UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMAZON.COM, INC. and AMAZON.COM SERVICES LLC,
Petitioner,

v.

NOKIA TECHNOLOGIES OY,
Patent Owner.

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Case IPR2024-01141
Patent 8,036,273

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# JOINT MOTION TO TERMINATE PROCEEDING

***Mail Stop "PATENT BOARD"***
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioners Amazon.com, Inc. and Amazon.com Services LLC ("Amazon" or "Petitioner") and Patent Owner Nokia Technologies Oy ("Nokia" or "Patent Owner") have reached a settlement. Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Amazon and Nokia jointly move to terminate the present *inter partes* review proceeding and request that the settlement agreement be treated as business confidential information pursuant to 35 U.S.C.§ 317(b) and 37 C.F.R. § 42.74(c). The Board authorized the parties to file this Joint Motion on March 31, 2025 via email.

## I. STATEMENT OF FACTS

A joint motion to terminate generally "must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, at *2 (July 28, 2014).

Patent Owner filed a patent infringement lawsuit alleging infringement of U.S. Patent No. 8,036,273 in the United States District Court for the District of Delaware, captioned *Nokia Technologies Oy v. Amazon.com, Inc.*, Case No. 1:23-cv-01236.

Amazon and Nokia (collectively, the "Settling Parties") have reached an agreement (the "Settlement Agreement") to resolve their disputes.

Under 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing. A true and

correct copy is being filed as Exhibit 2010. The Settlement Agreement references a Patent Agreement, which, along with its exhibits, has been filed as Exhibit 2011. The Settlement and Patent Agreements are being filed electronically with access to "Board and Parties Only." A "*Joint Request to File Settlement Agreement and Patent Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*" is being filed concurrently with this Joint Motion to Terminate to treat the Settlement Agreement and Patent Agreement as business confidential information and keep it separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). These agreements contain confidential commercial and financial information of the Settling Parties.

## II. RELIEF REQUESTED

The Settling Parties request termination of this *inter partes* review and respectfully submit that such termination is justified. "There are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide 86 (Nov. 2019). "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." *Id.* (citing 35 U.S.C. § 317(a)).

The Board should terminate this proceeding, as the Settling Parties jointly request, for the following reasons.

***First***, Amazon and Nokia have met the statutory requirement that they file a

"joint request" to terminate before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a). In fact, this IPR was recently instituted and briefing is not yet complete and there has not yet been an oral argument. Under section 317(a), an *inter partes* review shall be terminated upon such joint request "unless the Office has decided the merits of the proceeding before the request for termination is filed." There are no other preconditions recited in 35 U.S.C. § 317(a).

***Second***, Amazon and Nokia have reached a settlement as to all the disputes in this proceeding and as to the '273 patent. A true copy of the Settlement Agreement is being filed concurrently herewith. *See* Exhibit 2010. The Settlement Agreement references a Patent Agreement, which, along with its exhibits, has been filed as Exhibit 2011. These agreements contain confidential commercial and financial information of the Settling Parties. Amazon and Nokia request that the Settlement and Patent Agreements be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). The parties hereby represent that the documents filed as Exhibits 2010 and 2011 represent all agreements made in connection with, or in contemplation of, the termination of this proceeding. All such agreements have been filed with the Board as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

***Third,*** termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further

the purpose of inter partes review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an inter partes review would continue regardless of a settlement.

## III. CONCLUSION

For the foregoing reasons, Amazon and Nokia respectfully request termination of this *inter partes* review.

Dated: April 1, 2025

Respectfully submitted,

*/Jessica Kaiser/*
Jessica Kaiser, Reg. No. 58,937
Kaiser-ptab@perkinscoie.com
**PERKINS COIE LLP**
1900 Sixteenth Street, Suite 1400
Denver, CO 80202
Telephone: (303) 291-2300
Facsimile: (303) 291-2400

Robin Brewer, Reg. No. 60,951
Brewer-ptab@perkinscoie.com
**PERKINS COIE LLP**
505 Howard Street, Suite 1000
San Francisco, CA 94105
Telephone: (415) 344-7000
Facsimile: (415) 344-7050

Jonathan R. Carter, Reg. No. 75,145
Carter-ptab@perkinscoie.com
**PERKINS COIE LLP**
1155 Avenue of the Americas, 22nd Floor
New York, NY 10036-2711
Telephone: (212) 262-6900
Facsimile: (212) 977-1649

*Counsel for Petitioners*

*/Scott W. Hejny/*
Scott W. Hejny
Reg. No. 45,882
shejny@McKoolSmith.com
Eric S. Hansen
Reg. No. 63095
ehansen@mckoolsmith.com
**MCKOOL SMITH P.C.**
300 Crescent Court, Suite 1200
Dallas, TX 75201
Telephone: 214.978.4000
Facsimile: 214.978.4044

*Counsel for Patent Owner*
*Nokia Technologies Oy*

## CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on April 1, 2025, a complete and entire copy of this Joint Motion to Terminate and Exhibits 2010 and 2011 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

Jessica Kaiser
Kaiser-ptab@perkinscoie.com

Robin Brewer
Brewer-ptab@perkinscoie.com

Jonathan R. Carter
Carter-ptab@perkinscoie.com

Amazon-NokiaIPR@perkinscoie.com

Dated: April 1, 2025

Respectfully submitted,

/s/Scott W. Hejny
Scott W. Hejny
Reg. No. 45,882

*Attorney for Patent Owner*