

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIANT TECHNOLOGY LLC,
Petitioner

v.

ALMONDNET, INC.,
Patent Owner

Case IPR2025-00126
Patent 8,775,249 B2

JOINT MOTION TO TERMINATE

UPDATED EXHIBIT LIST

- Ex. 1001: U.S. Patent No. 8,775,249 (“the ’249 patent”)
- Ex. 1002: Expert Declaration of Dr. Sanjay Ranka
- Ex. 1003: Certified Prosecution History for U.S. Patent No. 7,428,493 (“the ’493 patent”)
- Ex. 1004: Certified Prosecution History for U.S. Patent No. 7,979,307 (“the ’307 patent”)
- Ex. 1005: Certified Prosecution History for U.S. Patent No. 8,244,582 (“the ’582 patent”)
- Ex. 1006: Certified Prosecution History of U.S. Patent No. 8,494,904 (“the ’904 patent”)
- Ex. 1007: Certified Prosecution History of U.S. Patent No. 8,775,249 (“the ’249 patent”)
- Ex. 1008: Papers from the prosecution histories of related EP 00 981 582.0 and EP 08103068.6 available at <https://register.epo.org/regviewer>
- Ex. 1009: Excerpts from *AlmondNet, Inc v. Freewheel Media, Inc.*, No. 1:23-cv-00220-MN (D. Del.) (“Corresponding District Court Litigation”)
- Ex. 1010: Excerpts from *AlmondNet, Inc. et al v. Oath Holdings Inc.*, 1- 19-cv-00247 (D. Del.) (“*Oath Holdings* case”)

- Ex. 1011: Excerpts from *AlmondNet, Inc., v. Samsung Electronics Co., Ltd., et al.*, 4-22-cv-07515 (N.D. Cal.) (“7515 N.D. Cal. case”), *AlmondNet, Inc. et al v. Microsoft Corporation*, 6-21-cv-00897 (W.D. Tex.) (“897 W.D. Tex. case”), and *AlmondNet, Inc. et al v. Amazon.com, Inc. et al.*, 6-21-cv-00898 (W.D. Tex.) (“898 W.D. Tex. case”)
- Ex. 1012: Excerpts from *Roku, Inc. v. AlmondNet, Inc. et al.*, 1-21-cv-01035 (D. Del.) (“1035 D. Del. case”)
- Ex. 1013: Excerpts from *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00049, challenging claims of the ’307 patent
- Ex. 1014: Excerpts from *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00050, challenging claims of the ’249 patent
- Ex. 1015: Excerpts from *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00051, challenging claims of the ’904 patent
- Ex. 1016: Excerpts from *Yahoo! Inc. v. AlmondNet, Inc.*, CBM2017-00052, challenging claims of the ’582 patent
- Ex. 1017: Excerpts from *Samsung Electronics Co., Ltd. v. AlmondNet, Inc.*, IPR2022-01260, challenging claims of the ’582 patent
- Ex. 1018: Excerpts from *Amazon.com, Inc. v. AlmondNet, Inc.*, IPR2022-01455, challenging claims of the ’582 patent
- Ex. 1019: Excerpts from *Meta Platforms, Inc. v. AlmondNet, Inc.*, IPR2022-01436, challenging claims of the ’582 patent

- Ex. 1020: “Brief History of the Internet,” by Barry Leiner et al., Internet Society, 1997
- Ex. 1021: “Addressing URL,” Internet Engineering Task Force (IETF), URI working Group, w3.org/Addressing/URL/url-spec.txt, 1994
- Ex. 1022: “HTML Sourcebook,” by Ian S. Graham, John Wiley & Sons, Inc., 1995, excerpts
- Ex. 1023: “Hypertext Transfer Protocol -- HTTP/1.0,” Internet Engineering Task Force (IETF), HTTP Working Group, 1996
- Ex. 1024: “Newton’s Telecom Dictionary,” 11th edition, by Harry Newton, Flatiron Publishing, Inc., 1996, excerpts
- Ex. 1025: “Hypertext Markup Language – 2.0,” RFC 1866, Internet Engineering Task Force (IETF), Network Working Group, 1995
- Ex. 1026: “Hypertext Transfer Protocol -- HTTP/1.0,” RFC 1945, Internet Engineering Task Force (IETF), Network Working Group, 1996
- Ex. 1027: “The HTTP Protocol As Implemented in W3,”
<https://www.w3.org/Protocol/HTTP/AsImplemented.html>
- Ex. 1028: U.S. Patent No. 6,183,366 (“Goldberg”)
- Ex. 1029: U.S. Patent No. 7,334,184 (“Simons”)
- Ex. 1030: U.S. Patent No. 6,055,573 (“Gardenswartz”)
- Ex. 1031: U.S. Patent No. 5,991,740 (“Messer”)

- Ex. 1032: U.S. Patent No. 6,036,601 (“Heckel”)
- Ex. 1033: “The Internet Complete Reference,” by Harley Hahn and Rick Stout, Osborne McGraw-Hill, 1994, excerpts
- Ex. 1034: “Net Worth,” by John Hagel III and Marc Singer, Harvard Business School Press, 1999
- Ex. 1035: U.S. Patent No. 5,948,061 (“Merriman”)
- Ex. 1036: U.S. Patent No. 6,285,987 (“Roth”)
- Ex. 1037: U.S. Patent No. 6,415,322 (“Jaye”)
- Ex. 1038: U.S. Patent No. 5,740,252 (“Minor”)
- Ex. 1039: U.S. Patent Application Pub. No. 2002/0026351 (“Coleman”)
- Ex. 1040: U.S. Patent Application Pub. No. 2013/0097664 (“Herz”)
- Ex. 1041: U.S. Provisional Pat. App. No. 60/161,640 (“Herz provisional”)
- Ex. 1042: Herz Claim 1 Listing
- Ex. 1043: U.S. Patent No. 6,141,694 (“Gardner”)
- Ex. 1044: U.S. Patent Application Pub. No. 2001/00202 (“Gupta”)
- Ex. 1045: U.S. Patent No. 7,240,022 (“Bistriceanu”)
- Ex. 1046: “Database Management Systems,” Second Edition, by Raghu Ramakrishnan and Johannes Gehrke, McGraw-Hill Companies, Inc., 1998 (excerpts)

- Ex. 1047: “How the Internet Works,” Fourth Edition, by Preston Gralla, Que Corporation, 1998
- Ex. 1048: “A Framework for Targeting Banner Advertising On the Internet,” by Katherine Gallagher and Jeffrey Parsons, IEEE, 1997
- Ex. 1049: “A Framework for the Optimizing of WWW Advertising,” by Charu C. Aggarwal, Joel L. Wolf, and Philip S. Yu, IBM T.J. Watson Research Center
- Ex. 1050: “Unintrusive customization techniques for Web advertising,” by Marc Langheinrich et al., Elsevier Science, Computer Networks 31 (1999), pp. 1259-1272
- Ex. 1051: “Web advertising,” by Michael McCandless, IEEE, Intelligent Systems, 1998
- Ex. 1052: Expert Declaration of Dr. Hall-Ellis
- Ex. 1053: Joint Stipulation and Order Regarding Disposition of Certain Patents (U.S. Patent Nos. 8,775,249, 7,979,307, and 11,564,015 dropped from suit), *AlmondNet, Inc. et al v. Viant Technology Inc. et al.*, No. 1-23-cv-00174, January 14, 2025

Pursuant to 35 U.S.C. § 317(a), Petitioner, Viant Technology LLC, and Patent Owner, AlmondNet, Inc. (collectively “the Parties”), jointly move to terminate this inter partes review of U.S. Patent No. 8,775,249, which has not yet been instituted. The Board authorized the filing of the instant motion in an email dated February 3, 2025.

I. SETTLEMENT AGREEMENT

The Parties have settled their dispute in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). The Parties’ settlement agreement is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1053. The settlement agreement is in the form of a Joint Stipulation and Order Regarding Disposition of Certain Patents, entered as an order by the court on January 14, 2025.

The Parties further certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the present inter partes review.

As stated in 35 U.S.C. § 317(a), because this request for termination is made before the Office has decided the merits, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

A. Reasons Why Termination is Appropriate

Termination is proper under 35 U.S.C. § 317(a) because the Parties are jointly requesting termination, and the Office has not yet “decided the merits of the

proceeding before the request for termination is filed.” Indeed, in this IPR proceeding, no decision instituting trial has been entered.

Moreover, as noted in the Patent Office Trial Practice Guidelines, “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding. . . . 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. 35 U.S.C. 317(a), as amended, and 35 U.S.C. 327.” Federal Register Vol. 77, No. 157 at 48768.

B. Status of Related District Court Litigation

The ’249 patent is the subject of the following pending litigation: *AlmondNet, Inc. et al v. Viant Technology Inc. et al*, 1-23-cv-00174 (D. DE), filed February 16, 2023. On January 14, 2025, the court entered an order whereby Plaintiffs’ claims against Defendants and Defendants’ counterclaims against Plaintiffs with respect to the ’249 patent were dismissed with prejudice. A copy of that order is provided here as Exhibit 1053.

II. CONCLUSION

For the foregoing reasons, the Parties jointly request termination of IPR2025-00126.

Respectfully submitted,

Dated February 6, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on February 6, 2025, a complete and entire copy of this Joint Motion to Terminate and Exhibit 1053 were provided by email, to the Patent Owner, by serving the correspondence addresses of record as follows:

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