

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

PETITIONER,

V.

BELL NORTHERN RESEARCH, LLC,

PATENT OWNER.

Case No. IPR2019-01365
U.S. Patent No. 7,039,435

**PETITIONER SAMSUNG ELECTRONICS CO., LTD.
AND PATENT OWNER'S JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Samsung Electronics Co., Ltd. (“Petitioner” or “SEC”) and Patent Owner Bell Northern Research, LLC (“Patent Owner”) (collectively, the “parties”) jointly request termination of this inter partes review (IPR) of U.S. Patent No. 7,039,435 (“435 patent” or “challenged patent”), Case No. IPR2019-01365. The parties note that the Patent Owner’s Sur-Reply is due on October 20, 2020. (Paper No. 28 at 4.)

The parties have settled with respect to the challenged patent and have reached agreement to terminate this IPR. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board via email to file this motion on October 15, 2020.

In light of this joint request and petitioner ZTE’s pending motion to terminate (Paper 29), termination of this proceeding is proper for at least the following reasons:

- The parties are jointly requesting termination. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”) (emphasis added). Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir.

1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Here, no public interest or other factors weigh against termination of this proceeding.

- The Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a) (emphasis added); 77 Fed. Reg. 48768 (“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.”). No other party’s rights will be prejudiced by the termination of this inter partes review. In fact, Patent Owner and petitioner ZTE jointly moved to terminate ZTE from this proceeding, and that motion is pending (Paper 29). This supports the propriety of terminating this proceeding. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012).
- The related district court case, *Bell Northern Research, LLC v. Samsung Electronics Co., Ltd., et al.*, Case No. 2:19-cv-00286-JRG in the Eastern District of Texas, has been dismissed with prejudice.

The settlement agreement between the parties has been made in writing, and a true and correct copy will be filed with this motion as Exhibit 1033.

Dated: October 19, 2020

Respectfully submitted,

/Naveen Modi/

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CERTIFICATE OF SERVICE

I hereby certify that on October 19, 2020, a copy of the foregoing Petitioner Samsung Electronics Co., Ltd. And Patent Owner's Joint Motion To Terminate Pursuant To 35 U.S.C. § 317 was served by electronic means upon the following:

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Respectfully submitted,

Dated: October 19, 2020

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