UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SPEAKWARE, INC.,
Patent Owner.

Case No. IPR2019-01146
Patent 6,397,186

JOINT MOTION TO DISMISS AND TERMINATE PROCEEDINGS

INTRODUCTION

Pursuant to 37 C.F.R. § 42.74 and the authorization provided by the Board in an email dated August 1, 2019, Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. and Patent Owner SpeakWare, Inc. jointly request termination of this proceeding.

Petitioners and Patent Owner have settled their dispute regarding the '186 Patent, including both this proceeding and Patent Owner's assertion of the '186 Patent in the related district court litigation, *SpeakWare, Inc. v. Microsoft Corp., et al*., No. 8-18-cv-01293). A true and correct copy of the agreement between the parties will be filed as Exhibit 2001, along with a joint motion to treat the agreement as business confidential information.

Petitioner and Patent Owner certify that there are no collateral agreements or understandings between the parties made in connection with, or in contemplation of, the termination of this proceeding.

STATUS OF RELATED PROCEEDINGS

In addition to this proceeding, there are several IPR proceedings involving the '186 Patent. There was also a recently concluded district court proceeding involving the '186 Patent. The status of these proceedings is indicated here:

1. *SpeakWare, Inc. v. Microsoft Corporation, et al*., Case No. 8:18-cv-01293 (C.D. Cal): In this consolidated district court action, SpeakWare asserted

the ’186 patent against Apple Inc., Microsoft Corp., Samsung Electronics Co., LTD, Samsung Electronics America, Inc., Amazon.com, Inc., and Google LLC. SpeakWare has settled its claim against each of these Defendants. And each of SpeakWare’s claims has been dismissed with prejudice.

2. *Samsung Electronics Co., LTD, Samsung Electronics America, Inc. v. SpeakWare, Inc.*, IPR2019-01147: As stated above, SpeakWare has settled its dispute with the Samsung entities. A joint motion to terminate this proceeding is being filed on the same day as this joint motion to terminate.

3. *Apple, Inc. v. SpeakWare, Inc.*, IPR2019-00874 and IPR2019-00875: As stated above, SpeakWare has settled its dispute with Apple. Upon authorization from the Board, the parties will be filing joint motions to terminate these proceedings.

4. *Microsoft Corp. v. SpeakWare, Inc.*, IPR2019-00758 and IPR2019-00792: As stated above, SpeakWare has settled its dispute with Microsoft. Upon authorization from the Board, the parties will be filing joint motions to terminate these proceedings.

5. *Amazon.com, Inc.,v. SpeakWare, Inc.*, IPR2019-00999: As stated above, SpeakWare has settled its dispute with Amazon. Upon authorization from the Board, the parties will be filing a joint motion to terminate this proceeding.

6. *Google LLC v. SpeakWare, Inc.*, IPR2019-00340 and IPR2019-00342: As stated above, SpeakWare has settled its dispute with Google. Upon authorization from the Board, the parties will be filing joint motions to terminate these proceedings

7. *Unified Patents Inc. v. SpeakWare, Inc.*, IPR2019-00495: Unified Patents Inc. filed its petition on December 27, 2018. The Board entered a Decision instituting *Inter Partes* Review on July 1, 2019. Oral Argument is scheduled for April 1, 2020.

RELIEF REQUESTED

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety. Termination is appropriate at this stage in view of the settlement, which ends all disputes between the parties, including this proceeding.

Both Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) ("The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation."); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) ("The law favors settlement of cases."), *cert. denied*, 479 U.S. 950 (1986). The U.S. Court of Appeals for the Federal Circuit also places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v.*

U.S., 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Moreover, the Board generally expects that a proceeding "will terminate after the filing of a settlement agreement, unless the Board has already decided the merits." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012); *see* 37 C.F.R. § 42.72.

Maintaining this proceeding after Petitioner's settlement with Patent Owner would discourage future settlements by removing a primary motivation for settlement: eliminating litigation risk by resolving the parties' disputes and ending the pending proceedings between them. For patent owners, litigation risks include the potential for an invalidity ruling against their patents. If a patent owner knows that an *inter partes* review or covered business method review will likely continue regardless of settlement, it creates a strong disincentive for the patent owner to settle.

CONCLUSION

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

Respectfully submitted,

Date: August 8, 2019

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Registration No. 36,588
Counsel for Patent Owner

Date: August 8, 2019

By: /s/Jeffrey A. Miller
Jeffrey A. Miller
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Counsel for Petitioner

CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing **JOINT MOTION TO DISMISS AND TERMINATE PROCEEDINGS** is being filed via PTAB E2E and served by electronic mail this 8th day of August, 2019 on counsel for Petitioner as follows:

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