

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK CORPORATION, DISH NETWORK L.L.C., AND DISH
NETWORK SERVICE L.L.C.,

Petitioners

v.

ENTROPIC COMMUNICATIONS, LLC,

Patent Owner.

PTAB Case No. IPR 2023-00393

Patent No. 8,792,008

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72, 42.74**

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board’s authorization by email dated September 11, 2023, Petitioners DISH Network Corporation, DISH Network L.L.C., and Dish Network Service L.L.C. (collectively, “DISH”) and Patent Owner Entropic Communications, Inc. (“Entropic”) jointly move to terminate the present *inter partes* review proceeding pursuant to an agreement agreed to by DISH and Entropic (the “Agreement”). The Agreement completely resolves all pending controversies between DISH and Entropic concerning U.S. Patent No. 8,792,008 (the “’008 patent”).

The parties are concurrently filing a true copy of the Agreement in connection with this matter as required by statute. The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Agreement be treated as business confidential information and kept separate from the file of the ’008 patent. A joint request for such treatment pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently herewith.

II. STATEMENT OF FACTS

Entropic asserted the '008 patent against DISH in a district court lawsuit captioned *Entropic Communications, LLC v. DISH Network Corp., et al.*, No. 2:22-cv-07959-JWH-JEMx (C.D. Cal.) (transferred from No. 2:22-cv-00075 (E.D. Tex.)) (“the Entropic Litigation”).

On February 6, 2023, DISH filed a petition for *inter partes* review against the '008 patent. The Board has not yet issued a decision regarding institution of a trial in this case.

On September 8, 2023, the parties entered into the Agreement pursuant to which they agreed, among other things, to dismiss with prejudice the '008 patent from the Entropic Litigation and to seek termination of this IPR proceeding.

III. LEGAL STANDARD

35 U.S.C. § 317(a) provides that “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that the Board “expects

that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Consolidated Trial Practice Guide (November 2019) at 86.

IV. GOOD CAUSE EXISTS TO TERMINATE THIS PROCEEDING.

Termination of the instant IPR is appropriate because the parties have resolved their entire dispute concerning the '008 patent and the Board has not yet decided whether to institute a trial in this proceeding. *See, e.g., Celco Partnership d/b/a Verizon Wireless v. AGIS Software Development LLC*, IPR2022-01350, Paper 9 at 2 (P.T.A.B. Jan. 24, 2023) (finding good cause to terminate IPR proceeding prior to institution decision based on settlement agreement). Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding.

V. CONCLUSION

Petitioners and Patent Owner respectfully request that the Board grant the parties' Joint Motion and terminate this proceeding. The parties also request that the Board grant the parties' joint request to treat the Agreement as business confidential information and keep it separate from the file of the '008 patent and this *inter partes* review proceeding.

Dated: September 11, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72, 42.74** has been served on the following counsel of record for Patent Owner:

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