

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HULU, LLC AND NETFLIX, INC.,
Petitioners,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2020-00008
Patent 9,721,273 B2

Before KEVIN F. TURNER, JENNIFER S. BISK, and NEIL T. POWELL,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION
Granting Joint Motion to Terminate Petitioner Hulu, LLC
37 C.F.R. § 42.74

Petitioner, Hulu, LLC and Patent Owner, Uniloc 2017 LLC, jointly move to terminate the instant *inter partes* review with respect to Hulu in light of the settlement between Hulu and Uniloc that resolves their dispute regarding U.S. Patent No. 9,721,273 B2. Paper 10. Hulu and Uniloc also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 1022. Pursuant to 37 C.F.R. § 42.74(c), Hulu and Uniloc additionally filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 11.

For the reasons set forth below, the Joint Motion to Terminate with respect to Hulu and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act, settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An 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. If the inter partes review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner's institution of that inter partes review.

Here, we have not yet decided whether to institute an *inter partes* review. Upon review of the procedural posture of this proceeding and the facts before us, we determine that the parties' contentions have merit, and that it is appropriate to terminate this proceeding with respect Hulu. The

proceeding, however, will not be terminated with respect to Uniloc, as another Petitioner, Netflix Inc., remains in the proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to Hulu, is *granted*;

FURTHER ORDERED that this review is terminated with respect to Hulu only; this review continues with Uniloc and the remaining Petitioner;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*; and

FURTHER ORDERED that any subsequent papers filed in this *inter partes* review should not include Hulu in the caption.

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For PETITIONER:

Babak Tehranchi
Patrick McKeever
PERKINS COIE LLP
Tehranchi-ptab@perkinscoie.com
Mckeever-ptab@perkinscoie.com

For PATENT OWNER:

Ryan Loveless
Brett Mangrum
James Etheridge
Jeffrey Huang
ETHERIDGE LAW GROUP
ryan@etheridgelaw.com
brett@etheridgelaw.com
jim@etheridgelaw.com
jeff@etheridgelaw.com