

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.,  
Petitioner

v.

TELEFONAKTIEBOLAGET LM ERICSSON,  
Patent Owner

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Case No. IPR2021-00486

Patent No. 10,476,722

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**UNOPPOSED MOTION TO DISMISS  
PETITION FOR *INTER PARTES* REVIEW**

On May 14, 2021 the Board authorized Petitioner, Samsung Electronics Co., Ltd. to file unopposed motions to dismiss in each of IPR2021-00459, IPR2021-00460, IPR2021-00486, IPR2021-00487, IPR2021-00508, IPR2021-00509, IPR2021-00536, IPR2021-00537, IPR2021-00539, IPR2021-00567, IPR2021-00568, IPR2021-00569, IPR2021-00729, IPR2021-00730, IPR2021-00731, and IPR2021-00732.

More specifically, in response to Petitioner's request for authorization to file an unopposed motion to dismiss in each of the above-captioned proceedings, the Board stated that "Petitioner is authorized to file either a motion to dismiss or, if the parties seek termination pursuant to a settlement, a joint motion to terminate," adding that "[i]f Petitioner files a motion to dismiss a proceeding, Petitioner shall identify any 'appropriate circumstances' giving rise to the motion" and "specify ... whether Patent Owner opposes it." Consistent with the Board's instruction, this motion to dismiss offers an explanation of the appropriate circumstances giving rise to this motion, while also confirming that Patent Owner does not oppose this motion.

Moreover, as explained in more detail below, dismissal of the instant *inter partes* review Petition under 37 C.F.R. 42.71 is the appropriate mechanism for addressing the Petition under the circumstances giving rise to this motion, as the

Petition is presently pending and awaiting a decision on institution,<sup>1</sup> and dismissal would preserve the Board's and parties' resources and promote a speedy and inexpensive resolution to the dispute, without prejudicing Patent Owner. *See Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257 Pap. 16, 3 (PTAB Jan. 2, 2020) (granting petitioner's unopposed motion to dismiss "to promote efficiency and minimize unnecessary costs"); 37 C.F.R. 42.71 (The Board may "grant, deny, or dismiss" a petition or motion).

Accordingly, Petitioner hereby moves unopposed for dismissal of the pending Petition.

**A. PTAB rules provide for dismissal of a pending petition for *inter partes* review without reaching the merits**

To request *inter partes* review of a patent, "a person who is not the owner of a patent may file with the Office *a petition to institute an inter partes review* of the patent."<sup>2</sup> 35 U.S.C. § 311. Thereafter, if reaching the merits, the Board either

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<sup>1</sup> In Sections C. and D., *infra*, Petitioner addresses the Board's alternative authorization to file a motion to terminate "if the parties seek termination pursuant to a settlement," and the Board's corresponding instruction to file a true copy of the settlement agreement with any such motion.

<sup>2</sup> Unless indicated, emphases in quotes throughout this motion are added.

grants the petition, which yields institution of an *inter partes* review, or denies the petition, which results in non-institution of an *inter partes* review. In rendering its decision on institution, the Board evaluates “whether the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a).

Notably, prior to such a decision on institution, no *inter partes* review has commenced. *See, e.g.*, 35 U.S.C. §§ 311-313. Statutes addressing pre-institution procedures therefore consistently refer to “the petition” rather than an “*inter partes* review” proceeding. *Id.*; *see also Intellectual Ventures II LLC v. JPMorgan Chase and Co.*, 781 F.3d 1372, 1376 (“The AIA differentiates between a petition for a CBMR proceeding (which a party files) and the act of instituting such a proceeding (which the Director is authorized to do”). This stands to reason, as its name – institution decision – confirms that *inter partes* review does not commence until a decision to institute has been rendered. *See also institution*, Black's Law Dictionary (8th ed. 2004) (“The commencement of something, such as a civil or criminal action”).

With respect to a petition, therefore, the PTAB rules aptly and affirmatively proscribe that the Board may reach the merits of the decision through grant or denial, in the manner noted above. And importantly, the PTAB rules recognize

one more option—dismissal. 37 C.F.R. 42.71 (“the Board ... may grant, deny, or ***dismiss*** any petition or motion”); *see also, e.g.*, 37 CFR 42.12(b)(8) (describing sanctions including “***dismissal of the petition***”); 37 CFR 42.106(b) (in the case of an incomplete petition, “the Office will ***dismiss the petition*** if the deficiency in the petition is not corrected within one month from the notice of an incomplete petition”).

In contrast, no rule or statute authorizes the Board to “dismiss” a trial on an instituted *inter partes* review. Instead, “the Board may ***terminate a trial***” or an “instituted” *inter partes* review. 37 C.F.R. 42.72; 35 U.S.C. § 317(a); *see also, e.g.*, 37 C.F.R. 42.2 (a “trial” is “a contested case instituted by the Board based upon a petition”). And as noted in section C., *infra*, no rule or statute authorizes the Board to “terminate” a petition. Thus, read together, authority is offered for dismissal (of a petition) pending decision on the petition’s institution merits (*i.e.*, without granting or denying it), and for termination (of trial) following a decision on the petition’s institution merits. *See* 37 C.F.R. 42.71; 37 C.F.R. 42.72; 35 U.S.C. § 317(a).

In the present case, a Petition requesting *inter partes* review awaits a Board decision on institution. The Board has yet to decide whether to grant the Petition—and thus institute trial—or deny the Petition. Under the rules, the proper mechanism for dispatching this pending Petition prior to an institution decision by

the Board is dismissal. *See* 37 C.F.R. 42.71; 37 C.F.R. 42.72; 35 U.S.C. § 317(a); *Apple Inc. v. Ericsson Inc. et al.*, IPR2015-01904 Pap. 7, 2 (PTAB Jan. 29, 2016) (granting petitioner’s unopposed motion to dismiss twelve petitions where “Patent Owner has not filed a preliminary response, and we have not considered the merits of the Petitions”).

**B. Good cause justifies dismissal of the present Petition**

Consistent with 37. C.F.R. § 42.71(a), the Board has recognized that dismissal of pre-institution petitions is available to petitioners upon a showing of good cause, and the Board has recognized through its decisions various instances of good cause sufficient to justify dismissal. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257 Pap. 16, 3 (PTAB Jan. 2, 2020); *Apple Inc. v. Ericsson Inc. et al.*, IPR2015-01904 Pap. 7, 2 (PTAB Jan. 29, 2016); *Staylinked Corp. v. Ivanti, Inc.*, IPR2021-00022 Pap. 10 (PTAB Feb. 4, 2021) (granting petitioner's unopposed motion and noting the petitioner's ability to refile at a later date due to lack of co-pending litigation); *World Programming LTD. v. SAS Institute, Inc.*, IPR2019-01457 Pap. 19, 2-3 (PTAB Dec. 27, 2019) (granting “unopposed motion to dismiss the Petition and terminate the proceeding more than two months before the statutory deadline for institution”); *Huawei Techs. Co. LTD. v. Harris Global Communications, Inc.*, IPR2019-01512 Pap. 8, 1-2 (PTAB Dec. 27, 2019) (granting petitioner’s unopposed motion to dismiss where “[b]oth

Petitioner and Patent Owner contend there is good cause to terminate the proceedings because it will preserve the resources of the Board and the parties”); *Samsung Electronics Co. et al. v. Nvidia Corp.*, IPR2015-01270 Pap. 11, 3-4 (PTAB Dec. 9, 2015) (granting petitioner’s motion to dismiss, even despite opposition by patent owner, “to promote efficiency and minimize unnecessary costs”); *Apple Inc. v. Pinn, Inc.*, IPR2021-00220 Pap. 10 (PTAB Mar. 19, 2021). In the instant case, good cause exists, consistent with Board precedent.

The parties have settled their dispute, a preliminary response to the Petition has not been filed, and a decision on institution of IPR2021-00446 has not yet been rendered. As such, granting Petitioner’s unopposed motion to dismiss the instant Petition at this early juncture would serve to preserve the Board’s and parties’ resources and promote a speedy and inexpensive resolution. *See Samsung v. Nvidia*, IPR2015-01270 Pap. 11, 3. Indeed, dismissing the Petition now, before any decision on the merits, will promote the Board’s objective of achieving “just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b) (2018); *World Programming LTD. v. SAS Institute, Inc.*, IPR2019-01457 Pap. 19, 2; *see also Staylinked Corp. v. Ivanti, Inc.*, IPR2021-00022 Pap. 10 (PTAB Feb. 4, 2021) (granting petitioner’s unopposed motion and noting the petitioner’s ability to refile at a later date due to lack of co-pending litigation).

**C. No statute or rule provides a basis for “terminating” a petition for *inter partes* review that has not yet been instituted**

As noted above, the Board’s response to Petitioner’s request to file an unopposed motion to dismiss alternatively authorized filing a joint motion to terminate. In particular, the Board stated that “Petitioner is authorized to file either a motion to dismiss or, if the parties seek termination pursuant to a settlement, a joint motion to terminate.” The next sentence, quoting from 37 C.F.R. § 42.74, adds that “[i]n any such motion, counsel must specifically confirm that ‘[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of [the instant] proceeding [is] in writing and a true copy [has been or is being] filed with the Board’ with the motion.”

Notably, the language of 37 C.F.R. § 42.74 refers to “termination of a proceeding” and “termination of the trial,” as opposed to dismissal of a petition: “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the ***termination of a proceeding*** shall be in writing and a true copy shall be filed with the Board before the ***termination of the trial***.”

Accordingly, Petitioner understands the Board’s instruction to file a true copy of the settlement agreement with “any such motion” to refer to the authorized “joint motion to terminate,” as opposed to the authorized, presently-filed motion to dismiss.



Petitioner’s understanding is consistent with the absence of any reference to dismissal within the entirety of 37 C.F.R. § 42.74. *See* 37 C.F.R. § 42.74. And this understanding comports with termination being made available through 35 U.S.C. § 317(a) for only the limited class of *inter partes* reviews “***instituted*** under this chapter.” 35 U.S.C. § 317(a). Indeed, there exists neither statutory nor rule-based authority for termination prior to institution of a petition. *See also* 37 C.F.R. § 42.74.

The statutory procedure for termination of an *inter partes* review is defined by 35 U.S.C. § 317(a), which states, in relevant part:

An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.

The plain language of 317(a) makes clear that the statutory option for “termination” is available to address only the limited class of “***instituted***” *inter partes* review proceedings, and does not describe an analogous mechanism for dispatching a petition for *inter partes* review that awaits decision on institution. *See id.* The present case involves such a Petition, and thus termination under 317(a) is not applicable.

Similar to 35 U.S.C. § 317(a), the PTAB rules specify that the Board “may ***terminate a trial*** without rendering a final written decision” (37 C.F.R. 42.72), and define a “trial” as “a contested case ***instituted by the Board*** based upon a petition” (37 C.F.R. 42.2). The plain language of 37 C.F.R. 42.72 is thus unambiguous in providing authority for “termination” of only “trials” (*i.e.*, instituted *inter partes* review proceedings), without providing authority via an analogous mechanism for dispatching a petition for *inter partes* review that awaits decision on institution. *See id.* The present case involves such a Petition, and thus termination is not available, even if otherwise proscribed by 37 C.F.R. 42.72.

Similarly, no basis exists in PTAB precedent for termination of non-instituted *inter partes* review proceedings, as no cases on this subject have been designated “precedential” (or even “informative”) by the Office.

Accordingly, the parties have not jointly sought to terminate; rather, consistent with the Board’s authorization, Petitioner hereby submits this unopposed motion to dismiss.

**D. Even if there were a basis for terminating a petition that has not yet been instituted, the parties would not be obligated to file a copy of a settlement agreement related to such termination**

To the extent the Board finds that a basis exists in the PTAB rules for termination of a non-instituted proceeding, such termination would still not obligate the parties to file a “true and correct copy” of a settlement agreement

related to the termination under 42.74(b), because the 42.74(b) states that this obligation must be fulfilled “*before the termination of the trial.*” 37 C.F.R.

42.74(b). As no “trial” exists for a non-instituted proceeding, such termination will never occur, so the parties are not obligated to file a copy of the settlement agreement. *See id.*; 37 C.F.R. 42.2 (defining a “trial” as “a contested case instituted by the Board based upon a petition” that “begins with a written decision notifying the petitioner and patent owner of the institution of the trial”).

#### **E. Conclusion**

For the foregoing reasons, Petitioner respectfully requests dismissal of the instant Petition.

Date: May 19, 2021

Respectfully submitted,

/s/ Todd M. Friedman

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## **CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing document was served on May 19, 2021, through the Patent Review Processing System, as well as by e-mailing copies to:

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