

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FREEWHEEL MEDIA, INC. and
VIAANT TECHNOLOGY LLC.,
Petitioner*,

v.

INTENT IQ, LLC,
Patent Owner.

Case No. IPR2024-00421
U.S. Patent No. 7,861,260

**JOINT MOTION TO TERMINATE
PETITIONER FREEWHEEL MEDIA, INC.**

*Viant Technology LLC was joined as a party to this proceeding via a Motion for Joinder in IPR2025-00128.

PETITIONER’S UPDATED EXHIBIT LIST

Previously Filed:

- Ex. 1001: U.S. Pat. No. 7,861,260 (“the ’260 Patent”)
- Ex. 1002: Expert Declaration of Mr. David B. Lett
- Ex. 1003: Curriculum Vitae of Mr. David B. Lett
- Ex. 1004: Certified File History of U.S. Pat. No. 7,861,260
- Ex. 1005: Excerpts from Case Docket of *Meta Platforms Inc. v. AlmondNet Inc. et al.*, IPR2022-00773 (March 28, 2022)
- Ex. 1006: U.S. Pat. App. Pub. No 2007/0283384 (“Haeuser”)
- Ex. 1007: Annotated Version of U.S. Pat. App. Pub. No. 2008/0113674 (“Baig”)
- Ex. 1008: U.S. Prov. Pat. App. No. 60/858,204 (“Baig Provisional”)
- Ex. 1009: Redline document showing differences between Baig (Ex. 1040) and Baig Provisional (Ex. 1008)
- Ex. 1010: Reserved
- Ex. 1011: U.S. Pat. App. Pub. No. 2006/0128364 (“Costa”)
- Ex. 1012: Excerpts from E. D. Zwicky et al., *Building Internet Firewalls* (2d ed. 2000) (“Zwicky”)
- Ex. 1013: U.S. Pat. App. Pub. No. 2004/0076180 (“Satapati”)
- Ex. 1014: U.S. Pat. App. Pub. No. 2006/0271690 (“Banga690”)
- Ex. 1015: Independent Claim Comparison Chart for U.S. Pat. No. 7,861,260
- Ex. 1016: U.S. Pat. App. Pub. No. 2008/0201731 (“Howcroft”)
- Ex. 1017: U.S. Pat. App. Pub. No. 2007/0025306 (“Cox”)
- Ex. 1018: Korean Pat. App. Pub. No. 2006-0065969 (“Han”)

- Ex. 1019: Certified Translation of Korean Pat. Pub. App. No. 2006-0065969 (“Han”)
- Ex. 1020: U.S. Pat. App. Pub. No. 2007/0180147 (“Leigh”)
- Ex. 1021: U.S. Pat. App. Pub. No. 2003/0083938 (“Smith”)
- Ex. 1022: U.S. Pat. App. Pub. No. 2006/0274741 (“Wing”)
- Ex. 1023: U.S. Pat. App. Pub. No. 2002/0124050 (“Middeljans”)
- Ex. 1024: U.S. Pat. App. Pub. No. 2005/0096980 (“Koningstein”)
- Ex. 1025: U.S. Pat. App. Pub. No. 2008/0263633 (“Banga633”)
- Ex. 1026: U.S. Pat. No. 6,415,322 (“Jaye”)
- Ex. 1027: U.S. Pat. App. Pub. No. 2003/0066085 (“Boyer”)
- Ex. 1028: U.S. Pat. App. Pub. No. 2006/0230427 (“Kunkel”)
- Ex. 1029: U.S. Pat. App. Pub. No. 2007/0217436 (“Markley”)
- Ex. 1030: U.S. Pat. App. Pub. No. 2002/0145621 (“Nguyen”)
- Ex. 1031: U.S. Pat. No. 6,543,052 (“Ogasawara”)
- Ex. 1032: U.S. Pat. No. 6,282,548 (“Burner”)
- Ex. 1033: U.S. Pat. No. 6,036,601 (“Heckel”)
- Ex. 1034: U.S. Pat. App. Pub. No. 2005/0096978 (“Black”)
- Ex. 1035: Request for Comments: 1631, “The IP Network Address Translator (NAT)” (1994) (“RFC 1631”)
- Ex. 1036: Hagel *et al.*, *Net Worth: Shaping Markets When Customers Make the Rules* (1999)
- Ex. 1037: Zeff *et al.*, *Advertising on the Internet* (2nd ed. 1999) (“Zeff”)
- Ex. 1038: U.S. Pat. No. 8,280,758 (“the ’758 Patent”)
- Ex. 1039: Request for Comments: 793, “Transmission Control Protocol” (1981) (“RFC 793”)

- Ex. 1040: U.S. Pat. App. Pub. No. 2008/0113674 (“Baig”)
- Ex. 1041: Excerpts from *AlmondNet, Inc. v. Freewheel Media, Inc.*, No. 1:23-cv-00220-MN (D. Del.) (“Corresponding District Court Litigation”)
- Ex. 1042: U.S. Pat. No. 9,036,981 (“Barton”)
- Ex. 1043: U.S. Pat. No. 7,634,789 (“Gerba”)
- Ex. 1044: U.S. Pat. App. Pub. No. 2002/0174444 (“Gatto”)
- Ex. 1045: U.S. Pat. App. Pub. No. 2002/0083445 (“Flickinger”)
- Ex. 1046: U.S. Pat. App. Pub. No. 2008/0040742 (“Howcroft742”)
- Ex. 1047: Jakob Nielsen, *Request Marketing* (Oct. 2000), <https://www.nngroup.com/articles/request-marketing/>
- Ex. 1048: Bettina Fabos, *The Commercial Search Engine Industry and Alternatives to the Oligopoly* (Mar. 2006) EastBound Journal
- Ex. 1049: Susan Young, *Getting the Message: How the Internet is Changing Advertising* (May 16, 2000), <https://hbswk.hbs.edu/item/getting-the-message-how-the-internet-is-changing-advertising>
- Ex. 1050: U.S. Pat. App. Pub. No. 2002/0099842 (“Jennings”)
- Ex. 1051: U.S. Pat. App. Pub. No. 2002/0123928 (“Eldering928”)
- Ex. 1052: Request for Comments: 2663, “IP Network Address Translator (NAT) Terminology and Considerations” (1999) (“RFC 2663”)
- Ex. 1053: ANSI/IEEE Std 802.11, 1999 Edition, “Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications”
- Ex. 1054: Excerpts from Harley Hahn, *The Internet Complete Reference* (2d ed. 1996) (“Hahn”)
- Ex. 1055: U.S. Pat. App. Pub. No. 2005/0108418 (“Bedi”)
- Ex. 1056: U.S. Pat. App. Pub. No. 2004/0177147 (“Joshi”)

- Ex. 1057: Excerpts from Downing *et al.*, *Dictionary of Computer and Internet Terms* (8th ed. 2003)
- Ex. 1058: Excerpts from Newton, *Newton's Telecom Dictionary* (21st ed. 2005)
- Ex. 1059: Declaration of Dr. Sylvia Hall-Ellis
- Ex. 1060: Institution Decision from *Meta Platforms, Inc. f/k/a Facebook, Inc. v. Intent IQ, LLC et al.*, IPR2023-01281, Paper 7 (February 21, 2024)
- Ex. 1061: U.S. Pat. No. 6,427,170 (“Sitaraman”)
- Ex. 1062: Transcript of March 10, 2025 Deposition of Erik de la Iglesia
- Ex. 1063: Declaration of Dr. David B. Lett in Support of Petitioner’s Reply to Patent Owner Response
- Ex. 1064: U.S. Pat. No. 6,745,223 (“Nobakht”)
- Ex. 1065: U.S. Pat. No. 8,640,176 (“Howcroft176”)
- Ex. 1066: U.S. Pat. No. 8,619,136 (“Howarter”)
- Ex. 1067: U.S. Pat. App. Pub. No. 2001/0039658 (“Walton”)
- Ex. 1068: U.S. Pat. App. Pub. No. 2002/0044103 (“Paulson”)
- Ex. 1069: U.S. Pat. No. 5,539,822 (“Lett822”)
- Ex. 1070: U.S. Pat. No. 5,771,064 (“Lett064”)
- Ex. 1071: Canadian Pat. No. 2,501,107C (“Robertson”)
- Ex. 1072: Patent Cooperation Treaty App. Pub. No. WO2004/047457A2 (“Russ”)
- Ex. 1073: U.S. Pat. No. 7,809,154 (“Lienhart”)
- Ex. 1074: European Pat. No. 1415471A1 (“Duffield”)
- Ex. 1075: U.S. Pat. No. 7,792,756 (“Plastina”)
- Ex. 1076: U.S. Pat. App. Pub. No. 2008/0288993 (“Aghasaryan”)

Ex. 1077: U.S. Pat. App. Pub. No. 2008/0235590 (“Krantz”)

Filed Herewith:

Ex. 1078: BUSINESS CONFIDENTIAL Release Agreement

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board email of July 7, 2025, Petitioner FreeWheel Media, Inc. (“FreeWheel”) and Patent Owner Intent IQ, LLC (“Patent Owner”) jointly request termination of Petitioner FreeWheel from this proceeding, IPR2024-00421, directed to U.S. Patent No. 7,861,260 (the “’260 Patent”).

I. CERTIFICATION

FreeWheel and Patent Owner submit a true copy of any agreement or understanding (Exhibit 1078) between FreeWheel and Patent Owner made in connection with, or in contemplation of, the termination of FreeWheel from this proceeding under 37 CFR § 42.74(b) with this joint motion. There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of FreeWheel from this proceeding.

II. STATUS OF RELATED PROCEEDINGS

FreeWheel and Patent Owner have resolved their disputes regarding the ’260 Patent, including both in this proceeding and Patent Owner’s assertion of the ’260 Patent in the related district court litigation, 1:23-cv-00220-MN (D. Del.). The litigation between the Parties regarding the ’260 Patent has been dismissed with prejudice pursuant to settlement and no further litigation between the Parties is contemplated.

The only other pending proceeding in the U.S. Patent and Trademark Office

regarding the '260 Patent is IPR2024-00422 (joined by IPR2025-00129).

The following district court litigation involving the '260 Patent is pending:

- *AlmondNet, Inc. et al v. Viant Technology Inc. et al.*, 1:23-cv-00174-MN (D. Del.).

III. RELIEF REQUESTED

As authorized by the Board, the parties are jointly and contemporaneously filing: (i) this joint motion to terminate FreeWheel; (ii) a true copy of any agreement or understanding (Exhibit 1078) between FreeWheel and Patent Owner made in connection with, or in contemplation of, the requested termination of FreeWheel; and (iii) a joint request to treat the term sheet as business confidential information and keep the term sheet (Exhibit 1078) separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

FreeWheel and Patent Owner jointly request that the Board terminate this proceeding as to FreeWheel. Termination is appropriate at this stage and in view of a settlement between FreeWheel and Patent Owner. 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 as to FreeWheel because (1) FreeWheel and Patent Owner

have resolved their disputes regarding the '260 Patent; and (2) oral argument has not yet occurred and the Office has not issued a Final Written Decision.

Dated: July 8, 2025

Respectfully submitted

/Frederic M. Meeker/

Frederic M. Meeker
Reg. No. 35,282
Banner & Witcoff, Ltd.
Attorney for Petitioner
FreeWheel Media, Inc.

Dated: July 8, 2025

Respectfully submitted

/Reza Mirzaie/

Reza Mirzaie
Reg. No. 69,138
Russ, August & Kabat
Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that I caused a true and correct copy of this JOINT MOTION TO TERMINATE PETITIONER FREEWHEEL MEDIA, INC. in connection with IPR2024-00421 to be served via e-mail on July 8, 2025, in its entirety on the following counsel of record for Patent Owner:

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Dated: July 8, 2025

By: /Carlos Goldie/

Carlos Goldie