

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HULU, LLC, and  
NETFLIX, INC.,  
Petitioners,

v.

UNILOC 2017 LLC,  
Patent Owner.

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Case IPR2020-00008  
Patent 9,721,273 B2

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**JOINT MOTION TO TERMINATE PETITIONER HULU, LLC  
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Hulu, LLC (“Hulu”) and Patent Owner Uniloc 2017 LLC (“Patent Owner”) jointly move to request the Patent Trial and Appeal Board (“Board”) to terminate the present *inter partes* review proceeding with respect to Petitioner Hulu.

## **I. STATEMENT OF FACTS**

Hulu and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. A “*Joint Request That Settlement Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreements. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office). The Board provided authorization to file this motion in an email dated January 21, 2020. A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB July 28, 2014).

- (1) **Brief Explanation.** Termination is appropriate in this case because the parties have settled their dispute.

(2) **Related Litigation.** The following litigations concern the '273 Patent:

- a) *Uniloc 2017 LLC v. Netflix, Inc.*, Case No. 8:18-cv-2055-GW-DFMx (C.D. Cal.) (filed November 17, 2018); and
- b) *Uniloc 2017 LLC v. Hulu, LLC*, Case No. 8:18-cv-2058-GW-DFWx (filed November 17, 2018).

## II. ARGUMENT

The Board should terminate this proceeding as to Hulu, as the parties jointly request, for the following reasons.

First, Hulu and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a).

Second, Hulu and Patent Owner have reached a settlement as to all the disputes in this proceeding and as to the '273 Patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Ex. 1022. Hulu and Patent Owner request that the settlement agreement be treated as business confidential information, and be kept separate from the files of this proceeding in accordance with 37 C.F.R.

§ 42.74(c). No other such agreements, written or oral, exist between or among the parties.

Accordingly, Hulu and Patent Owner jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding with respect to Hulu.

In addition, the IPR Petition was accorded a filing date on October 11, 2019 and is thus at a very early stage. Further, the Board has not decided on the merits of the case.

### **III. CONCLUSION**

For the foregoing reasons, Hulu and Patent Owners respectfully request termination of this *inter partes* review of the '273 Patent with respect to Hulu.

Respectfully submitted,  
/Babak Tehrani/

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Date: January 23, 2020

Respectfully submitted,  
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Date: January 23, 2020

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the following document has been served in its entirety by filing the JOINT MOTION TO TERMINATE PETITIONER HULU, LLC PURSUANT TO 35 U.S.C. § 317 through the USPTO Patent Trial and Appeal Board End-to-End System, as well as by causing the aforementioned document to be electronically mailed, pursuant to the parties' agreement, to the following attorneys of record for the Patent Owner listed below:

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