

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.

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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.

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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>.

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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.

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