

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner

Case No. IPR2021-00539

Patent No. 9,860,044

**UNOPPOSED MOTION TO DISMISS
PETITION FOR *INTER PARTES* REVIEW**

On May 14, 2021 the Board authorized Petitioner, Samsung Electronics Co., Ltd. to file unopposed motions to dismiss in each of IPR2021-00459, IPR2021-00460, IPR2021-00486, IPR2021-00487, IPR2021-00508, IPR2021-00509, IPR2021-00536, IPR2021-00537, IPR2021-00539, IPR2021-00567, IPR2021-00568, IPR2021-00569, IPR2021-00729, IPR2021-00730, IPR2021-00731, and IPR2021-00732.

More specifically, in response to Petitioner’s request for authorization to file an unopposed motion to dismiss in each of the above-captioned proceedings, the Board stated that “Petitioner is authorized to file either a motion to dismiss or, if the parties seek termination pursuant to a settlement, a joint motion to terminate,” adding that “[i]f Petitioner files a motion to dismiss a proceeding, Petitioner shall identify any ‘appropriate circumstances’ giving rise to the motion” and “specify ... whether Patent Owner opposes it.” Consistent with the Board’s instruction, this motion to dismiss offers an explanation of the appropriate circumstances giving rise to this motion, while also confirming that Patent Owner does not oppose this motion.

Moreover, as explained in more detail below, dismissal of the instant *inter partes* review Petition under 37 C.F.R. 42.71 is the appropriate mechanism for addressing the Petition under the circumstances giving rise to this motion, as the

Petition is presently pending and awaiting a decision on institution,¹ and dismissal would preserve the Board's and parties' resources and promote a speedy and inexpensive resolution to the dispute, without prejudicing Patent Owner. *See Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257 Pap. 16, 3 (PTAB Jan. 2, 2020) (granting petitioner's unopposed motion to dismiss "to promote efficiency and minimize unnecessary costs"); 37 C.F.R. 42.71 (The Board may "grant, deny, or dismiss" a petition or motion).

Accordingly, Petitioner hereby moves unopposed for dismissal of the pending Petition.

A. PTAB rules provide for dismissal of a pending petition for *inter partes* review without reaching the merits

To request *inter partes* review of a patent, "a person who is not the owner of a patent may file with the Office *a petition to institute an inter partes review* of the patent."² 35 U.S.C. § 311. Thereafter, if reaching the merits, the Board either

¹ In Sections C. and D., *infra*, Petitioner addresses the Board's alternative authorization to file a motion to terminate "if the parties seek termination pursuant to a settlement," and the Board's corresponding instruction to file a true copy of the settlement agreement with any such motion.

² Unless indicated, emphases in quotes throughout this motion are added.

grants the petition, which yields institution of an *inter partes* review, or denies the petition, which results in non-institution of an *inter partes* review. In rendering its decision on institution, the Board evaluates “whether the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Notably, prior to such a decision on institution, no *inter partes* review has commenced. *See, e.g.*, 35 U.S.C. §§ 311-313. Statutes addressing pre-institution procedures therefore consistently refer to “the petition” rather than an “*inter partes* review” proceeding. *Id.*; *see also Intellectual Ventures II LLC v. JPMorgan Chase and Co.*, 781 F.3d 1372, 1376 (“The AIA differentiates between a petition for a CBMR proceeding (which a party files) and the act of instituting such a proceeding (which the Director is authorized to do”). This stands to reason, as its name – institution decision – confirms that *inter partes* review does not commence until a decision to institute has been rendered. *See also institution*, Black's Law Dictionary (8th ed. 2004) (“The commencement of something, such as a civil or criminal action”).

With respect to a petition, therefore, the PTAB rules aptly and affirmatively proscribe that the Board may reach the merits of the decision through grant or denial, in the manner noted above. And importantly, the PTAB rules recognize

one more option—dismissal. 37 C.F.R. 42.71 (“the Board ... may grant, deny, or *dismiss* any petition or motion”); *see also, e.g.*, 37 CFR 42.12(b)(8) (describing sanctions including “*dismissal of the petition*”); 37 CFR 42.106(b) (in the case of an incomplete petition, “the Office will *dismiss the petition* if the deficiency in the petition is not corrected within one month from the notice of an incomplete petition”).

In contrast, no rule or statute authorizes the Board to “dismiss” a trial on an instituted *inter partes* review. Instead, “the Board may *terminate a trial*” or an “instituted” *inter partes* review. 37 C.F.R. 42.72; 35 U.S.C. § 317(a); *see also, e.g.*, 37 C.F.R. 42.2 (a “trial” is “a contested case instituted by the Board based upon a petition”). And as noted in section C., *infra*, no rule or statute authorizes the Board to “terminate” a petition. Thus, read together, authority is offered for dismissal (of a petition) pending decision on the petition’s institution merits (*i.e.*, without granting or denying it), and for termination (of trial) following a decision on the petition’s institution merits. *See* 37 C.F.R. 42.71; 37 C.F.R. 42.72; 35 U.S.C. § 317(a).

In the present case, a Petition requesting *inter partes* review awaits a Board decision on institution. The Board has yet to decide whether to grant the Petition—and thus institute trial—or deny the Petition. Under the rules, the proper mechanism for dispatching this pending Petition prior to an institution decision by

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