Paper No. __

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROKU INC.,
Petitioner,

v.

VIDEOLABS, INC.,
Patent Owner.

_____

Case No. IPR2024-01024
Patent No. 8,291,236

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JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R § 42.72

LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 8,291,236 ("'236")
1002	File History of U.S. Patent Application No. 11/007,116 ("'236FH")
1003	Declaration of Anthony J. Wasilewski, Ph.D. ("Wasilewski")
1004	CV of Anthony J. Wasilewski, Ph.D.
1005	U.S. Patent No. 6,748,080 ("Russ")
1006	U.S. Patent No. 7,546,641 ("Robert")
1007	RESERVED
1008	*VideoLabs, Inc. v. Roku, Inc.*, Case No. 1:23-cv-01136 (D. Del.), Dkt. No. 1, Complaint Exhibit 11 – U.S. Patent No. 8,291,236 ("'236 Patent") (Oct. 11, 2023)
1009	RESERVED
1010	U.S. Patent Application Publication No. 2002/0025042
1011	U.S. Patent Application Publication No. 2005/0027984
1012	U.S. Patent Application Publication No. 2003/0078891
1013	U.S. Patent Application Publication No. 2004/0098583
1014	RESERVED
1015	RESERVED
1016	Federal Judicial Caseload Statistics (Dec. 31, 2023)
1017	*VideoLabs, Inc. v. ASUSTeK Computer, Inc.*, Case No. 6:22-cv-00720 (W.D. Tex.), Dkt. No. 48, Plaintiff VideoLabs, Inc.'s Responsive Claim Construction Brief (Jun. 5, 2024)
1018	Settlement Agreement – Confidential

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, and the Board's authorization provided on December 20, 2024, Petitioner Roku Inc. ("Roku" or "Petitioner") and Patent Owner VideoLabs, Inc. ("VideoLabs" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached a settlement agreement and jointly request termination of the *inter partes* review of U.S. Patent No. 8,291,236 ("the '236 Patent"), Case No. IPR2024-01024, with the United States Patent and Trademark Office.

I. TERMINATION IS APPROPRIATE

The basis for this Joint Motion is the settlement of all disputes between the Parties relating to the '236 Patent. In October 2023, Patent Owner filed suit in district court against Petitioner asserting patent infringement based on *inter alia* the '236 Patent. *VideoLabs, Inc. v. Roku, Inc.*, Case No. 1:23-cv-01136 (D. Del.) (filed October 11, 2023). On December 19, 2024, the Parties entered into a Settlement Agreement. The Settlement Agreement requires the termination of this proceeding, IPR2024-01024. 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. 37 U.S.C. § 317(a). Further, "no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner." See *id*.

No other petitioners remain in this *inter partes* review, and no Final Written Decision on the merits has been entered. For at least these reasons, termination of the *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a).

II. LEGAL STANDARD

35 U.S.C. § 317(a) provides that "[a]n *inter partes* review instituted under this chapter 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 proceeding before the request for termination is filed." 37 C.F.R. § 42.72 similarly provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. § 317(a)." The Trial Practice Guide also observes that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding" and that the 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." 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

III. AGREEMENT IN WRITING SUBMITTED TO THE BOARD

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties' Settlement Agreement is being submitted as Exhibit 1018. The Settlement Agreement is in writing and constitutes the Parties' entire understanding and

agreement. The Parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), in a separate paper filed concurrently herewith, the Parties jointly request that the Settlement Agreement be treated as business confidential information and be kept separate from the underlying patent file.

IV. CONCLUSION

Termination of the proceeding is a just and fair resolution. The Parties agree that neither Roku nor VideoLabs will be prejudiced by the termination of this proceeding. Finally, the Parties will benefit from preserving resources that would otherwise be expended if this motion is denied. For at least the foregoing reasons, the Parties respectfully request that the Board terminate *Inter Partes* Review IPR2024-01024.

Respectfully submitted,

Date: December 23, 2024

/Scott A. McKeown/

Scott A. McKeown, Reg. No. 42,866
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210
(617) 646-8000 Phone
(617) 646-8646 Fax

Counsel for Petitioner Roku, Inc.

/Jerry D. Tice II/

Jerry D. Tice II, Reg. No. 73,582
BUNSOW DE MORY LLP
701 El Camino Real
Redwood City, CA 94063
(650) 351-7248 Phone
(415) 426-4744 Fax

Counsel for Patent Owner VideoLabs, Inc.

CERTIFICATE OF SERVICE UNDER 37 C.F.R. §42.6(e)(4)

I certify that on December 23, 2024, I will cause a copy of the foregoing document, including any exhibits or appendices filed therewith, to be served via electronic mail, as previously consented to by Patent Owner, upon the following:

Jerry D. Tice II	jtice@bdiplaw.com
Aaron R. Hand	ahand@bdiplaw.com
	VideoLabs_Roku@bdiplaw.com

Date: December 23, 2024

/Dara Del Rosario/
Dara Del Rosario
Paralegal
WOLF, GREENFIELD & SACKS, P.C.