

Entered: December 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC. AND SAMSUNG AUSTIN SEMICONDUCTOR LLC,
Petitioner,

v.

INVENSAS CORPORATION,
Patent Owner.

Case IPR2018-01402
U.S. Patent No. 6,849,946

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board’s December 12, 2018 correspondence, Petitioner Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Austin Semiconductor LLC (“Petitioner”) and Patent Owner Invensas Corporation (“Patent Owner”) (collectively, “the Parties”) jointly request termination of the *inter partes* review of U.S. Patent No. 6,849,946 (“’946 patent”), Case No. IPR2018-01402.

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018).

This proceeding is still in its preliminary stages. A Petition for *inter partes* review was filed on July 13, 2018 (Paper No. 1), and the Board has not yet issued a decision on institution. The Parties have settled their dispute and respectfully submit that termination is proper here.

The ’946 patent was the subject of two district court actions: (1) a District Court action in the Eastern District of Texas, Civil Action No. 2:17-cv-00670-RWS-RSP, entitled *Invensas Corporation v. Samsung Electronics Co., Ltd. et al.*; and (2) a District Court Action in Delaware, Civil Action No. 17-1363-MN-SRF, entitled *Invensas Corporation v. Samsung Electronics Co., Ltd. et al.*, both of which the

parties stipulated to dismiss with prejudice. A dismissal of the Petition here would promote efficiency and minimize unnecessary costs.

Samsung and Patent Owner's parent Xperi Corporation executed a Confidential Settlement Agreement to terminate this proceeding effective December 7, 2018. This agreement was made binding on Patent Owner Invensas Corporation by Consent Letter of the same date. Both the Settlement Agreement and a Consent Letter are submitted concurrently herewith. In accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a Joint Request that the Confidential Settlement Agreement and Consent Letter be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). True and correct copies of the Settlement Agreement and Consent Letter are submitted with that Request as Confidential Exhibits 1020 and 1021.

Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Both Petitioner and Patent Owner support termination of the proceeding.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board dismiss this proceeding in its entirety.

Respectfully submitted,

Dated: December 13, 2018

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 13th day of December 2018, a copy of **Joint Motion to Terminate** was served by electronic mail on Patent Owner's lead and backup counsel at the following email addresses:

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