

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T CORP., AT&T SERVICES, INC., and AT&T MOBILITY LLC

PETITIONERS

v.

ALEXANDER I. SOTO and WALTER G. SOTO

PATENT OWNERS

IPR2024-00712
PATENT 8,238,754

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74
&
REQUEST TO TREAT SETTLEMENT AGREEMENT AS
BUSINESS CONFIDENTIAL INFORMATION
AND KEEP SEPARATE**

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 8,238,754
1002-1	File History of U.S. Patent No. 8,238,754
1002-2	File History of U.S. Patent Application No. 60/886,514
1003	Declaration of Dr. Paul Prucnal
1004	<i>Curriculum Vitae</i> of Dr. Paul Prucnal
1005	U.S. Patent No. 6,697,374
1006	U.S. Patent No. 7,088,921
1007	U.S. Patent No. 6,439,918
1008	U.S. Patent No. 7,206,366
1009	U.S. Patent No. 6,005,694
1010	Declaration of Thomas J. J. Starr
1011-1	ITU-T Study Group 15, Temporary Document 7, Draft new Recommendation G.984.3 – Transmission Convergence Layer for Gigabit Passive Optical Networks
1011-2	ITU-T Study Group 15, Contribution 104, Draft new Recommendation G.984.3 – Transmission Convergence Layer for Gigabit Passive Optical Networks
1012	<i>SFF & SFP Optical Transceivers</i> , OKI Technical Review Issue 190, Vol. 69, No. 2 (April 2002)
1013	Rajiv Ramaswami & Kumar Sivarajan, <i>Optical Networks, A Practical Perspective</i> (2d ed. 2002)
1014	Glen Kramer & Gerry Pesavento, <i>Ethernet Passive Optical Network (EPON): Building a Next-Generation Optical Access Network</i> , IEEE Communications Magazine (February 2002)
1015	Khurram Kazi, <i>Optical Networking Standards, A Comprehensive Guide for Professionals</i> (2006)
1016	SFF Committee, INF-8074i Specification for SFP (Small Formfactor Pluggable) Transceiver, Rev. 1.0, May 12, 2001)
1017	10G small form-factor pluggable, XFP Revision 4.5 (initial publication March 2002)
1018	INF-8474i Specification for Xenpak 10 Gigabit Ethernet Transceiver, Rev. 3.0, September 18, 2002 (publicly announced March 12, 2001)

1019	Glen Kramer, et al., <i>Supporting differentiated classes of service in Ethernet passive optical networks</i> , Journal of Optical Networking, Vol. 1, Nos. 8 & 9 (August & September 2002)
1020	Small Form Factor Connector Basics by Paul Rosenberg, EC&M.com (Sept. 1, 2001)
1021	Going Serial in Gigabit Ethernet Designs by Martin Lund, EDN.com (June 20, 2002)
1022	ITU-T G.984.2 (03/2003) Gigabit-capable Passive Optical Networks (GPON): Physical Media Dependent (PMD) layer specification
1023	ITU-T G.984.1 (03/2003) Gigabit-capable Passive Optical Networks (GPON): General Characteristics
1024	ITU-T A.1 (10/2000) Work methods for study groups of the ITU Telecommunication Standardization Sector (ITU-T)
1025	List of contributions from Oct. 2003 Geneva, Switzerland Meeting
1026	List of Plenary temporary documents from the Oct. 2003 Geneva, Switzerland Meeting
1027	List of WP1 temporary documents from Oct. 2003 Geneva, Switzerland Meeting
1028	Report of Q.2/15 Rapporteur meeting, 13-14 August 2003, Santa Clara, USA
1029	List of participants at the Oct. 2003 Geneva, Switzerland
1030	Webpage printout of The G.984.3 Draft Recommendation page
1031	Webpage printout of Contribution 104
1032	Doc. No. 58, Docket Control Order, <i>NextGen Innovations, LLC v. Fujitsu Network Communications, Inc. et al.</i> , No. 2:22-cv-00307-JRG-RSP (E.D. Tex.) (consolidated cases)
1033	U.S. District Court – Judicial Caseload Profile (Sept. 2022)
1034	<i>Agilent Technologies’ New Fiber Optic Transceivers Offer Industry’s Lowest EMI Emissions</i> , Agilent Technologies Inc. (July 10, 2001)
1035	Doc. No. 279, Claim Construction Order, <i>NextGen Innovations LLC v. Fujitsu Network Comm’ns, Inc., et al.</i> , No. 2:22-cv-0307-JRG-RSP (E.D. Tex. Dec. 22, 2023)
1036	Dkt. No. 27, <i>Nokia of America Corporation’s Motion to Intervene, NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , No. 2:23-cv-00263-JRG-RSP (E.D. Tex.)
1037	Doc. No. 23, Docket Control Order, <i>NextGen Innovations, LLC v. AT&T Services, Inc. et al.</i> , No. 2:23-cv-00263-JRG-ESP (E.D. Tex.)

1038	Comparison of AT&T Petition in IPR2024-00712 to Nokia Petition in IPR2023-00960
1039	Confidential Agreement (BUSINESS CONFIDENTIAL)
1040	Dkt. No. 62, Order Granting Stipulation of Dismissal, <i>NextGen Innovations, LLC v. AT&T Services, Inc., et al.</i> , No. 2:23-cv-00263-JRG-RSP (E.D. Tex.)

Patent Owners (“Alexander I. Soto and Walter G. Soto”) and Petitioners (“AT&T Corp., AT&T Services, Inc., and AT&T Mobility LLC”) (collectively, “the Parties”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly request termination of this proceeding, IPR2024-00712, directed to U.S. Patent No. 8,238,754 (the “’754 Patent”). The Parties were authorized to file this Joint Motion by the Board (via e-mail) on September 23, 2024. EX3002 at 1.

I. CERTIFICATION

As required by 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly submit a true copy of the settlement agreement (the “Agreement”) between Patent Owners’ Exclusive Licensee and Petitioners made in connection with, or in contemplation of, the termination of the proceeding under 37 CFR § 42.74(b) with this joint motion. The Agreement is filed herewith as a confidential exhibit (EX1039). The parties respectfully note that the submitted agreement references a “Long-Form Agreement.”

As of the time of filing of this joint motion, the Parties certify that there are no other agreements or understandings between Patent Owners (or their Exclusive Licensee) and Petitioners, or any collateral agreements referred to in the Agreement, made in connection with, or in contemplation of, the termination of this proceeding. 35 U.S.C. § 317(a); *see also* 37 CFR § 42.74(b). While the parties expect to finalize

a “Long-Form Agreement,” that has not yet been finalized. Thus, the parties have included all applicable agreements currently in existence in accordance with 35 U.S.C. 317.

II. STATUS OF RELATED PROCEEDINGS

The Parties have resolved their disputes regarding the ’754 Patent, including both in this proceeding and in the related district court litigation, *NextGen Innovations, LLC v. AT&T Services, Inc. et al.*, No. 2:23-cv-00263 (E.D. Tex. 2023), which has been dismissed. *See* EX1040. The Parties do not anticipate further litigation between them concerning the ’754 Patent.

III. STATEMENT OF PRECISE RELIEF REQUESTED

As authorized by the Board’s e-mail message on September 23, 2024, the Parties are jointly and contemporaneously filing: (i) this joint motion to terminate the proceeding; (ii) a true copy of the entire Agreement between Patent Owners’ Exclusive Licensee and Petitioners; and (iii) a joint request to treat the Agreement as business confidential information and keep the Agreement separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

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’ Exclusive Licensee and Petitioners resolved their disputes regarding the ’754 Patent; (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) “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding” (*id.* citing 35 U.S.C. §§ 317(a), 327); (4) 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 (5) termination would serve the interests of judicial economy and both Parties.

IV. REQUEST TO TREAT AS BUSINESS CONFIDENTIAL

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Parties jointly request to treat the Agreement (EX1039) between Patent Owners’ Exclusive Licensee and Petitioners, as business confidential information that shall be kept separate from the file of the involved patent and be made available only to Federal

Government agencies on written request or to persons showing good cause. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). 35 U.S.C. 317(b) requires, in part, that “[a]t the request of a party to the proceeding, the agreement or understanding *shall* be treated as business confidential information.” (emphasis added).

V. CONCLUSION

The Parties have settled all disputes relating to the ’754 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 and treat Exhibit 1039 as Business Confidential Information and keep it separate from the patent file.

Dated: September 28, 2024

Respectfully submitted,

/Eagle H. Robinson/
Eagle H. Robinson

Lead Counsel for Petitioner

/ Qi Tong /
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on September 28, 2024, a complete copy of the foregoing JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74 & REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION AND KEEP SEPARATE was served on Patent Owners via email (by consent) at:

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