UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROKU, INC.,
Petitioner

v.

MEDIA CHAIN, LLC,
Patent Owner

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Case IPR2022-00393
U.S. Patent No. 10,860,691

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**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. 10,860,691 to Estes ("'691 Patent") |
| **1002** | Declaration of John Tinsman |
| **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** | U.S. Patent Publication No. 2013/0166921 to Vijay *et al.* ("Vijay") |
| **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) (https://www.pewresearch.org/internet/2009/06/15/the-state-of- |

| Exhibit No. | Description |
|---|---|
| | 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, archived December 7, 2004 |

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| | (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) |
| **1045** | U.S. Patent No. 8,375,131 To Rogers *et al.* ("Rogers") |

| Exhibit No. | Description |
|---|---|
| **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/how%2Bcan%2Bpublishers%2Blimit%2Bebook%2Bpiracy/3391502.html) |

| Exhibit No. | Description |
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| **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** | Daniel A Keim, et al. "Literature Fingerprinting: A New Method for Visual Literary Analysis," IEEE, 2007 |
| **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** | U.S. Patent No. 7,577,703 to Boucher et al. ("Boucher") |
| **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** | Plaintiff's Response, *Media Chain LLC v. Roku, Inc.*, WDTX-1-21-cv-00027 ("Plaintiff's Response") |
| **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. |
| **1072** | U.S. Patent No. 9,715,581 to Estes ("'581 Patent") |

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| **1073** | U.S. Patent No. 9,898,590 to Estes ("'590 Patent") |
| **1074** | U.S. Patent No. 10,489,560 to Estes ("'560 Patent") |
| **1075** | U.S. Patent No. 10,515,191 to Estes ("'191 Patent") |
| **1076** | *Intentionally Left Blank* |
| **1077** | U.S. Patent No. 10,885,154 to Estes ("'154 Patent") |
| **1078** | U.S. Patent Publication No. 2007/0150299 A1 to Flory *et al.* ("Flory") |
| **1079** | U.S. Patent No. 7,555,489 to Bell ("Bell") |
| **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. 10,860,691 ("the '691 patent") and assigned case number IPR2022-00393. 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 '691 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 '691 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/

Lestin L. Kenton (Reg. No. 72,314)
*Attorney for Petitioner Roku, Inc.*

Date: June 1, 2022

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

# 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/

Lestin L. Kenton (Reg. No. 72,314)
*Attorney for Petitioner Roku, Inc.*

Date: June 1, 2022

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600