

Entered: December 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

INVENSAS BONDING TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2019-00020
U.S. Patent No. 9,391,143

**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. and Samsung Electronics America, Inc. ("Petitioner") and Patent Owner Invensas Bonding Technologies, Inc. ("Patent Owner") (collectively, "the Parties") jointly request termination of the *inter partes* review of U.S. Patent No. 9,391,143 ("143 patent"), Case No. IPR2019-00020.

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 October 2, 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 '143 patent was the subject of a District Court action in the District of New Jersey, Civil Action No. 17-7609-RMB-KMW, entitled *Invensas Bonding Techs. v. Samsung Electronics America, Inc.*, which the parties stipulated to dismiss with prejudice. The '143 patent is also the subject of a Petition for *inter partes* Review, IPR2019-00021, entitled *Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. v. Invensas Bonding Technologies, Inc.*, in which the

Parties are simultaneously filing a Joint Motion to Terminate Proceedings. 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 Bonding Technologies, Inc. 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 1015 and 1016.

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

/s/ Marc Pensabene

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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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December 13, 2018

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