

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

J&H WEB TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00108
U.S. Patent No. 8,935,342

JOINT MOTION TO TERMINATE PROCEEDING

LIST OF EXHIBITS

LIST OF NEWLY FILED EXHIBITS

The following exhibit is being filed with this Joint Motion to Terminate Proceeding and concurrent Joint Request to Treat the Parties' Settlement Agreement as Business Confidential Information and be Kept Separate:

No.	Description
1032	Confidential Settlement Agreement

LIST OF PREVIOUSLY FILED EXHIBITS

No.	Description
1001	U.S. Patent No. 8,935,342 (“ the ’342 patent ”)
1002	File History of U.S. Patent No. 8,935,342
1003	Declaration of Loren Terveen, dated November 9, 2023
1004	U.S. Patent No. 7,831,707 (“ Bardsley ”)
1005	U.S. Patent No. 7,620,690 (“ Castelli ”)
1006	LashBack website excerpts, captured Jan. 25, 2009-Feb. 13, 2009, and Dec. 15, 2006 (“ LashBack ”)
1007	U.S. Patent No. 7,873,996 (“ Emigh ”)
1008	U.S. Patent No. 6,029,192 (“ Hill ”)
1009	Return Path Research Study, <i>Keeping the Subscriber Experience Positive After “Unsubscribe Me,”</i> 2008 (“ Return Path ”)
1010	Constant Contact: Email List Management, captured Jan. 2, 2011

No.	Description
1011	Chang, Ming-Wei; Yih, Wen-Tau; and McCann, Robert, <i>Personalized Spam Filtering for Gray Mail</i> , Proceedings of the 5th Conference on Email and Anti-Spam, Aug. 2008
1012	Yih, Wen-Tau; McCann, Robert; and Kolcz, Aleksander, <i>Improving Spam Filtering By Detecting Gray Mail</i> , CEAS 2007 – Fourth Conference on Email and Anti-Spam, Aug. 2-3, 2007
1013	Dietrich, Christian and Rossow, Christian, “ <i>Empirical research on IP blacklisting</i> ,” Fifth Conference on Email and Anti-Spam, CEAS 2008 (“Dietrich”)
1014	Affidavit of Nathaniel E. Frank-White
1015	Neufeld, G. and Nisto, Baer, J., “ <i>The Use of URLs as Meta-Syntax For Core Mail List Commands and their Transport through Message Header Fields</i> ,” Network Working Group Request for Comments: 2369, July 1998
1016	Duerst, M.; Masinter, L., and Zawinski, J., “ <i>The ‘mailto’ URI Scheme</i> ,” Internet Engineering Task Force Request for Comments: 6068, Oct. 2010
1017	U.S. Patent No. 7,644,126
1018	Unsubcentral.com: Suppression List, captured Jan. 4, 2011
1019	Jenkins, Simms, <i>The Truth About Email Marketing</i> , Pearson Education, Inc., 2009
1020	Interspire.com Email Marketer User Guide, 2008
1021	J&H Web Technologies, LLC’s Sur-Reply in Opposition to Motion to Dismiss, ECF 33, <i>J&H Web Techs., LLC v. Vade Retro Tech., Inc.</i> , no. 4:17-cv-00119 (S.D. Tex.), Apr. 21, 2017
1022	Tittel, Ed and James, Steve, <i>HTML for Dummies</i> , 2nd Ed., IDG Books Worldwide, Inc., 1996

No.	Description
1023	Designing, Coding & Delivering HTML Email: A beginners survival guide from MailChimp, 2009
1024	Bannan, Karen, “ <i>When They Say You Are a Spammer</i> ,” New York Times, May 24, 2007
1025	Dictionary of Computing,” 4 th ed., Peter Collin Publishing, 2002 (excerpt)
1026	Newton’s Telecom Dictionary, 25 th Updated and Expanded Anniversary Ed., 2009 (excerpt)
1027	Email Marketing Stats, Facts and Metrics – Metrics 2.0 Quick Pack, Metrics 2.0 Blog, Nov. 7, 2006
1028	Abrams, Alan; Chaudhary, Tarun, and Deane, Jason, “ <i>A multi-industry, longitudinal analysis of the email marketing habits of the largest United States franchise chains</i> ,” Journal of Direct and Digital Marketing Practice, Vol. 11, No. 3, pp. 187-197
1029	Singaraju, Gautam; Moss, Jeff, and Kang, Brent ByungHoon, “ <i>Tracking Email Reputation for Authenticated Sender Identities</i> ,” 5th Conference on Email and Anti-Spam, CEAS 2008
1030	Hoffman, P.; Masinter, L.; and Zawinski, J., “ <i>The mailto URL scheme</i> ,” Network Working Group Request for Comments: 2368, July 1998
1031	Docket Control Order, ECF 31, <i>J&H Web Techs., LLC v. Microsoft Corp.</i> , no. 2:23-cv-00277 (E.D. Tex.), Oct. 23, 2023

I. STATEMENT OF RELIEF REQUESTED

Petitioner Microsoft Corporation (“Petitioner”) and Patent Owner J&H Web Technologies, LLC (“Patent Owner”) (collectively, the “Parties”) have reached a settlement. Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and authorization provided by the Board on February 9, 2024, the Parties jointly move for termination of this *inter partes* review proceeding (IPR2024-00108) (the “Proceeding”), without prejudice to either Party. The Parties are concurrently filing a true copy of the Parties’ settlement agreement (Confidential Exhibit 1032) along with a request that it be kept separate and treated as “business confidential information” pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceedings.

Prior to filing this motion, undersigned counsel for Petitioner obtained permission from undersigned counsel for Patent Owner to add his signature and file this motion and request jointly on behalf of the Parties.

II. JOINT MOTION FOR TERMINATION

There are no other petitioners to this *inter partes* review, and no final written decision on the merits has been entered. For at least these reasons, termination of this *inter partes* review is proper under 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

Should this joint motion to terminate be denied, Petitioner would not continue to participate in the Proceeding.

As stated in 35 U.S.C. § 317(a) and 37 C.F.R. § 42.73(d), because Patent Owner and Petitioner jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to the Petitioner.

Respectfully submitted,

Dated: February 12, 2024

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**CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6(e)(4)**

The undersigned certifies that on February 12, 2024, a complete copy of **Joint Motion To Terminate Proceeding And Exhibit 1032** was served on counsel for J&H Web Technologies, LLC via electronic mail as follows:

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