

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETNUT LTD.,

Petitioner

v.

BRIGHT DATA LTD.,

Patent Owner

Case IPR2021-01492

Patent No. 10,257,319

**JOINT MOTION TO TERMINATE AS TO PETITIONER DUE TO
SETTLEMENT UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.74¹**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ This Joint Motion was authorized by the Board in an e-mail dated May 24, 2022.

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I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner NetNut Ltd. and Patent Owner Bright Data Ltd. (together, the “Parties”) jointly move to terminate IPR2021-01492 (this proceeding) and IPR2021-01493 (related proceeding) as to Petitioner due to settlement. As discussed below, the Parties respectfully request termination as to Petitioner for at least three reasons:

1. the Parties have settled their disputes;
2. the Board has not made a decision on the merits;
3. granting termination as to Petitioner is mandatory.

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.” (emphasis added).

II. CERTIFICATION

In compliance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties have filed Exhibit 2019, a true copy of the written settlement agreement between the Parties, and the Parties concurrently filed a Joint Request to File Settlement Agreement as Business Confidential Information and Be Kept Separate from the Patent Files. Exhibit 2019 has been filed for access by the “Parties and Board Only.”

The Parties jointly certify that Exhibit 2019 reflects final settlement and resolution of all disputes between the Parties, including those relating to Patent No. 10,257,319 (the “’319 Patent”), and there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination sought.

III. BACKGROUND

Trial was recently instituted on March 21, 2021. Paper 12. The Board issued a Scheduling Order setting the due date for the Patent Owner Response and/or Motion to Amend on June 15, 2022. Paper 13 at 11. The Board issued an Order *sua sponte* staying the concurrent *ex parte* reexamination of the ‘319 Patent in Control No. 90/014,875 on April 7, 2022. Paper 14.

On May 13, 2022, the Parties sent a joint email to inform the Board that they had reached settlement in principle and to request a conference call to discuss authorization to file papers related to termination.

On May 18, 2022, Patent Owner filed a Notice of Settlement and Related Court Order. Paper 16.

On May 20, 2022, the Parties held a conference call with the Board to discuss authorization to file papers related to termination.

On May 24, 2022, the Board authorized the filing of papers related to termination.

IV. THE PARTIES HAVE SETTLED THEIR DISPUTES.

With authorization from the Board, the Parties jointly move to terminate this proceeding as to Petitioner due to settlement. No other petitioner remains in the proceeding.²

The Parties have resolved all disputes between them and with regard to the ‘319 Patent. The Parties contemplate no new administrative or district court proceeding between them in the foreseeable future.

V. THE BOARD HAS NOT MADE A DECISION ON THE MERITS.

This IPR is at a relatively early stage. The Parties have not yet fully briefed their arguments following the Board’s institution decision. There have been no expert depositions and there has been no briefing regarding exclusion of evidence. There has been no prehearing conference and the oral argument (set for December

² In IPR2022-00861, Petitioners Code200, UAB et al. moved for joinder to this IPR. Patent Owner opposes joinder for the reasons set forth in its opposition filed on May 18, 2022. *See id.*, Paper 11. In IPR2022-00915, Petitioner Major Data UAB moved for joinder to this IPR. Patent Owner opposes joinder and for the reasons set forth in its opposition filed on May 23, 2022. *See id.*, Paper 7.

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