

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioner,

v.

UNILOC 2017 LLC,

Patent Owner.

Case IPR2017-01800

Patent 8,243,723

JOINT MOTION TO TERMINATE IPR PURSUANT TO 35 U.S.C. § 317

Petitioner Samsung Electronics America, Inc. (“Samsung”) and Patent Owner Uniloc 2017 LLC (“Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Samsung and Patent Owner jointly move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

Samsung and Patent Owner have reached an agreement to resolve the Parties’ disputes. The settlement agreement settles (i) this proceeding, (ii) IPR2017-01797, IPR2017-01798, IPR2017-01799, IPR2017-01801, and IPR2017-01802, and (iii) the related district court litigation styled *Uniloc USA, Inc. et al v. Samsung Electronics America, Inc.* 2-16-cv-00642 (EDTX). A stipulation of voluntary dismissal with prejudice was filed in the district court litigation on May 27, 2020. Contemporaneously with this Joint Motion to Terminate, the Parties are also filing Joint Motions to Terminate IPR2017-01797, IPR2017-01798, IPR2017-01799, IPR2017-01801, and IPR2017-01802. Exhibit 2013 filed concurrently herewith provides the status of related district court cases or USPTO proceedings with respect to all parties. In addition, the following appeals from USPTO proceedings concerning related patents are pending at the Federal Circuit:

| Case Name | Appeal No. | IPR No. | Patent |
|--------------------------------------|----------------|---------------|------------------|
| <i>Apple Inc. v. Uniloc 2017 LLC</i> | 19-1151 (Lead) | IPR2017-00222 | 8243723 by Rojas |

| Case Name | Appeal No. | IPR No. | Patent |
|--|----------------|---------------|------------------|
| <i>Facebook, Inc. v. Uniloc 2017 LLC</i> | 19-1179 | IPR2017-00222 | 8243723 by Rojas |
| <i>Apple Inc. v. Uniloc 2017 LLC</i> | 19-1203 | IPR2017-00222 | 8243723 by Rojas |
| <i>Uniloc 2017 LLC v. Apple Inc.</i> | 19-1197 | IPR2017-00221 | 7535890 by Rojas |
| <i>Uniloc 2017 LLC v. Facebook Inc.</i> | 19-1688 (Lead) | IPR2017-01427 | 8995433 by Rojas |
| <i>Uniloc 2017 LLC v. Facebook Inc.</i> | 19-1689 | IPR2017-01428 | 8995433 by Rojas |
| <i>Facebook, Inc. v. Uniloc 2017 LLC</i> | 19-2159 | IPR2017-01668 | 8724622 by Rojas |
| <i>Apple, Inc. v. Uniloc 2017 LLC</i> | 19-2160 | IPR2017-01668 | 8724622 by Rojas |
| <i>Uniloc 2017 LLC v. Facebook, Inc.</i> | 19-2162 (Lead) | IPR2017-01667 | 8724622 by Rojas |

Pursuant to 37 C.F.R. §42.74(b), the Parties’ settlement agreement is in writing, and a true and correct copy is being filed as Exhibit 2012. The settlement agreement is being filed electronically with access to “Board Only.” 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 seeking to treat the settlement agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37

C.F.R. § 42.74(c). The Board provided authorization to file this motion in an email dated June 9, 2020.

II. ARGUMENT

Termination of this *inter partes* review is requested, and the Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “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.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons.

First, Samsung 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, Samsung and Patent Owner have reached a settlement as to all the disputes in this proceeding and as to the ’723 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 2012. Samsung 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). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement as requested would also further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Samsung and Patent Owner respectfully request termination of this *inter partes* review.

Respectfully submitted,

/Naveen Modi/

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Date: June 10, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing document has been served in its entirety via email, pursuant to the parties' agreement, to the following attorneys of record listed below:

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Dated: June 10, 2020

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