

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS CO., LTD,  
Petitioner,

v.

AIRE TECHNOLOGY LIMITED,  
Patent Owner.

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Case No. IPR2022-00876  
U.S. Patent No. 8,581,706

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**JOINT MOTION TO DISMISS  
PURSUANT TO 37 C.F.R. § 42.71**

**EXHIBITS**

- SAMSUNG-1001 U.S. Patent No. 8,581,706 to Klaus Finkenzeller et al. (“the ’706 patent”)
- SAMSUNG-1002 Excerpts from the Prosecution History of the ’706 Patent (“the Prosecution History”)
- SAMSUNG-1003 Declaration of Dr. Tajana Rosing
- SAMSUNG-1004 U.S. Patent Publication No. 2005/0184163 to de Jong (hereinafter, “Jong”)
- SAMSUNG-1005 Certified Translation of Japanese Laid-Open Patent Application No. 2000-163539 to Nozawa
- SAMSUNG-1006 Japanese Laid-Open Patent Application No. 2000-163539 to Nozawa
- SAMSUNG-1007 U.S. Patent No. 6,220,510 to Everett et al.
- SAMSUNG-1008 U.S. Patent No. 8,016,192 to Messerges et al.
- SAMSUNG-1009 Excerpts from *RFID Handbook*, 2<sup>nd</sup> Edition, Klaus Finkenzeller, 2003 (hereinafter, “RFIDH”)
- SAMSUNG-1010 U.S. Patent Publication No. 2008/0212558 to Aillaud et al.
- SAMSUNG-1011 *Java Card™ 2.1 Runtime Environment (JCRE) Specification (Revision 1.0)*, Sun Microsystems, February 24, 1999
- SAMSUNG-1012 *Java Card 2.1™ Virtual Machine Specification (Revision 1.0)*, Sun Microsystems, March 3, 1999 (hereinafter, “JCVM”)
- SAMSUNG-1013 *Java Card 2.1 Application Programming Interface (Revision 1.0)*, Sun Microsystems, February 24, 1999
- SAMSUNG-1014 *ISO/IEC Standard 14443-3: Initialization and Anticollision*, First Edition, February 1, 2001

SAMSUNG-1015 *Contactless Payment and the Retail Point of Sale: Applications, Technologies and Transaction Models*, Smart Card Alliance, March 2003

SAMSUNG-1016 *Contactless Technology for Secure Physical Access: Technology and Standards Choices*, Smart Card Alliance, October 2002

SAMSUNG-1017 *Contactless Payments: Delivering Merchant and Consumer Benefits*, Smart Card Alliance, April 2004

SAMSUNG-1018 U.S. Patent No. 7,232,073 to de Jong

SAMSUNG-1019 U.S. Patent No. 5,721,781 to Deo et al.

SAMSUNG-1020-1021 [RESERVED]

SAMSUNG-1022 U.S. Patent Publication No. 2004/0083380 to Janke

SAMSUNG-1023 European Patent No. 0818761 to Drupsteen et al.

SAMSUNG-1024-1099 [RESERVED]

SAMSUNG-1100 Complaint from *Aire Technology Ltd. v. Samsung Electronics Co., Ltd.*, Case No. 6:21-cv-00955-ADA (W.D. Tex.)

SAMSUNG-1101 Court's Docket for *Aire Technology Ltd. v. Samsung Electronics Co., Ltd.*, Case No. 6:21-cv-00955-ADA (W.D. Tex.)

SAMSUNG-1102 Patent License Agreement and Escrow Agreement

SAMSUNG-1103 Declaration of June Ann Munford

## I. RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71, and the Board’s authorization provided by email on August 30, 2022, Petitioner Samsung Electronics Co., Ltd. (“Petitioner”) and Patent Owner Aire Technology Ltd. (“Patent Owner”) jointly request dismissal of the present Petition involving U.S. Patent No. 8,581,706 (the “’706 Patent”), and dismissal of IPR2022-00876 in its entirety.

## II. BACKGROUND

### A. Status of the Present Proceeding

IPR2022-00876 was initiated by the filing of a Petition for *inter partes* review of the ’706 Patent on May 2, 2022. The Board accorded a filing date to the Petition on May 18, 2022, and the deadline for a decision on institution is still months away (November 18, 2022).

### B. Related Matters Involving the ’706 Patent

In addition to IPR2022-00876, the ’706 Patent is separately involved in *Aire Technology Ltd. v. Samsung Electronics Co., Ltd*, Case No. 6:21-cv-00955-ADA (W.D. Tex.) (“Related Litigation”), in which Patent Owner is the plaintiff and Petitioner is a defendant; *Aire Technology Ltd. v. Apple Inc.*, Case No. 6:21-cv-1101-ADA (W.D.Tex.); *Aire Technology Ltd. v. Google LLC*, Case No. 6:21-cv-1104ADA (W.D. Tex.); *Aire Technology Ltd. v. Garmin Int’l Inc.*, Case No. 8:22-cv-01027-JVS-KES (C.D. Cal.); and *Apple Inc. v. Aire Technology Ltd.*, IPR2022-01137 (PTAB June 15, 2022).

Petitioner and Patent Owner jointly moved to dismiss the Related Litigation in the U.S. District Court for the Western District of Texas on August 9, 2022. The '706 Patent is not involved in any other pending litigation.

**C. Filing of Patent License Agreement and Escrow Agreement, and Certification of No Collateral Agreements or Understandings**

Petitioner and Patent Owner executed a Patent License Agreement and an Escrow Agreement on June 30, 2022, which fully settled all matters in controversy between the parties. The parties are concurrently filing true copies of the Patent License Agreement and the Escrow Agreement in Exhibit 1102, along with a Joint Request That Patent License Agreement and Escrow Agreement Be Treated As Business Confidential Information under 37 C.F.R. § 42.74(c).

Petitioner and Patent Owner certify that, beyond the Patent License and Escrow Agreements, there are no collateral agreements or understandings made in connection with, or in contemplation of, dismissal of the present Petition, or of IPR2022-00876.

**IV. GOOD CAUSE JUSTIFIES DISMISSAL OF THE PETITION**

Consistent with 37 C.F.R. § 42.71(a), the Board has recognized that dismissal of pre-institution petitions is available upon a showing of good cause. *See, e.g., Samsung Elec. Co. Ltd. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00446, Paper 7, at 5 (PTAB August 3, 2021) (finding good cause to dismiss a petition where “[t]he parties have settled their dispute, the proceedings are early in the preliminary stages,

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