

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC
Petitioner

v.

NOBLEWOOD IP LLC
Patent Owner

Case No. IPR2022-01111
U.S. Patent 7,941,553

**JOINT MOTION TO TERMINATE
INTER PARTES REVIEW OF U.S. PATENT 7,941,553
UNDER 37 C.F.R. 42.72**

Pursuant to 37 C.F.R. 42.72, Petitioner Unified Patents, LLC, and Patent Owner Noblewood IP LLC, jointly request dismissal and termination of the petition for *Inter Partes* Review (“IPR”) of U.S. Patent 7,941,553 in IPR2022-01111. Petitioner and Patent Owner have entered into a written confidential agreement that fully resolves this matter. The Parties are concurrently filing a copy of the agreement as Exhibit 1016 along with a motion to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. The undersigned represents that there are no other collateral agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the dismissal of the petition and that Exhibit 1016 represents a true and accurate copy of the agreement between the Parties that resolves the present proceeding. On December 13, 2022, the Parties informed the Board of the resolution via email and requested authorization to file a joint motion to terminate the petition with respect to both the Patent Owner and the Petitioner and a joint motion to keep the agreement confidential and separate from the file of U.S. Patent 7,941,553. As set forth in an email dated December 13, 2022, the Board authorized the filing of the requested joint motion to terminate this petition and joint motion to keep the agreement confidential and separate. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

The Board’s authorization included instructions to the parties to update the Board “concerning the status of any litigation or proceeding, including, but not limited to proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future.” The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the dismissal of the Petition outside of EX1016. Additionally, the parties provide the following table outlining the status of cases involving the patent-at-issue:

Case	Status	Filed	Terminated
Noblewood IP LLC v. Slalom, LLC, 6:22-cv-01242 (W.D.Tex.)	Open	Nov 30, 2022	N/A
Noblewood IP LLC v. WMK, LLC, 6:22-cv-01126 (W.D.Tex.)	Open	Oct 27, 2022	N/A
Noblewood IP LLC v. AutoZone, Inc., 6:22-cv-01125 (W.D.Tex.)	Open	Oct 27, 2022	N/A
Noblewood IP LLC v. DHL Express (USA), Inc., 6:22-cv-01127 (W.D.Tex.)	Open	Oct 27, 2022	N/A
Noblewood IP LLC v. Hexagon Mfg. Intelligence Inc, 3:22-cv-02399 (N.D.Tex.)	Open	Oct 27, 2022	N/A
Noblewood IP LLC v. Rarefied Atmosphere, Inc, 6:22-cv-00903 (W.D.Tex.)	Open	Aug 31, 2022	N/A
Noblewood IP LLC v. So. Newspapers Inc., 5:22-cv-00064 (S.D.Tex.)	Settled	Jun 30, 2022	Dec 2, 2022

Case	Status	Filed	Terminated
Noblewood IP LLC v. The McClatchy Co. LLC, 3:22-cv-01421 (N.D.Tex.)	Settled	Jun 30, 2022	Sep 23, 2022
Noblewood IP LLC v. DallasNews Corp., 3:22-cv-01420 (N.D.Tex.)	Settled	Jun 30, 2022	Oct 24, 2022
Noblewood IP LLC v. Alamo Drafthouse Cinemas, LLC, 9:22-cv-00084 (E.D.Tex.)	Settled	May 27, 2022	Jul 1, 2022
Noblewood IP LLC v. Wolters Kluwer U.S. Corp., 1:22-cv-00690 (D.Del.)	Settled	May 27, 2022	Nov 17, 2022
Noblewood IP LLC v. Everyday Health, Inc., 1:22-cv-00269 (D.Del.)	Settled	Feb 28, 2022	Jul 19, 2022
Noblewood IP LLC v. Dotdash Meredith, Inc., 1:22-cv-00267 (D.Del.)	Settled	Feb 28, 2022	Jun 15, 2022
Noblewood IP LLC v. Strengthen Lengthen Tone, LLC, 1:22-cv-01683 (S.D.N.Y.)	Settled	Feb 28, 2022	Jun 16, 2022
Noblewood IP LLC v. Wolters Kluwer, N.V., 4:22-cv-00136 (E.D.Tex.)	Settled	Feb 25, 2022	May 27, 2022
Noblewood IP LLC v. Pure Barre, LLC, 4:22-cv-00135 (E.D.Tex.)	Settled	Feb 25, 2022	Jun 21, 2022
Noblewood IP LLC v. Virtucom Inc, 3:22-cv-00227 (N.D.Tex.)	Settled	Jan 31, 2022	May 17, 2022
Noblewood IP LLC v. The New York Times Co., 1:22-cv-00842 (S.D.N.Y.)	Settled	Jan 31, 2022	May 12, 2022
Noblewood IP LLC v. Fox News Network, LLC et al, 1:22-cv-00135 (D.Del.)	Settled	Jan 31, 2022	Apr 20, 2022
Noblewood IP LLC v. ViacomCBS Inc., 1:22-cv-00134 (D.Del.)	Settled	Jan 31, 2022	Jun 6, 2022
Noblewood IP LLC v. NBCUniversal Media, LLC, 1:22-cv-00133 (D.Del.)	Settled	Jan 31, 2022	Mar 11, 2022

Further, at the present, Patent Owner states that no further litigation or proceeding involving the patent-at-issue is contemplated in the foreseeable future.

Public policy favors terminating the present petition for IPR. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012). Ending this petition for IPR early promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680 (Aug. 14, 2012). Permitting termination provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation. Additionally, termination of

this petition for IPR is appropriate as the Board has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012).

Unified filed its petition for *Inter Partes* Review on June 13, 2022, and the Board issued a notice of filing date accorded on June 22, 2022. No other substantive papers have been filed. The Parties have now resolved their dispute and reached agreement to terminate this proceeding. Additionally, there are no other pending USPTO proceedings regarding the patent-at-issue. The USPTO can conserve its resources through terminating now, removing the need for the Board to further consider the arguments and to render an Institution Decision or Final Decision.

Therefore, the Parties respectfully request termination of this *Inter Partes* Review of U.S. Patent 7,941,553.

Dated: December 15, 2022

Respectfully Submitted,

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Michelle Aspen, Reg. No. 75,665
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Counsel for Petitioner

BY: /Erin Madill/
Erin Madill, Reg. No. 46,893

Counsel for Patent Owner

UPDATED APPENDIX OF EXHIBITS

Per 37 C.F.R. § 42.63(e), Petitioner provides an updated listing of exhibits:

Exhibit	Description
1001	US Patent 7,941,553 to Baumeister et al.
1002	Prosecution File History of US Application 10/624,353
1003	US Patent 7,013,322 to Nils Lahr
1004	WO 00/29990 to Lewis et al.
1005	US Patent 5,996,015 to Day et al.
1006	US Patent 6,493,748 to Nakayama et al.
1007	Declaration of Dr. Henry H. Houh
1008	“An overview of videostreaming on the internet and its application to surgical education,” Rosser et al., Surgical Endoscopy, 2001
1009	RFC 1738 (1994)
1010	Declaration of Kevin Jakel
1011	“The Apache HTTP Server Project,” IEEE Internet Computing, July-August 1997, pp. 88–90.
1012	Microsoft Computer Dictionary (5 th ed.) (excerpts)
1013	US Patent 6,594,699 to Sahai et al.
1014	“Streaming-Media Knowledge Discovery,” Pieper et al., IEEE Computing 2001, pp. 68–74.
1015	“The workings of clients and servers in WWW,” Nigel Edwards, 1994.
1016	Confidential Agreement

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on December 15, 2022, a complete and entire copy of this **Joint Motion to Terminate**, along with Confidential **Exhibit 1016**, were provided via email to the Patent Owner by serving Patent Owner's counsel in this proceeding, listed below:

Erin Madill, emadill@ip-edge.com

Dated: December 15, 2022

Respectfully submitted,

BY: /Ashley Cheung/
Ashley Cheung

Paralegal for Petitioner