

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COMMSCOPE TECHNOLOGIES LLC  
CORNING OPTICAL COMMUNICATIONS LLC  
Petitioners

v.

DALI WIRELESS, INC.  
Patent Owner

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Case No. IPR2022-01293  
Patent No. 10,334,499

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**JOINT MOTION TO TERMINATE PROCEEDING AS TO  
PETITIONER CORNING OPTICAL COMMUNICATIONS LLC  
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R §§ 42.72, 42.74**

**EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Exhibit Description</b>
1001	U.S. Patent No. 10,334,499
1002	Prosecution History of U.S. Patent No. 10,334,499
1003	Declaration of Dr. Anthony Acampora
1004	<i>Curriculum Vitae</i> of Dr. Anthony Acampora
1005	U.S. Patent Application Publication No. 2010/0128676 A1 to Wu (“Wu”)
1006	U.S. Patent Application Publication No. 2008/0119198 A1 to Hettstedt (“Hettstedt”)
1007	Common Public Radio Interface (CPRI) Specification version 4.0 (2008-06-30)
1008	OBSAI “Reference Point 3 Specification Version 3.1” (November 13, 2006)
1009	OBSAI “BTS System Reference Document Version 2.0” (April 27, 2006)
1010	U.S. Patent Application Pub. No. 2009/0180426 A1 to Sabat et al. (“Sabat-426”)
1011	U.S. Patent No. 6,963,552 B2 to Sabat et al. (“Sabat-552”)
1012	U.S. Patent No. 10,080,178 (“’178 patent”)
1013	IPR2020-01473 Institution Decision (’178 patent IPR)
1014	IPR2020-01473 Judgment (’178 patent IPR)
1015	IPR2020-01473 Petition (’178 patent IPR)
1016	U.S. Patent No. 9,531,473 (“’473 patent”)
1017	IPR2018-00571 Final Written Decision (’473 patent IPR)
1018	Declaration of Dr. Peter Kenington
1019	Interim Procedure for Discretionary Denials in AIA Post-grant Proceedings with Parallel District Court Litigation
1020	Patent Owner’s Preliminary Infringement Contentions
1021	Provisional patent application number 61/439,940
1022	SKIPPED
1023	Complaint in Civil Action No. 2:22-cv-00012-RWS-RSP (E.D. Tex.)
1024	Preliminary Infringement Contentions by Patent Owner (Dali) in Civil Action No. 6:22-CV-00104-ADA (W.D. Tex.)
1025	U.S. Patent Application Pub. No. 2006/0094470 (“Wake”)
1026	U.S. Patent No. 7,286,507 (“Oh”)

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1027	Patent Owner's Preliminary Response in IPR2020-01466
1028	Claim Construction Order
1029	Patent Owner's Preliminary Response in IPR2020-01430
1030	U.S. Patent Number 6,785,558 ("Stratford")
1031	U.S. Patent Number 8,737,454 ("Wala")
1032	U.S. Patent Number 8,346,091 ("Kummetz")
1033	U.S. Patent Publication No. 2010/0296816 ("Larsen")
1034	U.S. Patent Number 7,848,747 ("Wala-747")
1035	U.S. Patent Number 8,204,544 ("Beaudin")
1036	U.S. Patent Publication No. 2005/0157675 ("Feder")
1037	Prosecution History of U.S. Patent No. 10,080,178
1038	Patent Owner's Preliminary Response in IPR2020-01473
1039	Patent Owner's Power of Attorney in IPR2020-01473
1040	ECF 174 in <i>Dali Wireless, Inc. v. CommScope Technologies LLC, et al.</i> , Case No. 1:19-cv-00952-MN (Attachment to Stipulation of Dismissal of Certain Claims)
1041	Final Written Decision in IPR2018-01178
1042	U.S. Patent Application Publication No. 2007/0177552 A1
1043	<i>Ethernet The Definitive Guide</i> , Spurgeon, (O'Reilly & Associates, Inc. 2000), Chapters 1-6
1044	<i>Hargraves Communications Dictionary</i> , Hargrave, F., IEEE Press p. 169
1045	Dali-Corning Settlement Agreement

## **I. STATEMENT OF RELIEF REQUESTED**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board’s authorization by email dated January 18, 2023, Petitioner Corning Optical Communications LLC (“Corning”) and Patent Owner Dali Wireless, Inc. (“Dali”) jointly move to terminate the present *inter partes* review (IPR) proceeding as to Corning as a result of a Settlement Agreement between Corning and Dali. The Settlement Agreement completely resolves all pending controversies between Corning and Dali concerning U.S. Patent No. 10,334,499 (“’499 patent”).

The Parties are concurrently filing a true copy of their Settlement Agreement in connection with this matter as required by statute. The Parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of Corning from this proceeding as set forth in 35 U.S.C. § 317(b).

## **II. STATEMENT OF FACTS**

Dali asserted the ’499 patent against Corning and other defendants in the action entitled *Dali Wireless, Inc. v. Cellco P’ship et al.*, Case No. 6:22-cv-00104-ADA (W.D. Tex.)<sup>1</sup> (“Corning Litigation”).

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<sup>1</sup> This case was later severed and became three cases: *Dali Wireless, Inc. v. Corning, Inc. et al.*, Case No. 6:22-cv-01314-ADA (W.D. Tex.), *Dali Wireless, Inc. v.*

Corning and CommScope Technologies LLC (“CommScope”) (collectively, “Petitioners”) filed a petition for IPR of all claims of the ’499 patent on July 20, 2022. Dali did not file a preliminary response. The Board has not yet determined whether to institute IPR.

On December 30, 2022, Corning and Dali entered into a Settlement Agreement pursuant to which they agreed, among other things, to mutually cooperate to request the termination of this IPR proceeding as to Corning (CommScope will remain a Petitioner). On or about January 17, 2023, Corning and Dali have filed a joint stipulation to dismiss the Corning Litigation.

Corning and CommScope also filed the following petition to institute IPR concerning another patent owned by Dali:

<b>IPR</b>	<b>Patent</b>	<b>Filed Date</b>
IPR2022-01242	11,026,232	July 1, 2022

Corning and Dali have filed a motion to terminate this proceedings as to Corning in light of the settlement between Corning and Dali. Thus, once the Board grants the motion, there will be no other proceedings before the Patent Office involving both Corning and Dali.

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*Ericsson Inc. et al.*, Case No. 6:22-cv-01313-ADA (W.D. Tex.), and *Dali Wireless, Inc. v. Cellco P’ship et al.*, Case No. 2:23-cv-00002 (E.D. Tex.). The -1314 case against Corning is being dismissed with prejudice.

### **III. LEGAL STANDARD**

35 U.S.C. § 317(a) provides that “[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.” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that the Board “expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

### **IV. GOOD CAUSE EXISTS TO TERMINATE THE ABOVE-CAPTIONED IPR AS TO CORNING**

Termination of the instant IPR as to Corning is appropriate because the Parties have settled their entire dispute concerning the ’499 patent and the Board has not yet decided the merits of this proceeding. Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding with respect to Corning. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (P.T.A.B. July

25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)).

Other factors weigh in favor of terminating this IPR proceeding as to Corning. First, trial in the above-captioned IPR is in its early phase and no institution decision has been made. In similar circumstances involving IPRs at such an early juncture, the Board has previously granted motions to terminate using its authority under at least 37 C.F.R. §§ 42.5(a) and 42.71(a). *See, e.g., Teva Pharmaceuticals USA, Inc. et al. v. Merck Sharp & Dohme Corp.*, IPR2020-01045, Paper 25 (P.T.A.B. Dec. 8, 2020) (granting joint motion to terminate); *Kavo Dental Techs., LLC v. Osseo Imaging, LLC*, IPR2020-00659, Paper 14 (P.T.A.B. Sept. 10, 2020) (same); *Zonar Systems, Inc. v. Innovative Global Systems, LLC*, IPR2020-00155, Paper 22 (P.T.A.B. Aug. 27, 2020) (same).

As set forth in 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the agreement has been made in writing in the form of a settlement agreement executed by the parties, and a true and correct copy of the Settlement Agreement has been filed as Exhibit 1045. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b). Thus, the Parties hereby represent that the document filed as Exhibit 1045 represents all agreements made in connection with, or in contemplation of, the termination of this proceeding. All such agreements have been filed with the Board as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

Further, termination of the proceeding as to Corning is a just and fair resolution. The Parties agree that neither Corning nor Dali will be prejudiced by the termination. Moreover, as noted above, the other Petitioner has confirmed that it does not object to the proceeding being terminated as to Corning. Finally, the Parties will benefit from preserving resources that would otherwise be expended if this motion is denied.

## **V. CONCLUSION**

Submitted concurrently herewith is a request by Corning and Dali that the Settlement Agreement (Exhibit 1045) be treated as business confidential information, be kept separate from the file of the involved patent, and be made 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).

For at least these reasons, Corning and Dali respectfully request that the Board grant this Joint Motion to Terminate the above-captioned IPR proceeding as to Corning.



Date: January 19, 2023

Respectfully submitted,

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the above-captioned “**JOINT MOTION TO TERMINATE PROCEEDING AS TO CORNING**” was served in its entirety on January 19, 2023 on Counsel for Patent Owner and Co-Petitioner via filing through the PTACTS System, as well as by delivering a copy via electronic mail to the following:

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(The below counsel were not served with Exhibit 1045 (Confidential).)

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