UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION,

PETITIONER,

v.

ALEXANDER I. SOTO and WALTER G. SOTO

PATENT OWNERS

IPR2023-00680
PATENT 9,887,795

JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74

Patent Owners' Exhibit List

Exhibit	Description
2001	Public file history of application 11/772,187
2002	Public file history of application 12/512,968
2003	U.S. Pub. No. 2007/0031153 to Aronson et al.
2004	U.S. Pub. No. 2002/0181895 to Gilliland et al.
2005	U.S. Pub. No. 2001/0035997 to Agazzi ("Agazzi '997")
2006	Comparison of Excerpted Figures from Agazzi '997 (Ex. 2005) and Agazzi '341 (Ex. 1009)
2007	Email chain from Petitioner's counsel to Patent Owners' counsel.
2008	Public file history of Patent 10,263,723
2009	Public file history of Patent 10,771,181
2010	Chain of Emails Between Counsel for Nokia and Special Appearance Counsel for Patent Owners, Redacting the Username and Password, Exhibit from *Nokia of Am. Corp. v. Alexander Soto and Walter Soto*, IPR2023-00960.
2011	Chain of emails between Infinera's counsel and Patent Owners' counsel regarding discovery, Exhibit from *Infinera Corp. v. Alexander Soto and Walter Soto*, IPR2023-00834.
2012	Chain of emails providing authorization from the Board for supplemental arguments and exhibits
2013	Consolidation Order from *NextGen Innovations, LLC v. Nokia of Am. Corp.*, 2:23-cv-00637-JRG-RSP (E.D. Tex. Jan 30, 2024)
2014	Order for Scheduling Conference from *NextGen Innovations, LLC v. Nokia of Am. Corp.*, 2:23-cv-00637-JRG-RSP (E.D. Tex. Apr. 17, 2024)
2015	Memorandum Regarding: *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation*

2016	Joint Motion to Stay All Deadlines and Notice of Resolution (with AT&T) from *NextGen Innovations, LLC v. Fujitsu Network Communications, Inc.*, No. 2:22-cv-00307-JRG-RSP (E.D. Tex. Mar. 29, 2024)
2017	Chain of emails between counsel for the parties, with Patent Owner seeking permission to file excerpts of expert report and Petitioner denying permission.
2018	U.S. Pat. No. 7,206,366 to Fujimori et al.
2019	Chain of emails between counsel for Patent Owners and counsel for Nokia regarding extensions in view of settlement in IPR2023-00960.
2020	Copy of "AMP Schematic, 'Plug Assembly, 64 Position, Self-Retained, Action Pin, Champ-Lok'" submitted as non-patent literature in the Sept. 4, 2017 IDS in App. 15/095,137 (corresponding to Patent 9,887,795).
2021	Joint Stipulation of Dismissal With Prejudice Pursuant to Rule 41(a)(1)(A)(ii) in *NextGen Innovations, LLC v. Nokia of America Corp.*, No. 2:23-cv-00637-JRG-RSP, Dkt. 742 (E.D. Tex. Jan 1, 2025), consolidated with *NextGen Innovations, LLC v. Nokia of America Corp.*, No. 2:22-cv-00309-JRG-RSP (E.D. Tex.).
2022	Dismissal Order in *NextGen Innovations, LLC v. Nokia of America Corp.*, No. 2:23-cv-00637-JRG-RSP, Dkt. 742 (E.D. Tex. Jan 1, 2025), consolidated with *NextGen Innovations, LLC v. Nokia of America Corp.*, No. 2:22-cv-00309-JRG-RSP (E.D. Tex.).
2023	Email correspondence between counsel for Patent Owners and counsel for Petitioner regarding dismissal of this Petition.

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly request termination of this proceeding, IPR2023-00680. The Parties were authorized to file this Joint Motion by the Board (via e-mail) on January 7, 2024.

The parties seek to terminate this proceeding because the Parties have resolved their dispute, and because the underlying litigations has been dismissed, and the Parties no longer desire to expend resources maintaining this proceeding. *See* Exs. 2021 (Joint Stipulation of Dismissal); Ex. 2022 (Dismissal Order in *NextGen Innovations, LLC v. Nokia of America Corp.*, No. 2:23-cv-00637-JRG-RSP, Dkt. 742 (E.D. Tex. Jan 1, 2025), consolidated with *NextGen Innovations, LLC v. Nokia of America Corp.*, No. 2:22-cv-00309-JRG-RSP (E.D. Tex.)).

RELATED AGREEMENTS

As represented previously by the parties, there is no written settlement agreement between the parties. Nevertheless, Exhibit 2023 is confirmation of the parties' agreement as it relates to this IPR that Nokia moves to withdraw and jointly moves to terminate the proceedings.

STATEMENT OF PRECISE RELIEF REQUESTED

The Parties jointly request the Board terminate this proceeding in its entirety. Termination of this proceeding is appropriate because a settlement has been reached. "An *inter partes* review 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 proceedings before the request for termination is filed." 35 U.S.C. § 317(a).

Good cause exists to terminate this proceeding because: (1) Patent Owners' and Petitioners resolved their disputes regarding the challenged patent; and (2) "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding" (Consolidated Trial Practice Guide ("TPG") at 86 (November 2019)); (3) the Board has granted late-stage termination in other proceedings, even after oral arguments (*see, e.g.*, *Nissan North America, Inc. & Nissan Motor Co., Ltd., v. Blitzsafe Tex.*, LLC, IPR2016-00418, Paper 50; *SZ DJI Tech. Co., Ltd. & Parrot Inc. v. Drone-Control, LLC*, IPR2018-00204, IPR2018-00205, IPR2018-00206, IPR2018-00207, IPR2018-00208, Paper 42); and (4) termination would serve the interests of judicial economy and both Parties.

CONCLUSION

The Parties have settled all disputes relating to the challenged Patent. The Board has not entered a final written decision on the merits. Accordingly, the Parties jointly and respectfully request that the Board terminate the instant proceeding in its entirety.

Dated: February 3, 2025

Respectfully submitted,

/ Qi Tong /
Qi (Peter) Tong (Reg. No. 74,292)
RUSS AUGUST & KABAT

8080 N. Central Expy., Suite 1503
Dallas, TX 75206
Telephone: 310-826-7474
Facsimile: 310-826-6991
E-mail: PTong@raklaw.com

Counsel for Patent Owners

/ M. Scott Stevens /
M. Scott Stevens
Reg. No. 54,762
ALSTON & BIRD LLP
Vantage South End
1120 South Tryon Street, Suite 300
Charlotte, NC 28280-4000
Phone: 704.444.1025
Fax: 704.444.1935
Email: scott.stevens@alston.com

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on February 3, 2025, a complete copy of the foregoing JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74 was served on Petitioners via email (by consent) at:

M. Scott Stevens (Reg. No. 54,762)
scott.stevens@alston.com
Karlee N. Wroblewski (Reg. 76,805)
karlee.wroblewski@alston.com

Dated: February 3, 2025

/ Qi Tong /
Qi Tong (Reg. No. 74,292)
RUSS AUGUST & KABAT
8080 N. Central Expy., Suite 1503
Dallas, TX 75206
(310) 826-7474

Attorney for Patent Owners