, CHARLES J. BOUDREAU, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

AHMED, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in all three cases. We therefore exercise our discretion to issue one Order to be filed in each case. The parties may not use this style heading for any subsequent papers without authorization.

IPR2023-00153 (Patent 10,346,017 B2)
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INTRODUCTION

With the Board’s authorization, Lightricks Ltd. (“Petitioner”) and Plotagraph, Inc. and Sascha Connelly (“Patent Owner”) filed a Joint Motion to Terminate in each of the above-identified proceedings. Paper 27² (“Motion”).

DISCUSSION

Petitioner filed petitions requesting *inter partes* review of claims 1–18 of U.S. Patent No. 10,346,017 B2; claims 1, 2, 6–14, and 18 of U.S. Patent No. 10,621,469 B2; and claims 1–4, 8–15, 19, and 20 of U.S. Patent No. 11,182,641 B2. IPR2023-00153, Paper 1; IPR2023-00154, Paper 1; IPR2023-00568, Paper 1; Motion 1. On September 5, 2023, we instituted trial in IPR2023-00153 and IPR2023-00154; and on October 2, 2023, we instituted trial in IPR2023-00568. IPR2023-00153, Paper 9; IPR2023-00154, Paper 9; IPR2023-00568, Paper 7.

In the petitions, Petitioner informed us that, in parallel litigation, the U.S. District Court for the Southern District of Texas found the claims challenged in these proceedings to be directed to patent-ineligible subject matter under 35 U.S.C. § 101 and dismissed parallel litigation between the parties under Fed. R. Civ. P. 12(b)(6) for failure to state a claim. *See* IPR2023-00153, Paper 1, 93; IPR2023-00154, Paper 1, 96; IPR2023-00568, Paper 1, 93; Motion 1; *see also Plotagraph, Inc. v. Lightricks Ltd.*, 620 F. Supp. 3d 591, 602 (S.D. Tex. 2022). On January 22, 2024, the U.S. Court of

² Unless otherwise indicated, references to exhibits and papers numbers herein refer to IPR2023-00153. Similar motions were filed in IPR2023-00154 and IPR2023-00568. *See* IPR2023-00154, Paper 27, IPR2023-00568, Paper 25.

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Appeals for the Federal Circuit entered a decision affirming the district court's determination, and on March 26, 2024, the Federal Circuit denied Patent Owner's petition for *en banc* rehearing of that decision. *See Plotagraph, Inc. v. Lightricks, Ltd.*, No. 2023-1048, 2024 WL 223185 (Fed. Cir. Jan. 22, 2024); *Plotagraph, Inc. v. Lightricks, Ltd.*, No. 2023-1048, slip op. at 2 (Fed. Cir. Mar. 26, 2024) (Ex. 3002). On July 16, 2024, we entered an order extending the time of pendency in these proceedings in light of Patent Owner's representation that it had filed a petition for *writ of certiorari* from the Federal Circuit's decision with the U.S. Supreme Court. *See* IPR2023-00153, Paper 24; Ex. 3004.

In the Motion, the parties inform us that the Supreme Court has denied Patent Owner's petition. Motion 1 (citing *Plotagraph, Inc. v. Lightricks, Ltd.*, No. 24-312 (2024)). The parties contend that the district court's decision on invalidity of all challenged claims is now final, and these *inter partes* review proceedings have been rendered moot, and accordingly, should be terminated.

We have not yet decided the merits of these proceedings, and final written decisions have not been entered in these proceedings. We agree with the parties that termination of these proceedings is appropriate and *grant* the Motion.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is:

ORDERED that the Motion (IPR2023-00153, Paper 27,

IPR2023-00153 (Patent 10,346,017 B2)

IPR2023-00154 (Patent 10,621,469 B2)

IPR2023-00568 (Patent 11,182,641 B2)

IPR2023-00154, Paper 27; IPR2023-00568, Paper 25) is *granted* in each of the identified proceedings; and

FURTHER ORDERED that IPR2023-00153, IPR2023-00154, and IPR2023-00568 are *terminated* pursuant to 37 C.F.R. § 42.72.

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