UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK CORPORATION, DISH NETWORK L.L.C., AND DISH NETWORK SERVICE L.L.C.

Petitioner

v.

WISTARIA TRADING LTD.

Patent Owner

Case IPR2019-01447

U.S. Patent No. 9,104,842

PETITIONER'S JOINT MOTION TO TERMINATE PETITION PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, DISH Network Corporation, DISH Network L.L.C., and DISH Network Service L.L.C. ("Petitioners") and Patent Owner Wistaria Trading Ltd. ("Patent Owner") jointly request termination of this *inter partes* review ("IPR") of 9,104,842 (the "'842 patent"), Case No. IPR2019-01447, and termination of the proceeding with respect to Petitioner. The parties note that the Decision on Institution is pending.

The parties have settled and have reached agreement to terminate this IPR. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this motion on January 22, 2020.

Termination of this proceeding is proper for at least the following reasons:

- The parties are jointly requesting termination. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) ("There are **strong public policy reasons to favor settlement** between the parties to a proceeding.") (emphasis added). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g.*, *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir.

1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Here, no public interest or other factors weigh against termination of this proceeding.

- The Board has not yet "decided the merits of the proceeding **before the request for termination is filed**." 35 U.S.C. § 317(a) (emphasis added); 77 Fed. Reg. 48768 ("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.") Indeed, the Board has not yet made a decision on institution of this *inter partes* review. Petitioners filed their petition for *inter partes* review on August 1, 2019. No Motions are outstanding in this proceeding. No other party's rights will be prejudiced by the termination of this *inter partes* review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to "instituted" proceedings. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (And 35 U.S.C. 317(a) provides "[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.").

- In *Blue Spike LLC et al. v. DISH Network Corporation et al.*, United States District Court for the District of Delaware, Case No. 1:19-CV-00160-LPS-CJB the parties are moving to dismiss the case. The settlement also calls for Blue Spike LLC and Dish Network Corporation et al. to jointly request termination of the proceeding before the Board involving the '842 patent (i.e., IPR2019-01447).

The following proceedings are related to the '842 Patent:

Blue Spike LLC et al v. Charter Communications, Inc., 1-19-cv-00158 (D. Del. filed Jan. 28, 2018) and *Blue Spike LLC et al v. Comcast Cable Communications, LLC*, 1-19-cv-00159 (D. Del. filed Jan. 28, 2018).

The settlement agreement between the parties has been made in writing, and a true and correct copy will be filed with this request as Exhibit 1014.

Aside from the settlement agreement, the parties confirm that there are no other "collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of [the] inter partes review." 35 U.S.C. § 317(b).

January 22, 2020 */Eliot D. Williams/*

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