

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETFLIX, INC. and ROKU, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00041
Patent 8,407,609 B2

Before CHARLES J. BOUDREAU, DANIEL J. GALLIGAN, and
JULIET MITCHELL DIRBA, *Administrative Patent Judges*.

DIRBA, *Administrative Patent Judge*.

ORDER

Settlement as to Roku, Inc.
Granting Request to Keep Agreement Confidential
35 U.S.C. § 317; 37 C.F.R. § 42.74

Netflix, Inc. and Roku, Inc. filed a Petition seeking institution of *inter partes* review of claims 1–3 of U.S. Patent No. 8,407,609 B2 (Ex. 1001, “the ‘609 patent”). Paper 1. After reviewing the Petition (Paper 1) and Patent Owner’s Preliminary Response (Paper 9), we instituted an *inter partes* review of the challenged claims on March 25, 2020. Paper 10.

On May 27, 2020, pursuant to our authorization, Petitioner Roku, Inc. (“Roku”) and Patent Owner Uniloc 2017 LLC (“Uniloc”) filed a Joint Motion to Terminate Petitioner Roku. Paper 12 (“Motion” or “Mot.”). Roku and Uniloc also filed a copy of a settlement agreement (Ex. 1007) along with an authorized Joint Request to File Settlement Agreement as Business Confidential Information and Keep Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 13).

In the Motion, Roku and Uniloc state that they “have reached a settlement as to all the disputes in this proceeding and as to the ‘609 Patent.” Mot. 2. They also state that “[a] true copy of the settlement agreement is filed concurrently herewith” (*id.* (citing Ex. 1007)), and they “jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them . . . that are made in connection with[,] or in contemplation of, the termination of the instant proceeding with respect to Roku” (*id.* at 3). The moving parties submit that termination is appropriate because “the proceeding is still at an early stage” and “the Board has not decided on the merits of the case.” *Id.*

Under 35 U.S.C. § 317(a), “[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.” Any

IPR2020-00041
Patent 8,407,609 B2

agreement or understanding “made in connection with, or in contemplation of, the termination of an inter partes review” must be in writing, and a true copy of any such documents must be filed in the Office before termination. *Id.* § 317(b); *accord* 37 C.F.R. § 42.74(b).

Because the moving parties (Roku and Uniloc) represent that they have complied with the applicable requirements, we terminate the *inter partes* review with respect to Petitioner Roku. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.74. We also grant the parties’ request to treat the settlement agreement (Exhibit 1007) as business confidential information. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

The other Petitioner—Netflix, Inc.—is not a party to the settlement agreement and did not join the Motion. Accordingly, this *inter partes* review proceeding remains pending as to Petitioner Netflix, Inc.

ORDER

Accordingly, it is:

ORDERED that the Joint Motion to Terminate with respect to Roku only is granted;

FURTHER ORDERED that the case caption for future submissions in this proceeding shall not list Roku as a petitioner;

FURTHER ORDERED that the settlement agreement (Exhibit 1007) be treated as business confidential information and be kept separate from the files of the involved U.S. Patent No. 8,407,609 B2;

FURTHER ORDERED this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

IPR2020-00041
Patent 8,407,609 B2

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