UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC,
Petitioner

v.

TIVO INC,
Patent Owner

Case IPR2016-01524
Patent 6,233,389

JOINT MOTION TO DISMISS PETITION

The Board authorized the filing of a joint motion to dismiss the Petition in this and other identified IPR cases on January 3, 2017. Previously, Petitioner met and conferred with Patent Owner, and Patent Owner does not oppose this Motion to Dismiss or otherwise object to Petitioner moving to dismiss the Petition and terminate the above-captioned IPR. In fact, Patent Owner joins this motion. Further, all parties agree that Patent Owner will not be prejudiced by the dismissal and that the dismissal will "secure the just, speedy, and inexpensive resolution" to the above-captioned IPR. *See* 37 C.F.R. § 42.1(b). Petitioner and Patent Owner hereby move for dismissal of the pending Petition and termination of the above-captioned IPR.

I. Good Cause Exists To Dismiss The Petition And Terminate The Above-Captioned IPR

Not only is this Motion to Dismiss unopposed, but there are a number of other factors that weigh in favor of dismissing the pending Petition. First, the above-captioned IPR is in its preliminary phase, no preliminary response has been filed, and the Board has yet to reach the merits and issue a decision on institution. In similar circumstances involving IPRs in such an early juncture, the Board has previously granted motions to dismiss using its authority under at least 37 C.F.R. §§ 42.5(a) and 42.71(a). *See, e.g., Apple Inc. v. Ericsson Inc.*, IPR2015-01905, Paper 7, (PTAB January 29, 2016) (granting unopposed motion to dismiss for twelve IPR petitions); *Celltrion, Inc. v. Cenetech, Inc.*, IPR2015-01733, Paper 12,

(PTAB October 6, 2015) (granting unopposed motion to dismiss petition); *Under Armour, Inc. v. Adidas AG*, IPR2015-01531, Paper 8, (PTAB September 21, 2015) (granting unopposed motion to dismiss petition); *Samsung Electronics Co. LTD v. Nvidia Corporation*, IPR2015-01270, Paper 11 (PTAB December 9, 2015) (dismissing Petition even over the patent owner's objection).

Second, dismissal of the Petition in the above-captioned IPR will preserve the Board's resources and the parties' resources while also epitomizing the Patent Office's policy of "secur[ing] the just, speedy, and inexpensive resolution" to the above-captioned IPR. *See* 37 C.F.R. § 42.1(b). Here, the requested dismissal would relieve the Board of the substantial time and resources required to consider the merits, issue an institution decision, and proceed through trial (if instituted). Likewise, even if Petitioner abandons the above-captioned IPR (regardless of whether this Motion to Dismiss is granted), granting this Motion to Dismiss would relieve the Patent Owner of the substantial expense in preparing responses, presenting expert testimony, and participating in an oral hearing. As such, it would be entirely proper for the Board to dismiss the pending Petition "at this early juncture[] to promote efficiency and minimize unnecessary costs." *Samsung*, IPR2015-01270, Paper 11 at p. 4.

Lastly, dismissal of the Petition and termination of the above-captioned IPR is a just and fair resolution. Again, all parties here agree that Patent Owner will

not be prejudiced by the dismissal. Moreover, the parties and the Board will benefit from preserving resources that would otherwise be expended if this Motion is denied.

II. Identification of Parties

This IPR petition is related to a lawsuit filed in the Eastern District of Texas (*TiVo Inc. v. Samsung Electronics Co., LTD., et al.*, Civil Action No. 2:15-cv-01503). On January 4, 2017, the parties filed a Stipulation of Dismissal of the lawsuit. All parties involved in the ligation are as follows:

TIVO INC.,

SAMSUNG ELECTRONICS CO., LTD., and

SAMSUNG ELECTRONICS AMERICA, INC.

III.   Identification and Status of Related Proceedings Before the USPTO

The following IPR petitions are related to the current IPR petition and/or the related litigation:

Case IPR2016-01524 Patent 6,233,389

Case IPR2016-01552 Patent 7,558,472

Case IPR2016-01553 Patent 7,558,472

Case IPR2016-01554 Patent 8,457,476

Case IPR2016-01555 Patent 8,457,476

Case IPR2016-01712 Patent 6,233,389

The current status of each of these IPR petitions is "Pending". Each is prior to institution and prior to any patent owner preliminary response. Motions to dismiss are being filed concurrently with respect to each petition. The parties agree that neither party would be prejudiced by dismissal of this and the related IPR petitions.

IV. Request to Keep Separate

Petitioner and Patent Owner are jointly submitting a settlement agreement herewith and hereby request that the settlement agreement be treated as business confidential information and kept separate from the files. This request is filed in accordance with 37 CFR § 42.74(c).

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