UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND

SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

DARELTECH, LLC

Patent Owner

Case: IPR2019-01575

Patent 9,075,612

JOINT MOTION TO TERMINATE PROCEEDINGS

EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 8,593,427 ("the '427 patent")
1002	U.S. Patent Application Publication No. 2014/0189583 ("*Yang*")
1003	Not Used
1004	Not Used
1005	Not Used
1006	PCT Application No. PCT/CN2012/087795
1007	Not Used
1008	Not Used
1009	Not Used
1010	Declaration of Andrew Wolfe, Ph.D.
1011	U.S. Patent No. 4,972,496 to Sklarew
1012	O'Malley, *BellSouth's communicative Simon is a milestone in the evolution of the PDA*, Byte
1013	Ha, *Bellsouth IBM Simon*, Time Magazine, Oct. 25, 2010
1014	Ha, *Palm Pilot 1000*, Time Magazine, Oct. 25, 2010
1015	Newton Apple MessagePad Handbook, © 1995
1016	Macworld, September 1993 (cover)
1017	U.S. Patent Pub. No. 2013/0316769 to Kim
1018	U.S. Patent No. 9,360,967 to Hotelling
1019	U.S. Patent No. 8,203,541 to Wolfe

Exhibit	Description
1020	U.S. Patent No. 8,243,045 to Mangione-Smith
1021	U.S. Patent No. 5,825,352 to Bisset
1022	U.S. Patent No. 7,844,915 to Platzer
1023	Linus Write-Top Computer, printout from http://oldcomputers.net/linus.html [last visited 7/11/2019 2:32:15 PM]
1024	U.S. Patent No. 8,593,328 to Yang et al. ("the '328 patent")
1025	Not Used
1026	U.S. Patent No. 9,075,612 to Yang et al. ("the '612 patent")
1027	Prosecution History of U.S. Patent Application No. 14/257,888
1028	International Publication No. WO 2013/172507 to *Park* ("*Park*")
1029	U.S. Patent Application Publication No. 2013/0111378 to Newman et al. ("*Newman*")
1030	U.S. Patent No. 8,842,074 to Ording et al. ("*Ording*")
1031	U.S. Patent No. *Siwinski*, U.S. Patent No. 7,012,588 ("*Siwinski*")
1032	Not Used
1033	U.S. Provisional Patent Application No. 61/822,267
1034	U.S. Provisional Patent Application No. 61/826,673
1035	Not Used
1036	U.S. Patent No. to 8,804,324 to Bohn et al (*Bohn*)
1037	Plaintiff/Counterclaim Defendant's Objections And Responses To Defendant/Counterclaim Plaintiffs' Requests For Admission (Nos. 1-6)

Exhibit	Description
1038	U.S. Patent Application Publication No. 2012/0297215 ("*Saba*")
2001	Confidential Agreement between Samsung Electronics Co., Ltd. and Dareltech, LLC (Parties and Board Only)

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioners Samsung Electronics Co., Ltd. ("Samsung") and Samsung Electronics America, Inc. and Patent Owner Dareltech, LLC ("Dareltech") jointly request that this *inter partes* review proceeding involving U.S. Patent No. 9,075,612 ("the '612 patent") be terminated based on an agreement between Samsung and Dareltech ("the Parties").

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of an agreement between the Parties made in connection with, or in contemplation of, the termination of the proceeding, unless the Board has already decided the merits of the proceeding. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing of the instant motion on June 22, 2020. Guidance as to the content of a motion to terminate is provided in IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id*. at 2. This motion satisfies each of the above requirements.

a. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because no patent owner response or further papers have been filed, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. Under 35 U.S.C. § 317(a), this proceeding "shall be terminated with respect to [] [P]etitioner" because the parties are jointly requesting termination and the Office has not yet "decided the merits of the proceeding before the request for termination is filed." The Parties have resolved their disputes and executed an agreement which contemplates requesting termination of this proceeding and dismissing the Parties' related proceeding regarding the '612 patent in *Dareltech, LLC v. Samsung Elecs. Co., Ltd. et al.*, Case No. 4:18-cv-00702 (E.D. Tex.).

b. All Parties in Any Pending Related Litigation Involving the Patent at Issue

The following litigation, which is pending dismissal, is related to the '612 patent:

> *Dareltech, LLC v. Samsung Elecs. Co., Ltd. et al.*, Case No. 4:18-cv-00702 (E.D. Tex.) (notice of settlement filed).

A joint stipulation of dismissal was submitted in that action on September 4, 2020. Dkt. 73. There are no other pending district court actions in which the '612 patent is asserted.

c. Related Proceedings Currently Before the Office

Two related proceedings, of members in the same family as the ’612 patent, are currently pending before the Patent Office: IPR2019-01528 and IPR2019-01529.

d. Current Status of Each Such Related Litigation of Proceeding With Respect to Each Party in the Litigation or Proceeding

Sections II.b and II.c above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding.

III. AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties’ agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and correct copy is being filed concurrently herewith as Exhibit 1015.[1] There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. The parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat this agreement as business confidential information and keep it separate from the files of the ’612 patent.

IV. CONCLUSION

For all these reasons, the Parties respectfully request termination of this

[1] The agreement is being filed via the Patent Trial and Appeal Board End to End (PTAB E2E) system with access to the “Parties and Board only.”

proceeding.

Dated: September 21, 2020

/s/ Jeffrey A. Miller
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