

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.,  
SAMSUNG ELECTRONICS AMERICA, INC., and  
SAMSUNG AUSTIN SEMICONDUCTOR, LLC,  
Petitioner,

v.

INVENSAS CORPORATION,  
Patent Owner.

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Cases  
IPR2018-01401 (Patent 6,232,231 B1)  
IPR2018-01402 (Patent 6,849,946 B2)<sup>1</sup>

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Before MICHAEL R. ZECHER, LYNNE E. PETTIGREW, and  
KAMRAN JIVANI, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION  
Granting Parties' Joint Motions to Terminate Proceeding  
*37 C.F.R. §§ 42.71(a) and 42.74*

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<sup>1</sup> This Decision addresses an issue that is identical in both cases. We, therefore, exercise our discretion to issue one Decision to be filed in each case.

IPR2018-01401 (Patent 6,232,231 B1)  
IPR2018-01402 (Patent 6,849,946 B2)

## I. DISCUSSION

On December 13, 2018, the parties jointly filed the following documents in each proceeding identified above: (1) a Joint Motion to Terminate Proceeding (Case IPR2018-01401, Paper 9; Case IPR2018-01402, Paper 9); (2) a true copy of the parties' settlement agreement (Case IPR2018-01401, Ex. 1022; Case IPR2018-01402, Ex. 1020), along with a consent letter (Case IPR2018-01401, Ex. 1023; Case IPR2018-01402, Ex. 1021); and (3) a joint request to treat both the settlement agreement and the consent letter as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Case IPR2018-01401, Paper 10; Case IPR2018-01402, Paper 10).

These proceedings are still in their preliminary stages. Petitioner, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Austin Semiconductor, LLC, filed a Petition in each proceeding requesting the following: (1) an *inter partes* review of claims 1–16 of U.S. Patent No. 6,232,231 B1 (“the ’231 patent”) (Case IPR2018-01401, Paper 1); and (2) an *inter partes* review of claims 16–22 of U.S. Patent No. 6,849,946 B2 (“the ’946 patent”) (Case IPR2018-01402, Paper 1). Patent Owner, Invensas Corporation, filed a Preliminary Response in each proceeding (Case IPR2018-01401, Paper 8; Case IPR2018-01402, Paper 8), but we have not issued a decision on institution.

In the Joint Motions to Terminate Proceeding, the parties represent that they have settled all their disputes regarding the ’231 patent and the ’946 patent. Case IPR2018-01401, Paper 9, 1; Case IPR2018-01402, Paper 9, 1. The parties also represent that these two patents were the subject of two district court cases, captioned (1) *Invensas Corporation v. Samsung Electronics, Co., Ltd.*, No. 2:17-cv-00670-RWS-RSP (E.D. Tex.) and (2) *Invensas Corporation v. Samsung Electronics Co., Ltd.*, No. 17-1363-MN-SRF (D. Del.), both of which the parties

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stipulated to dismiss with prejudice. Case IPR2018-01401, Paper 9, 1–2; Case IPR2018-01402, Paper 9, 1–2. Under these particular circumstances, we determine that it is appropriate to dismiss both Petitions without rendering any further decisions, thereby terminating these proceedings. *See* 37 C.F.R. § 42.71(a).

## II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ requests to treat both the settlement agreement (Case IPR2018-01401, Ex. 1022; Case IPR2018-01402, Ex. 1020) and the consent letter (Case IPR2018-01401, Ex. 1023; Case IPR2018-01402, Ex. 1021) as business confidential information under 37 C.F.R. § 42.74(c) are *granted*; and

FURTHER ORDERED that the parties’ Joint Motions to Terminate Proceeding are *granted*, and both Petitions are dismissed resulting in termination of these proceedings.

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IPR2018-01402 (Patent 6,849,946 B2)

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