

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MICROSOFT CORPORATION,  
Petitioner,

v.

WORLDS INC.,  
Patent Owner.

---

Case IPR2021-00277  
Patent 8,082,501

---

**PETITIONERS AND PATENT OWNER'S JOINT REQUEST TO FILE  
SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL  
INFORMATION PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72, Microsoft Corporation (“Petitioner”) and Worlds Inc. (“Patent Owner”) (collectively, “the Parties”) hereby seek to file a true copy of the settlement agreement between the Parties in connection with the Parties’ joint request for termination of the above-captioned *inter partes* review. The settlement agreement is being filed as confidential Exhibit 1042. Because the agreement contains business confidential information, the Parties request the Board treat the agreement as business confidential information, keep the agreement separate from the file of U.S. Patent No. 8,082,501, and make it available only where required by statute or regulation. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.72(c) (restricting access except to Federal Government agencies upon written request, or to a person on a showing of good cause).

DATED: September 20, 2021

Respectfully Submitted,

/W. Karl Renner/

W. Karl Renner, Reg. No. 41,265  
David L. Holt, Reg. No. 65,161  
Fish & Richardson P.C.  
3200 RBC Plaza, 60 South Sixth Street  
Minneapolis, MN 55402  
T: 202-783-5070  
F: 877-769-7945

/Wayne M. Helge/

Wayne M. Helge (Reg. No. 56,905)  
Aldo Noto (Reg. No. 35,628)  
Davidson Berquist Jackson & Gowdey L.L.P.  
8300 Greensboro Drive, Suite 500  
McLean, VA 22102  
Telephone: 571-765-7700  
Fax: 571-765-7200

## CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on September 20, 2021, a complete and entire copy of this PETITIONERS AND PATENT OWNER'S JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317 was provided via email, to the Patent Owner by serving the correspondence addresses of record as follows:

Wayne M. Helge (Reg. No. 56,905)  
Aldo Noto (Reg. No. 35,628)  
Davidson Berquist Jackson & Gowdey L.L.P.  
8300 Greensboro Drive, Suite 500  
McLean, VA 22102  
Telephone: 571-765-7700  
Fax: 571-765-7200

Email: [whelge@dbjg.com](mailto:whelge@dbjg.com)  
Email: [jwilson@dbjg.com](mailto:jwilson@dbjg.com)  
Email: [anoto@dbjg.com](mailto:anoto@dbjg.com)

/Michael Stanwyck/  
Michael Stanwyck  
Fish & Richardson P.C.  
60 South Sixth Street, Suite 3200  
Minneapolis, MN 55402  
(202) 626-6420