

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CLEAR IMAGING RESEARCH, LLC,
Patent Owner.

IPR2020-01395 and IPR2020-01396¹
Patent 9,154,699 B2

Before JONI Y. CHANG, KRISTEN L. DROESCH, and
JASON M. REPKO, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

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

¹ This order is being filed in each proceeding in the caption. The parties, however, are not authorized to use this style of filing in subsequent papers, without prior authorization.

In each above-identified proceeding, Petitioner and Patent Owner jointly move to terminate *inter parte* review (“IPR”) proceeding in light of their settlement that resolves their dispute regarding the patent at issue. Paper 9 (“Mot.”).² The parties also filed a true copy of their written settlement agreement made in connection with, or in contemplation of, the termination under 37 C.F.R. § 42.74(b), in each above-identified proceeding. Ex. 1026. In each Motion, the parties indicate that “Patent Owner has dismissed the ’699 patent [(U.S. Patent No. 9,154,699 B2)] from the district court proceeding and Petitioner has agreed to terminate this petition.” Mot. 1. The parties contend that “[t]ermination is proper because the Parties are jointly requesting termination, the review is still in its early stages, and the Office has not yet ‘decided the merits of the proceeding before the request for termination is filed.’” *Id.* We agree.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See Consolidated Trial Practice Guide*³ at 86; *see also* 84 Fed. Reg. 64,280 (Nov. 21, 2019). Here, the parties indicate that they “filed a joint stipulation to dismiss their respective claims and counterclaims with prejudice” in the related parallel District Court litigation, and “the Court ordered dismissal with prejudice on January 5, 2021.” Mot. 2–3; Ex. 1027. Therefore, if these IPR proceedings are

² For purposes of expediency, we refer to the papers and exhibits filed in IPR2020-01395. Similar papers and exhibits were filed in IPR2020-01396.

³ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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terminated, there are no other pending proceedings between the Petitioner and Patent Owner relating to the '699 patent. Mot. 3.

Moreover, each of these IPR proceedings is in an early stage. We have not yet determined whether a trial should be instituted in these proceedings.

Upon review of the procedural posture of these IPR proceedings and the facts before us, we determine that the parties' requests have merit and that it is appropriate to terminate these IPR proceedings. *See* 37 C.F.R. §§ 42.2, 42.72.

ORDER

In consideration of the foregoing, it is hereby

ORDERED that the Joint Motions to Terminate filed in these IPR proceedings are *granted*.

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