

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

IPR2023-00960
PATENT 8,238,754

**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	Email from PTAB, dated July 20, 2023
2002	Chain of Emails Between Counsel for Nokia and Special Appearance Counsel for Patent Owners, Redacting the Username and Password
2003	Excerpt of JOSEPH W. GLANNON, <i>Civil Procedure, in</i> EXAMPLES & EXPLANATIONS (Aspen Publishers, 6th ed. 2008).
2004	Transcript of August 23, 2023 Teleconference Hearing
2005	U.S. Pat. Pub. No. 2002/0067529 to Yokomoto et al. ("Yokomoto")
2006	U.S. Pat. Pub. No. 2002/0006111 to Akita et al. ("Akita")
2007	U.S. Pat. Pub. No. 2003/0091045 to Choi et al. ("Choi")
2008	U.S. Pat. No. 5,572,349 to Hale et al. ("Hale")
2009	U.S. Pat. Pub. No. 2004/0052274 to Wang et al. ("Wang")
2010	U.S. Pat. No. 7,031,343 to Kuo et al. ("Kuo")
2011	U.S. Pat. No. 6,023,467 to Abdelhamid et al. ("Abdelhamid")
2012	U.S. Pat. No. 6,498,667 to Masucci et al ("Masucci")
2013	U.S. Pat. No. 6,778,339 to Medina et al. ("Medina")
2014	Excerpt of Plaintiff NextGen Innovations, LLC's Responses to Defendants' First Set of Common Interrogatories
2015	U.S. Pat. No. 7,925,162 to Soto et al.
2016	Declaration of Andrew D. Weiss in Support of Motion to Appear <i>Pro Hac Vice</i>
2017	Declaration of Paul A. Kroeger in Support of Motion to Appear <i>Pro Hac Vice</i>
2018	Declaration of Benjamin T. Wang in Support of Motion to Appear <i>Pro Hac Vice</i>

2019	Transcript of April 22, 2024 Teleconference Hearing
2020	Claim Construction Order from <i>NextGen Innovations, LLC v. Fujitsu Network Communications, Inc.</i> , No. 2:22-cv-00307-JRG-RSP (E.D. Tex. Dec. 22, 2023).
2021	Transcript from the Deposition of Dr. Prucnal in IPR2023-00960 (June 29, 2024).
2022	Public File History of Application 60/485,072
2023	Opening Expert Report of Dr. Paul Prucnal Regarding Invalidity of U.S. Patent No. 8,238,754 from <i>NextGen Innovations, LLC v. Nokia of Am. Corp.</i> , No. 2:22-cv-00309-JRG-RSP (E.D. Tex.)
2024	Email from Nokia's counsel agreeing to de-designate confidentiality of Exhibit 2023.
2025	Data Sheet for Motorola ONT6000 GPON ONT for Multi-Dwelling Unit, available at https://www.broadbandsoho.com/PDF/Datasheet_ONT6000GVT.pdf (accessed June 30, 2024)
2026	Data Sheet for Motorola AXS1800 GPON Optical Line Terminal, available at https://www.klonex.com.pl/media/produkty/pdf/motorola-axs1800.pdf (accessed June 30, 2024).
2027	Public File History of Application 60/515,836
2028	Demonstrative Exhibit PRUCNAL009 from the Deposition of Dr. Prucnal in IPR2023-00960 (June 29, 2024).
2029	U.S. Pat. No. 10,771,181 to Soto and Soto.
2030	Rebuttal Expert Declaration of Dr. Willner, <i>Nokia of Am. Corp. v. Alexander Soto and Walter Soto</i> , IPR2023-00960 (July 9, 2024).
2031	Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019).
2032	Joint Stipulation of Dismissal With Prejudice Pursuant to Rule 41(a)(1)(A)(ii) in <i>NextGen Innovations, LLC v. Nokia of America Corp.</i> , No. 2:23-cv-00637-JRG-RSP, Dkt. 742 (E.D. Tex. Jan 1, 2025), consolidated with <i>NextGen Innovations, LLC v. Nokia of America Corp.</i> , No. 2:22-cv-00309-JRG-RSP (E.D. Tex.).
2033	Dismissal Order in <i>NextGen Innovations, LLC v. Nokia of America Corp.</i> , No. 2:23-cv-00637-JRG-RSP, Dkt. 742 (E.D. Tex. Jan 1,

	2025), consolidated with <i>NextGen Innovations, LLC v. Nokia of America Corp.</i> , No. 2:22-cv-00309-JRG-RSP (E.D. Tex.).
2034	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, IPR2023-00960. 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. 2032 (Joint Stipulation of Dismissal); Ex. 2033 (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 2034 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)

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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:

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