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 REQUEST THAT SETTLEMENT AGREEMENT BE TREATED AS BUSINESS CONFIDENTIAL INFORMATION AND KEPT SEPARATE UNDER 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

Petitioner Roku Inc. ("Roku" or "Petitioner") and Patent Owner VideoLabs, Inc. ("VideoLabs" or "Patent Owner") (collectively, the "Parties") have settled their dispute with respect to U.S. Patent No. 8,291,236 ("the '236 Patent"), Case No. IPR2024-01024. The Settlement Agreement between the Parties fully resolves all disputes relating to the '236 Patent before the district court and the Patent Trial and Appeal Board. See Exhibit 1018. Pursuant to 37 C.F.R. § 42.74(b), any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial. Accordingly, the Parties have filed the Settlement Agreement herewith as Exhibit 1018.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner and Patent Owner jointly request to file their Settlement Agreement, including the entirety of Exhibit 1018 to the Joint Motion to Terminate Proceeding, as business confidential information, and that it be kept separate from the file of the involved '236 Patent.

The terms require the Parties to treat the Settlement Agreement as confidential information and limit the Parties' ability to share the Settlement Agreement, or to disclose its contents with third parties. See Exhibit 1018. Moreover, the Settlement Agreement does not contain any information material to patentability. As such, the Parties respectfully request that the Board treat Exhibit

1018 as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Respectfully submitted,

Date: December 23, 2024

/Scott A. McKeown/

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**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/
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