

Filed: June 8, 2020

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. IPR2020-00698

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. IPR2020-00698.¹ The parties note that the Patent Owner’s Preliminary Response is due on June 17, 2020.

The parties have settled with respect to the only claim addressed from the challenged patent by Case No. IPR2020-00698, 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 to file this motion on June 8, 2020.

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

¹ Only claim 8 of the ’435 patent is challenged in Case No. IPR2020-00698.

(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.”). Indeed, the Board has not yet made a decision on institution of this inter partes review. Petitioner filed its petition for inter partes review on March 10, 2020. No Motions are outstanding in this proceeding. No other party’s rights will be prejudiced by the termination of this inter partes review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings. 77 Fed. Reg. 48680, 48686 (Aug. 14, 2012) (And 35 U.S.C. 317(a) provides “An 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.”)

- The parties in the related district court action, *Bell Northern Research, LLC v. Samsung Electronics Co., Ltd., et al.*, Case No. 2:19-cv-00286-JRG pending in the Eastern District of Texas have reached an agreement to end any dispute as to claim 8 of the '435 Patent.

Petitioner and Patent Owner are aware that IPR2020-00697, IPR2020-00319, and IPR2019-01365, each related to the '435 patent, remain pending.

The settlement agreement between the parties has been made in writing, and a true and correct copy will be filed with this request as Exhibit 1030.

Dated: June 8, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on June 8, 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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