

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SCRAMOGE TECHNOLOGY LTD.,
Patent Owner.

IPR2022-00284 (Patent 9,997,962 B2)
IPR2022-00385 (Patent 9,843,215 B2)¹

Before JAMESON LEE, KARL D. EASTHOM, BRIAN J. McNAMARA,
and AARON W. MOORE, *Administrative Patent Judges*.²

EASTHOM, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
as to Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc.
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order addresses the same issue for the above-identified proceedings.

² This is not an expanded panel. Judges Lee, Easthom, and Moore are the panel for IPR2022-00284. Judges Lee, Easthom, and McNamara are the panel for IPR2022-00385.

IPR2022-00284 (Patent 9,997,962 B2)

IPR2022-00385 (Patent 9,843,215 B2)

I. INTRODUCTION

On August 15, 2022, with the Board’s authorization, Petitioner Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively “Samsung”) and Patent Owner Scramoge Technology Ltd. (“Patent Owner”) filed a Joint Motion to Terminate (“Joint Motion”) with respect to Samsung in each of the above-identified proceedings due to a settlement. Paper 14.³ With the Joint Motion, Samsung and Patent Owner filed, in each of the above-identified proceedings, a copy of their Patent License Agreement (Ex. 1028) and their Escrow Agreement (Ex. 1029) (collectively “Settlement Agreement”) that resolves the disputes related to the above-identified proceedings. Joint Motion 1. Samsung and Patent Owner also filed, in each of the above-identified proceedings, a Joint Request to Keep Separate (“Joint Request”) that requests the Board to treat the Settlement Agreement as business confidential information and to keep it separate from the publicly available files in the above-identified proceedings. Paper 15, 1.

II. DISCUSSION

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Prior to termination, the parties must file true copies of “[a]ny agreement or understanding between the patent owner and a petitioner, including any

³ References are to Papers and Exhibits in IPR2022-00284; however, reference to Papers 14 and 15 include Papers 16 and 17 in IPR2022-00385, respectively. Reference to Exhibits 1028 and 1029 includes Exhibits 1033 and 1034 in IPR2022-00385, respectively.

IPR2022-00284 (Patent 9,997,962 B2)

IPR2022-00385 (Patent 9,843,215 B2)

collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an *inter partes* review.” 35 U.S.C. § 317(b).

In the Joint Motion, Samsung and Patent Owner represent that they have reached an agreement to seek termination of the above-identified *inter partes* review proceedings under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74. Joint Motion 1. Samsung and Patent Owner indicate that “a copy of the settlement agreement that resolves the disputes in the [above-identified] *inter partes* [reviews] relating to [the above-identified patents] as between Scramoge and Samsung is filed herewith as an exhibit.” *Id.* Samsung and Patent Owner also certify “[t]here are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.” *Id.* The Joint Motion and Settlement Agreement collectively show that the parties represent that they filed all agreements between themselves, including all collateral agreements referred to, made in connection with, or in contemplation of, the termination of this proceeding, as 35 U.S.C. § 317(b) requires.

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019) (“Consolidated TPG”)⁴; *see also* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The Board has not decided the merits of these proceedings. Accordingly, under the circumstances present here, it is appropriate to terminate the instant proceedings as to Samsung. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.72(a, b), 42.74. The grant of the Joint Motion will not result in termination of the instant *inter*

⁴ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

IPR2022-00284 (Patent 9,997,962 B2)

IPR2022-00385 (Patent 9,843,215 B2)

partes reviews, however, because Google LLC remains as Petitioner.

Further, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Samsung and Patent Owner as business confidential information and to keep it separate from the files of the patents in the above-identified proceedings pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

For the reasons discussed above, it is

ORDERED that the Joint Motion with respect to Samsung is *granted* and these proceedings are terminated only as to Samsung;

FURTHER ORDERED that Google LLC will remain as Petitioner in each of these proceedings, and each of the above-identified proceedings will continue;

FURTHER ORDERED that the Joint Request is *granted*, and that the Settlement Agreement in each case shall be kept separate from the respective files of U.S. Patent Nos. 9,997,962 B2 and 9,843,215 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the caption for each of the above-identified proceedings is modified as set forth on the attached Exhibit. The remaining parties are directed to use this caption in all further filings.

IPR2022-00284 (Patent 9,997,962 B2)

IPR2022-00385 (Patent 9,843,215 B2)

For PETITIONER:

John Kappos
Cameron Westin
O'MELVENY & MYERS LLP
jkappos@omm.com
cwestin@omm.com

Naveen Modi
Joseph Palys
Paul Anderson
Phillip Citroen
Quadeer Ahmed
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
paulanderson@paulhastings.com
phillipcitroen@paulhastings.com
quadeerahmed@paulhastings.com

For PATENT OWNER:

Brett Cooper
Reza Mirzaie
RUSS AUGUST & KABAT
bcooper@raklaw.com
rmirzaie@raklaw.com

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.