UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ELEMENT TV COMPANY, LP, AND
ELEMENT TELEVISION COMPANY, LLC,

Petitioners,

v.

NOKIA CORPORATION AND NOKIA TECHNOLOGIES OY,

Patent Owner.

IPR2025-01108
U.S. Patent No. 7,532,808

JOINT MOTION TO TERMINATE PROCEEDING

Petitioners Element TV Company, LP, and Element Television Company, LLC ("Element" or "Petitioner") and Patent Owners Nokia Corporation and Nokia Technologies Oy ("Nokia" or "Patent Owners") have reached a settlement. Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Element 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). On Wednesday, August 20, 2025, Petitioner called the Board and spoke with a paralegal, who indicated that if this case had not yet been assigned to a panel, the parties should go ahead and file this Joint Motion

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). Petitioners filed a complaint seeking declaratory judgment of non-infringement of U.S. Patent No. 7,532,808 in United States District Court for the District of Minnesota, captioned *Element Television Co., LLC v. Nokia Corp.,* 24-cv-04269 (D. Mn.).

Element and Nokia (collectively, the "Settling Parties") have reached an

agreement (the "Settlement and Patent License Agreement") to resolve their disputes.

Under 37 C.F.R. § 42.74(b), the Settlement and Patent License Agreement is in writing. A true and correct copy is being filed as Exhibit 1019. The Settlement and Patent License Agreement is being filed electronically with access to "Board and Parties Only." A "*Joint Request to Treat Settlement and Patent License 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 and Patent License Agreement as business confidential information and kept separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). This agreement contains 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, Element 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 has not yet been instituted, and Patent Owner has not even filed a Preliminary Response to the Petition. 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, Element and Nokia have reached a settlement as to all the disputes in this proceeding and as to the '321 patent. A true copy of the Settlement and Patent License Agreement is being filed concurrently herewith. *See* Exhibit 1019. This agreement contains confidential commercial and financial information of the Settling Parties. Element and Nokia request that the Settlement and Patent License Agreement 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 document filed as Exhibit 1019 represents 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, Element and Nokia respectfully request termination of this *inter partes* review.

Dated: August 25, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on August 25, 2025 a complete and entire copy of this Joint Motion to Terminate and Exhibit 1019 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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Date: August 25, 2025