

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,  
Petitioner,

v.

VL COLLECTIVE IP LLC,  
Patent Owner.

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IPR2022-01086  
Patent 8,605,794 B2

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Before KARL D. EASTHOM, JEFFREY S. SMITH, and  
PATRICK M. BOUCHER, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. §§ 42.5, 42.72, 42.73

On August 31, 2023, a conference call was held with the parties to discuss Petitioner's request for authorization to file a motion to terminate this proceeding. *See* Ex. 3001 (email requests from parties). Petitioner seeks to terminate the proceeding "so that it can reallocate its resources in

light of budget constraints.” *Id.* Patent Owner opposes “because there are substantial estoppel effects at play.” *Id.* During the conference call, Patent Owner elaborated that certain entities who it believes may be real parties in interest are involved in various proceedings in district court and before the Board. Patent Owner confirmed that no allegations that such parties are unnamed real parties in interest have otherwise been made in the instant proceeding.

Based on our understanding of Petitioner’s reasons for seeking to terminate the proceeding, it appears to us that any termination motion filed by Petitioner is most properly understood as an abandonment of the contest, which would be construed as a request for adverse judgment. *See* 37 C.F.R. § 42.73(b)(4); *but cf.* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, *where appropriate*” (emphasis added)); *see also Merrill Commc’ns LLC d/b/a Merrill Corp. v. E-Numerate Solutions, Inc.*, IPR2018-01389, Paper 17 (PTAB July 25, 2019) (Board construing unopposed request by a petitioner to withdraw as an abandonment of the contest). During the call, Petitioner indicated that it would oppose such a basis for termination, and Patent Owner indicated that it would not oppose such a basis for termination.

We authorize Petitioner to file a motion to terminate these proceedings. Petitioner’s motion should address the precise relief it is seeking as well as the precise factual and regulatory basis underlying its motion. In addition, Petitioner should indicate what relief it seeks, if any, if we construe Petitioner’s request as an abandonment of the contest under the facts presented. Patent Owner is authorized to file an opposition. To the

extent necessary, Patent Owner should explain its estoppel argument in detail.

Oral argument is currently scheduled for September 19, 2023.

Paper 29. We accordingly set forth an expedited schedule to complete this briefing.

It is ORDERED that

Petitioner is authorized to file a motion to terminate the proceedings as outlined above, limited to five pages, by September 5, 2023; and

Patent Owner is authorized to file an opposition to Petitioner's motion, limited to five pages, by September 8, 2023.

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