

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AFFINITY NETWORK, INC.
Petitioner,

v.

TELIAX TECHNOLOGY LLC,
Patent Owner.

Case IPR2023-00412
Patent 9,807,249

JOINT MOTION TO TERMINATE PRE-INSTITUTION

I. INTRODUCTION

On April 5, 2023, the Board authorized Petitioner Affinity Network, Inc. (“ANI”) and Patent Owner Teliix Technology LLC (“Teliix”) (collectively, the “Parties”) to file a joint motion to terminate this proceeding. Accordingly, pursuant to 37 C.F.R. § 42.71(a), the Parties file this joint motion to terminate and respectfully request termination of the *inter parties* review (“IPR”) of U.S. Patent No. 9,807,249 (the “’249 Patent”), Case No. IPR2023-00412.

For the reasons explained below, the Parties request the Board to terminate IPR2023-00412 because the ’249 Patent has already been adjudged to be invalid and further to preserve the Board’s and Parties’ resources and promote a speedy and inexpensive resolution to this dispute. IPR2023-00412 is in its preliminary stage, and the Board has not yet issued a decision on institution in this proceeding. As such, the Board should grant this joint motion to terminate IPR2023-00412.

II. FACTUAL BACKGROUND

On October 19, 2022, the United States District Court for the District of Nevada entered a judgment of invalidity under 35 U.S.C. § 101 against the ’249 Patent. *Teliix Tech. LLC v. Affinity Network, Inc.*, No. 2:22-cv-00362-CDS-DJA, 2022 U.S. Dist. LEXIS 190751 (D. Nev. Oct. 19, 2022). On November 17, 2022, Teliix appealed the District Court’s judgment to the United States Court of Appeals for the Federal Circuit.

On December 24, 2022, in order to preserve its ability to file an IPR against the '249 Patent within the one year date set forth under 35 U.S.C. § 315(b) (had the '249 Patent survived the appeal), ANI filed the instant IPR petition seeking to invalidate all of the claims (Claims 1-20) of the '249 Patent.

On March 13, 2023, the Parties filed a joint stipulation of voluntary dismissal with the Federal Circuit seeking to dismiss Teliix's appeal. On March 15, 2023, in response to the Parties' joint stipulation, the Federal Circuit issued a mandate dismissing Teliix's appeal. *Teliix Tech. LLC v. Affinity Network, Inc.*, No. 2023-1197, 2023 U.S. App. LEXIS 6135 (Fed. Cir. Mar. 15, 2023). Teliix's appeal of the District Court's judgment of invalidity against the '249 Patent is therefore exhausted and the District Court's judgment is now final.

Teliix has not yet filed its Preliminary Patent Owner Response, due May 16, 2023, nor has the Board issued a decision on institution in this proceeding.

III. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

Consistent with 37 C.F.R. § 42.71(a) and the Board's precedent allowing parties to terminate IPRs pre-institution, good cause exists to terminate IPR2023-00412 because the underlying dispute in the district court between the parties has been finally resolved in Petitioner's favor via a final, non-appealable judgment of invalidity of all the claims of the '249 Patent. Accordingly, any further consideration of the '249 Patent would not be an efficient use of the Board's

resources. *See, e.g., Facebook, Inc. v. EveryMD.com LLC*, IPR2017-02027, Paper 24, at 9 (P.T.A.B. Oct. 9, 2018) (terminating the IPR and reasoning that “[a]ssessing amendments to claims that the courts have adjudicated, with finality, to be unpatentable ... is an inefficient use of the Board’s resources”).

Termination of this IPR is also appropriate here because this proceeding is in its preliminary stage – Teliix has not yet filed its Preliminary Patent Owner Response and the Board has not yet issued a decision on institution. Accordingly, terminating this IPR now would preserve the Board’s and the Parties’ resources and promote a speedy and inexpensive resolution to this dispute. *See, e.g., General Elec. Co. v. Siemens Gamesa Renewable Energy A/S*, IPR2021-00722, Paper 11 at 3 (P.T.A.B. Oct. 7, 2021) (granting motion to terminate “to promote efficiency and minimize unnecessary costs”); *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257, Paper 16 at 3 (P.T.A.B. Jan. 2, 2020) (same); *Samsung Elecs. Co. v. Nvidia Corp.*, IPR2015-01270, Paper 11 at 3-4 (same).

For the foregoing reasons, the Parties respectfully request the Board to dismiss the instant petition and terminate IPR2023-00412.

Dated: April 6, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned hereby certifies that on April 6, 2023, a copy of the foregoing JOINT MOTION TO TERMINATE PRE-INSTITUTION was served, via email, on Patent Owner's attorneys of record:

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