Trials@uspto.gov
571-272-7822

Paper 12
Entered: February 3, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

ULTRAVISION TECHNOLOGIES, LLC,
Patent Owner.

IPR2020-01312
Patent 8,870,410 B2

Before HUBERT C. LORIN and SCOTT A. DANIELS,
Administrative Patent Judges.

DANIELS, *Administrative Patent Judge*.

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

On December 15, 2020, the parties filed the following documents: (1) a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 (Paper 8, "Joint Motion to Terminate"), (2) a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 9, "Joint Request to Keep Separate), and (3) a true copy of the parties' settlement agreement (Ex. 1045). On January 14, 2021 we denied the parties' Joint Motion to Terminate because it did not certify that there are no collateral agreements or understandings between the parties apart from the parties' settlement agreement. Paper 10. The parties filed a Revised Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317 (Paper 11, "Revised Joint Motion to Terminate") the same day.

For the following reasons, we grant the parties' Revised Joint Motion to Terminate. The proceeding is still in its preliminary stage. Petitioner, Samsung Electronics Co., Ltd., filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–5, 7, 15, 16, 19, 20, 27, and 28 (the "challenged claims") of U.S. Patent No. 8,870,410 (Ex. 1001, "the '410 patent"). Pet. 1. We have not entered a decision whether to institute an *inter partes* review. The Revised Joint Motion to Terminate requests terminating this *inter partes* proceeding. Paper 10, 1.

The parties represent that they have settled their dispute in *Ultravision Technologies, LLC v. Samsung Electronics Co., Ltd and Samsung Display Co., Ltd*., Case No. 2:19-cv-00252, 00053 (E.D. Tex.), as to all claims of the '410 patent, and that they agreed to terminate this *inter partes* review. Paper 11, 3. The Revised Joint Motion to Terminate refers to the parties' Joint Request to Keep Separate which requests treating the settlement agreement as business confidential, keeping the agreement separate from the underlying patent files, and making the agreement available only as provided "pursuant

to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)." Paper 11, 1; *see also* Paper 9, 1. The parties state they have filed a true copy of the confidential settlement agreement as required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Paper 11, 3. The parties also certify that "[t]here are no collateral agreements." *Id*. Based on the foregoing, we understand the filed agreement settles all disputes between the parties with respect to this proceeding. Under these circumstances, we determine that good cause exists to grant the Revised Joint Motion to Terminate.

It is

ORDERED that the Joint Motion to Terminate is *granted*; and

FURTHER ORDERED that that the settlement agreement included in Exhibit 1045 shall be treated as business confidential information and be kept separate from the patent file; and

FURTHER ORDERED that this proceeding is *terminated*.

FOR PETITIONER:

Naveen Modi
Joseph E. Palys
Paul M. Anderson
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
paulanderson@paulhastings.com

FOR PATENT OWNER:

Peter Lambrianakos
Vincent J. Rubino
Joseph M. Mercadante
Enrique W. Iturralde
FABRICANT LLP
plambrianakos@fabricantllp.com
vrubino@fabricantllp.com
jmercadante@fabricantllp.com
eiturralde@fabricantllp.com