UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROKU, INC.,
Petitioner

v.

MEDIA CHAIN, LLC,
Patent Owner

Case IPR2022-00391
U.S. Patent No. 10,489,560

PETITIONER'S UNOPPOSED MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW

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PETITIONER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,489,560 ("'560 patent")
1002	Declaration of John Tinsman in Support of Petition for *Inter Partes* Review of U.S. Patent No. 10,489,560
1003	U.S. Patent Publication No. 2004/0010417 to Peled ("Peled")
1004	U.S. Patent Publication No. 2011/0191246 to Brandstetter *et al.* ("Brandstetter")
1005	U.S. Patent Publication No. 2005/0004873 to Pou *et al.* ("Pou")
1006	U.S. Patent Publication No. 2008/0140433 to Levy *et al.* ("Levy")
1007	U.S. Patent No. 7,818,261 to Weiskopf *et al.* ("Weiskopf")
1008	*Intentionally Left Blank*
1009	Prosecution History of U.S. Patent No. 9,715,581 ("'581 Prosecution History")
1010	Prosecution History of U.S. Patent No. 9,898,590 ("'590 Prosecution History")
1011	Prosecution History of U.S. Patent No. 10,489,560 ("'560 Prosecution History")
1012	Prosecution History of U.S. Patent No. 10,515,191 ("'191 Prosecution History")
1013	Prosecution History of U.S. Patent No. 10,860,691 ("'691 Prosecution History")
1014	Prosecution History of U.S. Patent No. 10,885,154 ("'154 Prosecution History")
1015	*Curriculum Vitae* of John Tinsman
1016	U.S. Patent No. 7,043,473 to Rassool *et al.* ("Rassool")
1017	Mary Madden, The State of Music Online: Ten Years After Napster, Pew Research Center (June 15, 2009)

Exhibit No.	Description
	(https://www.pewresearch.org/internet/2009/06/15/the-state-of-music-online-ten-years-after-napster/)
1018	U.S. Patent No. 8,185,475 to Hug ("Hug")
1019	U.S. Patent No. 8,051,130 to Logan ("Logan")
1020	"Digital Rights Management," FTC.org (March 25, 2009) (https://www.ftc.gov/news-events/events-calendar/2009/03/digital-rights-management)
1021	U.S. Patent No. 8,776,216 to Boccon-Gibod *et al.* ("Boccon-Gibod")
1022	Urs Gasser *et al.*, "Case Study: DRM-protected Music Interoperability and e-Innovation," Harvard.edu (November 2007) (https://dash.harvard.edu/bitstream/handle/1/2794938/DRM-protected+Music+Interoperability+and+eInnovation.pdf;jsessionid=FEC1E2A0F87ABB7EB30E41EA93AC1CAC?sequence=2)
1023	*Intentionally Left Blank*
1024	*Intentionally Left Blank*
1025	*Intentionally Left Blank*
1026	*Intentionally Left Blank*
1027	U.S. Patent Publication No. 2011/0314378 A1 to Nijim *et al.* ("Nijim")
1028	"Apple TV Coming to Your Living Room,"Apple.com (January 9, 2007) (https://www.apple.com/newsroom/2007/01/09Apple-TV-Coming-to-Your-Living-Room/)
1029	Jaap Haitsma, *et al.*, "A Highly Robust Audio Fingerprinting System," 3rd International Conference on Music Information Retrieval, Paris, France, October 13-17, 2002 ("Haitsma")
1030	U.S. Patent No. 9,554,176 to Gharaat *et al*. ("Gharaat")
1031	Alex Pappademas, "Mood music for the cyber set," CNN.com,

Exhibit No.	Description
	archived December 7, 2004 (https://web.archive.org/web/20041207191754/http:/archives.cnn.com/2000/TECH/computing/09/08/mood.music.idg/index.html)
1032	U.S. Patent No. 8,306,976 to Handman *et al.* ("Handman")
1033	U.S. Patent Publication No. 2006/0206478 to Glaser *et al.* ("Glaser")
1034	U.S. Patent No. 7,081,579 to Alcade *et al.* ("Alcade")
1035	Avery Li-Chun Wang, "An Industrial-Strength Audio Search Algorithm," 4th International Conference on Music Information Retrieval, Baltimore, Maryland, USA, October 27-30, 2003.
1036	Bryan Jacobs, "How Shazam Works To Identify (Nearly) Every Song You Throw At It," Gizmodo.com (September 24, 2010) https://gizmodo.com/how-shazam-works-to-identify-nearly-every-song-you-th-5647458
1037	European Patent Application Publication No. 1,558,032 to Widevine Technologies, Inc.
1038	U.S. Patent Publication No. 2013/0051772 to Ramaswamy *et al.* ("Ramaswamy")
1039	U.S. Patent No. 5,223,924 to Strubbe *et al.* ("Strubbe924")
1040	U.S. Patent Publication No. 2001/0056405 to Muyres *et al.* ("Muyres")
1041	U.S. Patent No. 7,603,382 to Halt, Jr. ("Halt")
1042	U.S. Patent No. 10,447,564 to Abraham *et al.* ("Abraham")
1043	U.S. Patent No. 8,583,089 to Ramer *et al.* ("Ramer")
1044	Laurie J. Flynn, "Like This? You'll Hate That. (Not All Web Recommendations Are Welcome.)," NYTIMES.com (January 23, 2006) (https://www.nytimes.com/2006/01/23/technology/like-this-youll-hate-that-not-all-web-recommendations-are.html)

Exhibit No.	Description
1045	U.S. Patent No. 8,375,131 To Rogers *et al.* ("Rogers")
1046	U.S. Patent Publication No. 2012/0233701 to Kidron ("Kidron")
1047	U.S. Patent No. 6,317,722 to Jacobi *et al.* ("Jacobi")
1048	U.S. Patent No. 8,352,331 to Dunning *et al.* ("Dunning")
1049	U.S. Patent Publication No. 2003/0086341 to Wells *et al.* ("Wells")
1050	U.S. Patent No. 7,178,720 to Strubbe *et al.* ("Strubbe")
1051	"Technological Protection Systems for Digitized Copyrighted Works: A Report to Congress," United States Patent and Trademark Office, 2002
1052	Richard Leeming, "DRM – 'digital rights' or 'digital restrictions' management?", EBU Technical Review, January 2007 (https://tech.ebu.ch/docs/techreview/trev_309-digital_rights.pdf)
1053	Jordi Ribas-Corbera, "Windows Media 9 Series – a platform to deliver compressed audio and video for Internet and broadcast applications," EBU Technical Review, January 2003 (https://tech.ebu.ch/docs/techreview/trev_293-ribas.pdf)
1054	*Intentionally Left Blank*
1055	Adrian Slywotzky, *et al.*, "The Future of Commerce," Harvard Business Review, January-February 2000 (https://hbr.org/2000/01/the-future-of-commerce)
1056	Benno Stein, *et al.*, "Near Similarity Search and Plagiarism Analysis," 29th Annual Conference of the German Classification Society (GfKI), Magdeburg, Germany, 2006
1057	Chow Kok Kent, *et al.*, "Features Based Text Similarity Detection," Journal of Computing, Vol. 2, Issue 1, January 2010
1058	Benjamin Cohen, "How can publishers limit e-book piracy?", Channel 4 News, October 18, 2009 (https://www.channel4.com/news/articles/arts_entertainment/books/

Exhibit No.	Description
	how%2Bcan%2Bpublishers%2Blimit%2Bebook%2Bpiracy/3391502.html)
1059	John Timmer, "Publishers cut book sharing deal with Scribd," Ars Technica, March 18, 2009 (https://arstechnica.com/information-technology/2009/03/publishers-cut-book-sharing-deal-with-scribd/)
1060	Eric A. Robinson, "Digital Rights Management, Fair Use, and Privacy: Problems for Copyright Enforcement through Technology," University of St. Augustine, December 2009 (https://orcid.org/0000-0001-9554-8754)
1061	U.S. Patent Publication No. 2012/0020647 to Vogel ("Vogel")
1062	*Intentionally Left Blank*
1063	U.S. Patent Application Publication No. 2003/0028796 to Roberts et al. ("Roberts")
1064	Complaint, *Media Chain LLC v. Roku, Inc.*, WDTX-1-21-cv-00027 ("Complaint")
1065	Order on Motion to Transfer, Media Chain LLC v. Roku, Inc., WDTX-1-21-cv-00027 ("Motion to Transfer Order")
1066	Scheduling Order, Media Chain LLC v. Roku, Inc., WDTX-1-21-cv-00027 ("Scheduling Order")
1067	*Intentionally Left Blank*
1068	*Intentionally Left Blank*
1069	Affidavit of Service, *Media Chain, LLC v. Roku, Inc.*, Case No. 1:21-cv-00027-LY (W.D. Tex.), filed January 26, 2021.
1070	Plantiff's Response, *Media Chain LLC v. Roku, Inc.*, WDTX-1-21-cv-00027
1071	Case Management Conference Order in Reassigned Case, *Media Chain, LLC v. Roku, Inc.*, Case No. 1:21-cv-00027-EMC (N.D. Cal.), filed December 22, 2021.

Exhibit No.	Description
1072	U.S. Patent No. 9,715,581 to Estes ("'581 Patent")
1073	U.S. Patent No. 9,898,590 to Estes ("'590 Patent")
1074	*Intentionally Left Blank*
1075	U.S. Patent No. 10,515,191 to Estes ("'191 Patent")
1076	U.S. Patent No. 10,860,691 to Estes ("'691 Patent")
1077	U.S. Patent No. 10,885,154 to Estes ("'154 Patent")
1078	*Intentionally Left Blank*
1079	*Intentionally Left Blank*
1080	California Northern District Time to Milestones, Docket Navigator, accessed January 4, 2022.
1081-1099	*Intentionally Left Blank*
1100	Settlement Agreement (CONFIDENTIAL)

Petitioner Roku, Inc. ("Petitioner"), hereby moves for an order dismissing the Petition for *Inter Partes* Review (IPR) filed on January 10, 2022, directed to U.S. Patent No. 10,489,560 ("the '560 patent") and assigned case number IPR2022-00391. Petitioner has conferred with Patent Owner, who does not oppose this motion.

Patent Owner did not filed a preliminary response. The Board has yet to issue a decision to institute trial.

I. REASONS WHY TERMINATION IS APPROPRIATE

On May 16, 2022, the Board provided email authorization to Petitioner to file this Motion to Dismiss the Petition. Dismissal is proper because this IPR proceeding is still in its early stages, and the Board has not yet "decided the merits of the proceeding." *Samsung Electronics Co., Ltd. et al v. Neodron Ltd.*, IPR2020-01682, Paper 14, 3 (P.T.A.B. Feb. 18, 2021); *see also Samsung Electronics Co., Ltd. v. Fundamental Innovation Systems Int'l*, IPR2018-00605, Paper 10, 2 (P.T.A.B. July 16, 2018) (noting that 35 U.S.C. § 317 "does not govern settlement prior to institution," but explaining that "it is appropriate to dismiss the proceedings pursuant to 37 C.F.R. § 42.71(a)"). Accordingly, dismissal is appropriate here.

Petitioner is filing herewith as Exhibit 1100 a true copy of the confidential settlement agreement entered between the parties. *See* 37 C.F.R. § 42.74(c). The

confidential settlement agreement was entered into in contemplation of the dismissal of the Petition. There are no collateral agreements or understandings made in connection with, or in contemplation of, the dismissal of the Petition. *See* 37 C.F.R. § 42.74(b). A request is being filed herewith to treat this agreement as "business confidential information" and to keep it separate from the files of the involved patent. *See* 37 C.F.R. § 42.74(c).

II. STATUS OF PROCEEDINGS INVOLVING THE CHALLENGED PATENT

The '560 patent is currently at issue in the related litigation *Roku, Inc. v. Media Chain, LLC*, Case No. 3:21-cv-09528 (N.D. Cal.). Petitioner and Patent Owner have agreed to terminate that litigation pursuant to their confidential settlement agreement.

The parties do not contemplate any other litigation or proceeding between the parties concerning the '560 patent in the foreseeable future.

III. CONCLUSION

The parties have settled all disputes relating to the challenged patent. This *inter partes* review is in an early stage, and the Board has not entered an institution decision in this proceeding. Accordingly, Petitioner respectfully requests that the Board dismiss the Petition and terminate this proceeding in its entirety.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Lestin L. Kenton/

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Date: June 1, 2022

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that true and correct copies of the foregoing **PETITIONER'S UNOPPOSED MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW** and **EXHIBIT 1100 (Confidential)** were electronically served in their entireties on June 1, 2022, on the following party via email:

Christopher A. Estes chris@mediachainllc.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Lestin L. Kenton/

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Date: June 1, 2022

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