

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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VONAGE HOLDINGS CORP., VONAGE AMERICA, INC., VONAGE  
MARKETING LLC, and NETFLIX, INC.,

Petitioner,

v.

STRAIGHT PATH IP GROUP, INC.,  
Patent Owner

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Case IPR2014-01224  
Patent 6,701,365

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**NETFLIX, INC. AND STRAIGHT PATH IP GROUP, INC.'S  
JOINT MOTION TO TERMINATE PROCEEDING  
PURSUANT TO 37 C.F.R. § 42.74**

As permitted by the Patent Trial and Appeal Board's Order (Paper No. 7) entered September 9, 2014, Petitioner Netflix, Inc. ("Netflix") and Patent Owner Straight Path IP Group, Inc. ("Straight Path") jointly request termination as to Netflix in *Inter Partes Review* proceeding IPR2014-01224, relating to U.S. Patent No. 6,701,365 (the '365 Patent), pursuant to 37 C.F.R. § 42.74. Petitioners Vonage Holdings Corp., Vonage America, Inc., and Vonage Marketing LLC remain in the *Inter Partes Review* proceeding and do not oppose Netflix and Straight Path's request.

Petitioner Netflix and Vonage filed this Petition for *Inter Partes Review* of the '365 Patent on August 1, 2014. Straight Path has not yet filed a preliminary response. No decision on institution has been entered in this proceeding.

Netflix and Straight Path have now settled their dispute with respect to the '365 Patent, and have reached agreement to terminate this proceeding as to Netflix.

Filed concurrently herewith is a complete, true and correct copy of an agreement to settle this *Inter Partes Review* proceeding as to Netflix as well as to settle outstanding disputes as to Netflix. (*See Exhibit 1028*). Netflix and Straight Path request that the settlement agreement be treated as business confidential information, and kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). A request for treatment of the settlement agreement as confidential business information is submitted herewith.

Netflix 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. Netflix and Patent Owner are concurrently requesting termination of those proceedings as to Netflix.

The settlement agreement does not involve other parties in the Related Proceedings identified in Patent Owner's Mandatory Notices filed August 21, 2014 (Paper No. 5). Accordingly, those proceedings may continue despite this settlement.

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). Netflix and Patent Owner are jointly requesting termination of the proceeding as to Netflix. *See, e.g., CBS Interactive, Inc., et al., v. Helferich Patent Licensing, LLC, et al.*, Case IPR2013-00033, 2013 WL 5970152, \*1 (P.T.A.B. 2013) (terminating proceeding as to a single petitioner). The Office has not yet issued a decision instituting the trial or a final written decision and has accordingly not decided the merits of the proceeding. Under similar circumstances, the Office has exercised its

authority to terminate proceedings prior to the institution of a trial. *See Porche Cars N. America, Inc. v. Vehicle Interface Technologies, LLC*, Case IPR2014-00014, 2014 WL 1510862 (P.T.A.B. 2014).

Additionally, the Office recognizes strong public policy reasons favoring settlement between parties. Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). Terminating this proceeding as to Netflix would promote those policy considerations in view of the settlement between Netflix and Straight Path. Accordingly, termination as to Netflix is appropriate.

As required by the Order, this Joint Motion identifies all defendants in any related district court litigation in which infringement or invalidity of the claims of the ’066 Patent have been alleged:

<b>Case Name</b>	<b>Docket No.</b>	<b>Court</b>	<b>Defendants</b>	<b>Status of Defendant(s)</b>
<i>Innovative Communications Technologies, Inc. v. Vivox, Inc.</i>	12-cv-00007	EDVA	Vivox, Inc.	Terminated
<i>Innovative</i>	12-cv-00008	EDVA	OOVOO, LLC	Terminated

<i>Communications Technologies, Inc. v. ooVoo, LLC</i>				
<i>Innovative Communications Technologies, Inc. v. Stalker Software, Inc., etc.</i>	12-cv-00009	EDVA	Stalker Software, Inc.	Terminated
<i>Straight Path IP Group, Inc. v. Bandwidth.com, Inc.</i>	13-cv-00932	EDVA	Bandwidth.com, Inc.	Terminated
<i>Straight Path IP Group, Inc. v. Telesphere Networks Ltd.</i>	13-cv-00937 (Consolidated with 13-cv-932)	EDVA	Telesphere Networks Ltd.	Terminated
<i>Straight Path IP</i>	13-cv-01100	EDVA	Vocalocity, Inc.	Terminated

<i>Group, Inc. v. Vocalocity, Inc.</i>	(Transferred from EDVA 13-cv-00594; Consolidated with EDVA 13-CV-932)			
<i>Straight Path IP Group, Inc. v. Netflix, Inc.</i>	14-cv-00405	EDTX	Netflix, Inc.	Terminated
<i>Straight Path IP Group, Inc. v. LG Electronics, Inc. et al.</i>	13-cv-00933	EDVA	<ul style="list-style-type: none"> <li>Patent at issue only with respect to Intervenor Netflix, Inc.</li> </ul>	Terminated as to Netflix, Inc.
<i>Straight Path IP Group, Inc. v. VIZIO, Inc. et al.</i>	13-cv-00934	EDVA	<ul style="list-style-type: none"> <li>Patent at issue only with respect to Intervenor Netflix, Inc.</li> </ul>	Terminated as to Netflix, Inc.
<i>Straight Path IP Group, Inc. v.</i>	13-cv-0503 (Transferred	EDVA	<ul style="list-style-type: none"> <li>Patent at issue only with respect</li> </ul>	Terminated as to Netflix,

<i>Toshiba Corporation, et al.</i>	to 13-cv-01070 and consolidated with 13-CV-934)		to Intervenor Netflix, Inc.	Inc.
<i>Straight Path IP Group, Inc. v. Vonage America, Inc., Vonage Holdings Corp., Vonage Marketing LLC.</i>	14-cv-00502 (Transferred from EDVA 13-cv-01366)	DNJ	<ul style="list-style-type: none"> <li>• Vonage Holdings Corp.</li> <li>• Vonage America, Inc.</li> <li>• Vonage Marketing LLC</li> </ul>	Pending

**Table of Exhibits for U.S. Patent 6,701,365**

**Petition for *Inter Partes* Review**

Exhibit	Description
1001	U.S. Patent No. 6,701,365 (“365 patent”)
1002	Declaration of Dr. Bruce M. Maggs (“Maggs Decl.”)
1003	Microsoft Windows NT Server Version 3.5 (“Microsoft Manual”)
1004	Technical Standard: Protocols for X/Open PC Interworking: SMB, Version 2 (“NetBIOS”)
1005	Declaration of Jason Liss Regarding Documentation of Microsoft Windows NT Server Version 3.5
1006	Windows NT Server 3.5 TCP/IP Documentation [TCPIP.HLP]
1007	Windows NT Server Copyright Registration
1008	Windows NT Networking Guide
1009	Windows NT Networking Guide Copyright Registration
1010	Petition for Inter Partes Review of U.S. Patent No. 6,108,704, <i>Sipnet EU S.R.O. v. Straight Path IP Group, Inc.</i> (IPR No. 2013-00246)

	(April 11, 2013)
1011	Institution Decision in Sipnet EU S.R.O. v. Straight Path IP Group, Inc. (IPR No. 2013-00246) (Oct. 11, 2013)
1012	<i>Straight Path IP Group, Inc. v. Bandwidth.com, Inc. et al.</i> , No. 1:13-cv-0932 (E.D.V.A. Feb. 25, 2014) (Dkt. 107, Claim Construction Order)
1013	IETF RFC 1541, October 1993 (“Dynamic Host Configuration Protocol”) (“DHCP”)
1014	IETF RFC 1034, November 1987 (“Domain Names - Concepts And Facilities”) (“Domain Names RFC 1034”)
1015	IETF RFC 1035, November 1987 (“Domain Names - Implementation And Specification”) (“Domain Names RFC 1035”)
1016	IETF RFC 791, September 1981 (“Internet Protocol”)
1017	Curriculum Vitae of Dr. Bruce M. Maggs
1018	Excerpt from File History for U.S. Patent No. No. 6,108,704 (December 2, 1997 Amendment)
1019	U.S. Patent No. 5,159,592 (“Perkins”)
1020	Excerpt from File History for ’365 Patent (Apr. 19, 2002)

	Amendment)
1021	Excerpt from File History for '365 Patent (July 17, 2002 Request for Reconsideration)
1022	Excerpt from File History for '365 Patent (Feb. 13, 2002 Office Action)
1023	Excerpt from File History for '365 Patent (June 20, 2002 Office Action)
1024	Excerpt from File History for '365 Patent (Oct. 8, 2002 Amendment)
1025	Excerpt from File History for '365 Patent (Dec. 31, 2002 Notice of Allowance)
1026	Excerpt from Reexamination File History for '365 Patent (Aug. 14, 2009 Office Action)
1027	Excerpt from Reexamination File History for '365 Patent (May 11, 2010 Notice of Intent to Issue Reexamination Certificate)
1028	Executed Confidential License Agreement (August 20, 2014)

## **CONCLUSION**

For the reasons stated above, Netflix and Straight Path respectfully request termination of Netflix from *Inter Partes Review* of U.S. Patent No. 6,701,365, Case No. IPR2014-01224.

Dated: September 19, 2014

Respectfully submitted,

/s/ Stacy Chen

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that this Joint Motion to Terminate as to Netflix was served by electronic mail, as agreed by the parties, on September 19, 2014, as follows:

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