

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SCRAMOGE TECHNOLOGY LTD.
Patent Owner.

Case No. IPR2022-00385
U.S. Patent No. 9,843,215

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW WITH
RESPECT TO PETITIONER SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC. ONLY**

Patent Owner Scramoge Technology Ltd. (“Scramoge”) and Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request termination of the *inter partes* review of U.S. Patent No. 9,843,215 (“Patent-in-Suit”), Case IPR2022-00385 with respect to Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. only. The settlement agreement does not extend to Co-Petitioner Google LLC (“Other Petitioner”). The Other Petitioner does not oppose this motion, with the understanding that the *inter partes* review will continue with respect to the Other Petitioner. The parties were authorized to file this Joint Motion by the Board (via email) on August 9, 2022.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a copy of the settlement agreement that resolves the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit as between Scramoge and Samsung is filed herewith as an exhibit. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Scramoge and Samsung are concurrently filing a Joint Request to Keep Separate, which asks the Board to treat the settlement agreement as business confidential information, and

to keep it separate from the files of this proceeding and the files of the Patent-in-Suit.

I. STATEMENT OF PRECISE RELIEF REQUESTED

The parties jointly request that the Board terminate the *inter partes* review of the Patent-in-Suit, Case IPR2022-00385, with respect to Petitioner Samsung only.

II. TERMINATION WITH RESPECT TO SAMSUNG IS APPROPRIATE

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.” This *inter partes* review is still in its early stages. The Petition was filed on December 7, 2021, and the Board has not yet decided the merits of the proceeding. Accordingly, the Board should terminate with proceeding with respect to Samsung.

The lawsuits between Scramoge and Samsung have been dismissed, and Scramoge and Samsung do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future.

III. NO FUTURE PARTICIPATION BY SAMSUNG

Samsung will not participate further in this proceeding.

IV. CONCLUSION

Scramoge and Samsung have settled all disputes relating to the Patent-in-

Suit. That settlement does not extend to the Other Petitioner, but the Other Petitioner does not oppose this motion with the understanding that this *inter partes* review will continue with respect to the Other Petitioner. This *inter partes* review is in an early stage, and the Board has not entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request that the Board terminate this proceeding with respect to Samsung only.

Dated: August 15, 2022

Respectfully submitted,

/s/ John Kappos

John Kappos (Reg. No. 37,861)
Email: jkappos@omm.com
O'Melveny & Myers LLP
610 Newport Center Dr., 17th Floor
Newport Beach, California 92660
Telephone: (949) 823-6900

Attorney for Petitioners

/s/ Brett Cooper

Brett Cooper (Reg. No. 55,085)
Email: bcooper@raklaw.com
RUSS AUGUST & KABAT
12424 Wilshire Boulevard, 12th Floor
Los Angeles, CA 90025
Telephone: 310-826-7474

Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies to 37 C.F.R. §42.6(e) and §42.105 that the above document was served on August 15, 2022 by filing this document through the Patent Trial and Appeal Board End to End system as well as by delivering a copy via electronic mail to the attorneys of record for the Patent Owner:

/s/ John Kappos
John Kappos (Reg. No. 37,861)
Email: jkappos@omm.com
O'Melveny & Myers LLP
610 Newport Center Dr., 17th Floor
Newport Beach, California 92660
Telephone: (949) 823-6900
Attorney for Petitioners