

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VONAGE HOLDINGS CORP., VONAGE AMERICA, INC.,
VONAGE MARKETING LLC, AND NETFLIX, INC.;
Petitioner

v.

STRAIGHT PATH IP GROUP, INC.
Patent Owner

Case IPR2014-01224
Patent 6,701,365

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioners Vonage Holdings Corp., Vonage America, Inc., and Vonage Marketing LLC (“Vonage”) and Patent Owner Straight Path IP Group, Inc (“Straight Path”) jointly request termination of the *Inter Partes* Review (Case No. IPR2014-01224), which is directed to U.S. Patent No. 6,701,365 (the “’365 Patent”).

Petitioner Netflix¹ and Vonage filed this Petition for *Inter Partes Review* of the ‘365 Patent on August 1, 2014. Straight Path did not file a preliminary response. No decision on institution has been entered in this proceeding, and accordingly, no final written decision on the merits of this review proceeding has been entered. The parties have settled their dispute, and have reached agreement to terminate this *Inter Partes Review*.

The parties’ Settlement Agreement has been made in writing, and a true copy of same is attached hereto as Exhibit 1029². The parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. §42.74(c), and a separate joint request to that effect is being filed on even date herewith.

¹ Petitioner Netflix, Inc. has already filed a Joint Motion to Terminate Proceedings on September 19, 2014 (Paper 8).

² The Settlement Agreement is being filed electronically via the Patent Review Processing System (PRPS) as “Parties and Board Only.”

Vonage filed four related Petitions for Inter Partes Review on August 1, 2014. Those proceedings are IPR2014-01223, relating to U.S. Patent No. 6,513,066; IPR2014-01225, relating to U.S. Patent No. 6,009,469; IPR2014-01234, relating to U.S. Patent No. 6,131,121; and IPR2014-01241, relating to U.S. Patent No. 6,108,704. Vonage and the Patent Owner are concurrently and jointly requesting termination of those proceedings.

1. Reasons Why Termination is Appropriate.

Termination is proper under 35 U.S.C. § 317(a), because the parties are jointly requesting termination, and the Patent Trial and Appeal Board (“PTAB”) has not yet “decided the merits of the proceeding before the request for termination is filed.” Within the context of Section 317(a), because the PTAB has not yet issued a decision instituting the trial or a final written decision, it accordingly not decided the merits of the proceeding. Therefore, the parties are entitled to terminate this proceeding under Section 317(a) upon their joint request.

2. Related District Court Litigations and Status.

The '365 Patent is the subject of the following pending litigations:

Case Name	Case No.	Venue	Filing Date	Status
Straight Path IP Group, Inc. v. Verizon Communications Inc. et al	1-14-cv-07798	NYSD	September 26, 2014	Pending
Straight Path IP Group, Inc. v. Apple Inc	3-14-cv-04302	CAND	September 24, 2014	Pending
Straight Path IP Group, Inc. v. Cisco Systems, Inc.	3-14-cv-04312	CAND	September 24, 2014	Pending
Straight Path IP Group, Inc. v. Avaya, Inc.	3-14-cv-04309	CAND	September 24, 2014	Pending
Straight Path IP Group, Inc. v. Netflix, Inc.	6-14-cv-00405	TXED	May 2, 2014	Terminated
Straight Path IP Group, Inc. v. Vonage Holdings Corp. et al	2-14-cv-00502	NJD	January 24, 2014	Terminated
Straight Path IP Group, Inc. v. Vonage Holdings Corp. et al	1-13-cv-01366	VAED	November 4, 2013	Terminated
Straight Path IP Group, Inc. v. ZTE Corporation et al	6-13-cv-00607	TXED	August 23, 2013	Terminated
Straight Path IP Group, Inc. v. Samsung Electronics Co., Ltd. et al	6-13-cv-00606	TXED	August 23, 2013	Pending

Straight Path IP Group, Inc. v. Huawei Investment & Holding Co., Ltd. et al	6-13-cv-00605	TXED	August 23, 2013	Pending
Straight Path IP Group, Inc. v. BlackBerry Limited et al	6-13-cv-00604	TXED	August 23, 2013	Pending
Straight Path IP Group, Inc. v. Vocalocity, Inc.	3-13-cv-00504	VAED	August 2, 2013	Terminated
Straight Path IP Group, Inc. v. Vocalocity, Inc.	1-13-cv-01100	VAED	August 2, 2013	Terminated
Straight Path IP Group, Inc. v. Bandwidth.com, Inc.	1-13-cv-00932	VAED	August 1, 2013	Terminated
Straight Path IP Group, Inc. v. Telephere Networks Ltd.	1-13-cv-00937	VAED	August 1, 2013	Terminated
Innovative Communications Technologies, Inc. v. ooVoo, LLC	2-12-cv-00008	VAED	January 4, 2012	Terminated
Innovative Communications Technologies, Inc. v. Vivox, Inc.	2-12-cv-00007	VAED	January 4, 2012	Terminated
Innovative Communications Technologies, Inc. v. Stalker Software, Inc., etc.	2-12-cv-00009	VAED	January 4, 2012	Terminated
Net2phone, Inc. v. Ebay, Inc. et al.	4-10-cv-04090	ARWD	June 23, 2010	Terminated
Net2phone, Inc. v. Ebay, Inc. et al.	2-06-cv-02469	NJD	June 1, 2006	Terminated

3. Future Participation by the Parties.

Pursuant to the Settlement Agreement, Petitioner Vonage will not bring or assist with any action challenging the validity of the Licensed Patents. It is unclear how these proceedings could properly proceed if they are not terminated by this joint motion.

Respectfully submitted,

Dated: October 22, 2014

/s/ Thomas J. McWilliams

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that a copy of the foregoing

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and its exhibit was served on October 22, 2014, by filing this document through the Patent Review Processing System as well as delivering a copy via electronic mail directed to the attorneys of record for the Petitioner at the following address:

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