

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner

v.

VIDEO SOLUTIONS PTE. LTD.,

Patent Owner

IPR2024-00194

U.S. Patent No. 9,204,099

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a), Petitioner Cisco Systems, Inc. (“Cisco”) and Patent Owner Video Solutions Pte. Ltd. (“Video Solutions”) (collectively, the “Parties”) jointly request termination of this *inter partes* review of U.S. Patent 9,204,099. The Board has discretion to “grant, deny, or dismiss any petition or motion.” 37 C.F.R. § 42.71(a). The Parties respectfully request that the Board grant this Motion because the Parties’ dispute with respect to the ’099 Patent has been resolved. The Settlement Agreement is the sole and entire agreement between Cisco and Video Solutions made in connection with, or in contemplation of, terminating this proceeding. Ex.1041, p. 3, ¶5.

The Parties are concurrently filing a copy of the confidential Settlement Agreement as Ex.1041 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The undersigned certify that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding, and that Ex.1041 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

On December 17, 2024, the Parties informed the Board of their confidential agreement via email and requested authorization to file a joint motion to terminate the *inter partes* review with respect to both parties. As set forth in an email dated

December 18, 2024, the Board authorized the filing of the requested joint motion to terminate this proceeding as to both parties. Accordingly, the Parties jointly request termination of the present proceeding.

Public policy favors terminating the present *inter partes* review proceeding. 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). Further, the Board’s Trial Practice Guide indicates that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide, at 86 (Nov. 2019).

Terminating this *inter partes* review 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 as to all parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation.

Additionally, termination of this IPR is appropriate as the Board has not yet “decided the merits of the proceeding.” Consolidated Trial Practice Guide, at 86. Cisco filed its petition for *inter partes* review on March 15, 2024. This IPR is scheduled for an oral hearing on January 10, 2025. The parties have now settled their dispute and have reached agreement to terminate this *inter partes* review. The Board can conserve its resources through terminating the proceedings now, removing the need for the Board to hold that oral hearing and render a final written decision.

Therefore, the Parties respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: December 18, 2024

/Theodore M. Foster/

Theodore M. Foster
Counsel for Petitioner
Registration No. 57,456

/Christopher C. Hoff/

Christopher C. Hoff
Counsel for Patent Owner
Registration No. 67,738

PETITIONER’S UPDATED EXHIBIT LIST

December 18, 2024

Ex.1001	U.S. 9,204,099
Ex.1002	Prosecution History of U.S. 9,204,099
Ex.1003	Declaration of Narasimha Reddy, Ph.D. under 37 C.F.R. §1.68
Ex.1004	<i>Curriculum Vitae</i> of Narasimha Reddy, Ph.D.
Ex.1005	U.S. Pub. 2010/0287238
Ex.1006	U.S. 8,581,958
Ex.1007	U.S. Pub. 2005/0080894
Ex.1008	U.S. 7,692,683
Ex.1009	U.S. Pub. 2009/0232129
Ex.1010	U.S. 8,601,097
Ex.1011	U.S. 9,124,757
Ex.1012	Andrew S. Tanenbaum, “Computer Networks,” 4th ed. (2002)
Ex.1013	U.S. 9,009,225
Ex.1014	U.S. 7,877,489
Ex.1015	Michael Arrington, “Facebook Will Launch In-Browser Video Chat Next Week In Partnership with Skype,” TechCrunch (Jul. 1, 2011).
Ex.1016	Ian Paul, “Facebook Video Calling vs. Google+ Hangouts,” PCWorld (July 7, 2011).
Ex.1017	U.S. Pub. 2006/0215765
Ex.1018	U.S. Pub. 2009/0015661

Joint Motion to Terminate *Inter Partes* Review
IPR2024-00194 (U.S. Patent 9,204,099)

Ex.1019	U.S. Pub. 2010/0157017
Ex.1020	U.S. Pub. 2010/0333004
Ex.1021	Complaint, Video Solutions Pte. Ltd. v. Cisco Systems, Inc., 2-23-cv-00222 (E.D. Tex.)
Ex.1022	Docket Control Order, Video Solutions Pte. Ltd. v. Cisco Systems, Inc., 2-23-cv-00222 (E.D. Tex.)
Ex.1023	Calendar Events Set for 2/10/2025 - 2/11/2025, Judge Rodney Gilstrap
Ex.1024	Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
Ex.1025	United States Copyright Office Catalog Record for Andrew S. Tanenbaum, Computer Networks, 4th ed. (Ex.1012)
Ex.1026	Supplemental Declaration of Narasimha Reddy, Ph.D
Ex.1027	Deposition Transcript of Dr. Jacob Sharony, September 6, 2024
Ex.1028	Preliminary Claim Constructions, Video Solutions Pte. Ltd. v. Cisco Systems, Inc., 2-23-cv-00222 (E.D. Tex.)
Ex.1029	William Strunk and E.B. White, <i>The Elements of Style</i> (4th ed. 2000)
Ex.1030	Bryan A. Garner, <i>The Redbook: A Manual of Legal Style</i> (2d ed. 2006)
Ex.1031	Anne Enquist and Laurel Currie Oates, <i>Just Writing</i> (4th ed. 2013)
Ex.1032	THE CHICAGO MANUAL OF STYLE (18th ed. 2024)
Ex.1033	Andrew S. Tanenbaum, “Computer Networks,” 4th ed. (2002), pp. 529-532, 683-692 (“Tanenbaum II”)
Ex.1034	Request for Comments (RFC) 3550 – RTP: A Transport Protocol for Real-Time Applications, July 2003
Ex.1035	RFC 4123 – Session Initiation Protocol (SIP) – H.323 Interworking Requirements, July 2005

Joint Motion to Terminate *Inter Partes* Review
IPR2024-00194 (U.S. Patent 9,204,099)

Ex.1036	RFC 3261 – SIP: Session Initiation Protocol, June 2002
Ex.1037	RFC 2026 – Internet Engineering Task Force Request for Comments 2026, October 1996
Ex.1038	U.S. Pub. 2007/0097886
Ex.1039	U.S. 8,526,447
Ex.1040	Errata Sheet for Deposition Transcript of Jacob Sharony
Ex.1041	(NEW) Confidential Settlement Agreement

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

Date of service December 18, 2024

Manner of service Electronic Service: chris.hoff@btlaw.com;
mnelson@btlaw.com; david.lisch@btlaw.com;
steven.shipe@btlaw.com; cmargulis@btlaw.com;
joshua.larsen@btlaw.com; todd.vare@btlaw.com;
adam.kaufmann@btlaw.com

Documents served **Joint Motion to Terminate *Inter Partes* Review;
Joint Request to Treat Settlement Agreement As
Business Confidential Information and Be Kept
Separate; Exhibit Ex.1041.**

Persons served Christopher C. Hoff
Barnes & Thornburg LLP
225 S. Sixth Street, Suite 2800
Minneapolis, MN 55402

Mark C. Nelson
David M. Lisch
Barnes & Thornburg LLP
2121 N. Pearl Street, Suite 700
Dallas, TX 75201

Steven D. Shipe
Barnes & Thornburg LLP
555 12th Street N.W., Suite 1200
Washington, DC 20004

Chloe S. Margulis
Barnes & Thornburg LLP
390 Madison Avenue, 12th Floor
New York, NY 10017

Joshua P. Larsen
Todd G. Vare (*pro hac vice*)
Barnes & Thornburg LLP
11 South Meridian Street
Indianapolis, Indiana 46204

Adam Kaufmann
Barnes & Thornburg LLP
One North Wacker Drive, Suite 4400
Chicago, Illinois 60606

/Theodore M. Foster/
Theodore M. Foster
Counsel for Petitioner
Registration No. 57,456