

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVX CORPORATION

Petitioner

v.

SAMSUNG ELECTRO-MECHANICS CO., LTD.

Patent Owner

Case No. PGR2017-00010

Patent No. 9,326,381

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 327 AND 37 C.F.R. § 42.72**

Pursuant to 35 U.S.C. § 327, 37 C.F.R. § 42.72, and the Board's Order entered January 30, 2018, Patent Owner Samsung Electro-Mechanics Co., Ltd. ("SEM") and Petitioner AVX Corporation ("AVX") (collectively, the "Parties") jointly request termination of post-grant review no. 2017-00010.

The Parties have executed a settlement agreement that resolves their dispute regarding U.S. Pat. No. 9,326,381 ("the '381 Patent"). Pursuant to 37 C.F.R. § 42.74(b), the Parties' settlement agreement is in writing, and a true and unredacted copy is filed herewith as Exhibit 1029. There are no other agreements or understandings between the parties made in connection with, or in contemplation of, the termination of this proceeding. Pursuant to 37 C.F.R. § 42.74(b) , 35 U.S.C. § 327(b) , and the Board's Order (Paper 22), a joint motion to treat the settlement as business confidential information and to keep it separate is filed herewith.

I. Background

On January 26, 2017, AVX filed a Petition for post-grant review of claims 1–19 of the '381 Patent. Paper No. 2. On May 5, 2017, SEM filed a Preliminary Response. Paper No. 6. On July 18, 2017, the Board instituted trial as to claims 1–4, 6–11, and 13–19 of the '381 Patent. Paper No. 11. On September 29, 2017, SEM filed its Response to the Petition. Paper No. 16. Petitioner has not yet filed its Reply and the Board has not heard oral argument.

On January 29, 2018, the Parties informed the Board of their settlement agreement and sought authorization to file the present motion. The Board granted authorization on January 30, 2018. Paper No. 22.

II. Termination as to Patent Owner and Petitioner is Appropriate

Termination of this post-grant review is appropriate because the Board has not yet “decided the merits of the proceeding.” 35 U.S.C. § 327(a); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Briefing has not been completed, because Petitioner has not yet filed its Reply brief. Furthermore, the oral hearing has not yet been conducted.

The Parties have entered into a settlement agreement and no dispute remains between them involving the '381 Patent. There are no other Board proceedings involving the '381 Patent and there is no litigation involving the '381 Patent. AVX is the sole Petitioner in this proceeding.

III. Conclusion

For the foregoing reasons, Patent Owner and Petitioner jointly request that the Board terminate this post-grant review proceeding.

Respectfully submitted,

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Date: February 5, 2018

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on February 5, 2018, a complete and entire copy of the foregoing was provided via electronic mail to the following attorneys of record for patent owner:

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Respectfully submitted,

Dated: February 5, 2018

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