

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., and QUALCOMM INCORPORATED,
Petitioner,

v.

DAEDALUS PRIME LLC,
Patent Owner.

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)¹

Before WILLIAM V. SAINDON, THOMAS L. GIANNETTI,
ARTHUR M. PESLAK, and KRISTI L. R. SAWERT, *Administrative Patent
Judges*.²

PER CURIAM.

DECISION

Settlement as to Samsung Prior to Institution of Trial
37 C.F.R. § 42.74

¹ The parties are not authorized to use this style caption.

² This is not an expanded panel. The panel for IPR2023-00547 and IPR2023-00550 includes Judges Saindon, Peslak, and Sawert. The panel for IPR2023-00567 and IPR2023-00617 includes Judges Saindon, Giannetti, and Sawert.

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)

I. INTRODUCTION

With the Board’s authorization, Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively “Samsung”) and Patent Owner Daedalus Prime LLC (“Daedalus”) filed a Joint Motion to Terminate as to Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. in each of the above-identified proceedings. Paper 10 (“Joint Motion”).³ In support of each Joint Motion, Samsung and Daedalus filed a copy of a Settlement Agreement (Ex. 1031) and a Joint Request to Treat the Settlement Agreement as Business Confidential Information pursuant to 37 C.F.R. § 42.74. Paper 9 (“Joint Request”).

II. DISCUSSION

In the Joint Motions, Samsung and Daedalus represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings with respect to Samsung, and that the filed copy of the Settlement Agreement is a true and complete copy. Paper 10; 37 C.F.R. § 42.74(b) (requiring a “true copy” of any agreement to be filed with the Board). Samsung and Daedalus state that “there are no other agreements, oral or written, between Daedalus and Samsung made in connection with, or in contemplation of, the termination of the proceeding[s].” Paper 10; 37 C.F.R. § 42.74(b) (requiring “Any agreement

³ This Decision cites to papers and exhibits in IPR2023-00547. Corresponding items were filed in IPR2023-00550, IPR2023-00567, and IPR2023-00617.

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)

or understanding between the parties” to be filed with the Board (emphasis added)). The Settlement Agreement indicates that it resolves all currently pending proceedings between Samsung and Daedalus involving the above-identified patents at issue. Ex. 1031, 1–2.

These proceedings are at an early stage, and we have not yet decided whether to institute trial in any of the proceedings. In view of the early stage of the proceedings and the settlement between Samsung and Daedalus, which resolves all proceedings involving the Parties and the above-identified patents, we determine that good cause exists to terminate the proceedings as to Samsung. Qualcomm Incorporated remains as Petitioner in the proceedings.

Samsung and Daedalus also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the patents involved in these *inter partes* review proceedings. Paper 9. After reviewing the Settlement Agreement between Samsung and Daedalus, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Samsung and Daedalus as business confidential information pursuant to 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate as to Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. in each of the above-identified proceedings is *granted*, and the proceedings are *terminated* only as to Samsung;

FURTHER ORDERED that Qualcomm Incorporated will remain as Petitioner in each of the above-identified proceedings, and the proceedings will continue;

FURTHER ORDERED that the Joint Request to Treat the Settlement Agreement as Business Confidential Information in each of the above-identified proceedings is *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patents 10,705,588 B2; 8,775,833 B2; 10,049,080 B2; and 8,898,494 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the caption for each of the above-identified proceedings is modified as set forth in the attached Exhibit. The remaining parties are directed to use this caption in all further filings.

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)

FOR PETITIONER:

William M. Fink
Benjamin Haber
Nicholas J. Whilt
Brian Cook
O'MELVENY & MYERS LLP
tfink@omm.com
bhaber@omm.com
nwhilt@omm.com
bcook@omm.com

Daniel Leventhal
Richard Zembek
Darren Smith
Eagle H. Robinson
NORTON ROSE FULBRIGHT
daniel.leventhal@nortonrosefulbright.com
richard.zembek@nortonrosefulbright.com
darren.smith@nortonrosefulbright.com
eagle.robinson@nortonrosefulbright.com

FOR PATENT OWNER:

Peter F. Snell
Adam Rizk
Michael T. Renaud
Serge Subach
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.
pfsnell@mintz.com
arizk@mintz.com
mtrenaud@mintz.com
ssubach@mintz.com

IPR2023-00547 (Patent 10,705,588 B2)
IPR2023-00550 (Patent 8,775,833 B2)
IPR2023-00567 (Patent 10,049,080 B2)
IPR2023-00617 (Patent 8,898,494 B2)

EXHIBIT: Sample Case Caption

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED,
Petitioner,

v.

DAEDALUS PRIME LLC,
Patent Owner.

Case IPR2023-00XXX
Patent XX,XXX,XXX B2
