

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., AND QUALCOMM INCORPORATED,
Petitioner,

v.

DAEDALUS PRIME LLC,
Patent Owner.

Cases IPR2023-00547 (Patent 10,705,588 B2);
IPR2023-00550 (Patent 8,775,833 B2);
IPR2023-00567 (Patent 10,049,080 B2); and
IPR2023-00617 (Patent 8,898,494 B2)

Before WILLIAM V. SAINDON, THOMAS L. GIANNETTI,
ARTHUR M. PESLAK, KRISTIL R. SAWERT, *Administrative Patent
Judges.*¹

SAWERT, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ This is not an expanded panel. The panel for IPR2023-00547 and -00550 includes Judges Saindon, Peslak, and Sawert. The panel for IPR2023-00567 and -00617 includes Judges Saindon, Giannetti, and Sawert.

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)

In the above-referenced proceedings, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. (collectively, “Samsung”) and Qualcomm Incorporated (“Qualcomm”) filed Petitions requesting *inter partes* review of all or certain claims of U.S. Patent No. 10,705,588 B2 (IPR2023-00547), U.S. Patent No. 8,775,833 B2 (IPR2023-0055), U.S. Patent No. 10,049,080 B2 (IPR2023-00567), and U.S. Patent No. 8,898,494 B2 (IPR2023-00617).

Daedalus Prime LLC (“Patent Owner”) has not yet filed Preliminary Responses in any of these proceedings.

On April 28, 2023, Samsung’s counsel emailed the Board and stated that the “underlying litigations involving the challenged patents have been settled, in principle, between Samsung and Daedalus.” Ex. 3001. Samsung’s counsel stated that Samsung no longer seeks to pursue these *inter partes* reviews, and “[t]o prevent the parties from expending further resources while the settlement is being finalized, Samsung asks for a pause of all [Patent Owner Preliminary Response] deadlines for 30 days to allow Samsung and Daedalus to finalize their agreement.” *Id.* Samsung’s counsel also stated that Patent Owner “does not oppose these requests,” and that “[c]ounsel for Qualcomm is copied on this email.” *Id.*

On May 2, 2023, counsel for Qualcomm emailed the Board. Ex. 3002. In that email, counsel for Qualcomm stated that “Qualcomm has not resolved its dispute with Patent Owner and has not agreed to any stay or extension in [these] four proceedings.” *Id.* The Board held a conference call with counsel for Samsung, Qualcomm, and Patent Owner on May 10, 2023. No court reporter was present.

IPR2023-00547 (Patent 10,705,588 B2)
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During the call, counsel for Qualcomm and Patent Owner stated that they have not entered into any settlement negotiations. Counsel for Qualcomm, therefore, requested that Samsung's request for extensions of time be denied. Counsel for Qualcomm argued that these proceedings should be conducted within the time periods contemplated by the statutes and regulations governing *inter partes* review. Patent Owner, however, requested that the due dates for filing its Patent Owner Preliminary Responses be extended to conserve its resources during settlement negotiations with Samsung.

The panels have considered the parties' respective arguments and determine that, under these circumstances, good cause exists for a 30-day extension of time for Patent Owner to file its Patent Owner Preliminary Responses in these proceedings. 37 C.F.R. § 42.5(c)(2). Although Qualcomm is correct that the general procedures of an *inter partes* review are designed to ensure the speedy resolution of disputes between parties, Qualcomm has not identified any particular prejudice that it would experience from a 30-day delay in these proceedings. Moreover, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Patent Trial and Appeal Board, *Consolidated Trial Practice Guide*, p. 86 (Nov. 2019).² We determine that the benefits from settlement negotiations here outweigh any potential harm to Qualcomm from a 30-day delay, especially given that the parties have not identified any co-pending district-court litigations involving Qualcomm and the Patent Owner.

² Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

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See IPR2023-00547, Paper 6, 1; IPR2023-00550, Paper 6, 1; IPR2023-00567, Paper 6, 1; IPR2023-00617, Paper 6, 1.

Accordingly, it is

ORDERED that the due date for filing Patent Owner Preliminary Response in each of the above-referenced proceedings is extended by thirty (30) days; and

FURTHER ORDERED that no other extensions of time will be granted.

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