

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

RFCYBER CORP.,
Patent Owner.

IPR2021-00980 (Patent 9,189,787 B1)
IPR2021-00981 (Patent 9,240,009 B2)¹

Before PATRICK R. SCANLON and KEVIN W. CHERRY,
Administrative Patent Judges.

SCANLON, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ We exercise our discretion to issue a single Order to be entered in each case using a joint caption. The parties are not permitted to use this caption. For convenience, we use the Paper and Exhibit numbers from IPR2021-00980.

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On March 29, 2022, Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (“Petitioner”) and RFCyber Corp. (“Patent Owner”) filed joint motions to terminate these proceedings pursuant to 35 U.S.C. § 317. Paper 16 (“Mot.”). Each motion was accompanied by a true, unredacted copy of a settlement and license agreement (Ex. 1047), and a joint request to treat the agreement as business confidential information, to be kept separate from the patent file, pursuant to 35 U.S.C. § 317(b) (Paper 17).

The parties represent in their joint motions that they have settled their dispute regarding the patents challenged in these *inter partes* review proceedings, as well as the related district court proceedings. Mot. 1. The parties state that they “do not anticipate further litigation between them concerning the” challenged patents. *Id.*

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” As indicated in the Joint Motions, the parties are requesting termination prior to oral hearing and prior to the Board’s final written decision. Mot. 2. The parties also note that “no patent owner response or further papers have been filed.” *Id.*

Under the circumstances presented here, we determine that termination of the proceedings is appropriate. *See* Consolidated Trial Practice Guide (November 2019)² at 86 (“The Board expects that a

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”). Accordingly, we grant the parties’ joint motions to terminate.

We also determine that the parties have complied with the requirements of 37 C.F.R. § 42.74(c) to have the settlement and license agreement treated as business confidential information and kept separate from the patent files of the challenged patents. Thus, we grant the joint requests to treat the settlement and license agreement as business confidential.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the joint motions to terminate are *granted*;

FURTHER ORDERED that each of these proceedings is *terminated*;

and

FURTHER ORDERED that the joint requests to treat the settlement and license agreement as business confidential information are *granted*, and the settlement and license agreement shall be kept separate from the files of U.S. Patent Nos. 9,189,787 and 9,240,009, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

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FOR PETITIONER:

Heath J. Briggs
Andrew R. Sommer
GREENBERG TRAUIG, LLP
briggsh@gtlaw.com
sommera@gtlaw.com

FOR PATENT OWNER:

Vincent J. Rubino, III
Peter Lambrianakos
Enrique W. Iturralde
Richard Cowell
FABRICANT LLP
vrubino@fabricantllp.com
plambrianakos@fabricantllp.com
eiturralde@fabricantllp.com
rcowell@fabricantllp.com