

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.; and
SAMSUNG AUSTIN SEMICONDUCTOR, LLC,

Petitioners,

v.

IMBERATEK LLC

Patent Owner.

Case No. IPR2023-00323

U.S. Patent No. 7,989,944

**JOINT MOTION TO DISMISS INTER PARTES REVIEW BEFORE
INSTITUTION**

Patent Owner ImberaTek LLC (“Patent Owner”) and Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Austin Semiconductor, LLC (collectively, “Samsung”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request dismissal of the *inter partes* review of U.S. Patent No. 7,989,944 (“Patent-in-Suit”), Case IPR2023-00323. The parties were authorized to file this Joint Motion by the Board (via email) on January 13, 2023.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a copy of the settlement agreement that resolves the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit as between ImberaTek and Samsung is filed herewith as an exhibit. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the dismissal sought.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), ImberaTek and Samsung are concurrently filing a Joint Request to Keep Separate, which asks the Board to treat the settlement agreement as business confidential information, and to keep it separate from the files of this proceeding and the files of the Patent-in-Suit.

I. STATEMENT OF PRECISE RELIEF REQUESTED

The parties jointly request that the Board dismiss the *inter partes* review of the Patent-in-Suit, Case IPR2023-00323.

II. DISMISSAL IS APPROPRIATE

Pursuant to 37 C.F.R. § 42.74, and the Board’s e-mail, Samsung requests that its petition be dismissed. *See Unified Patents, LLC v. Motion Offense, LLC*, IPR2020-00705, Paper 14 at 7 (PTAB Sept. 23, 2020); *id.* at 2 (“We agree with Petitioner that dismissal is appropriate under the present circumstances. Our ‘regulations expressly provide the Board with broad authority to dismiss a petition where appropriate.’”). This *inter partes* review is still in its early stages. The Petition was filed on December 9, 2022, and the Board has not yet instituted, much less decided the merits of the proceeding. Accordingly, the Board should dismiss this proceeding. *See Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 at 4 (PTAB Dec. 9, 2015) (granting opposed motion to dismiss before institution because the proceeding was at an “early juncture” and “to promote efficiency and minimize unnecessary costs”).

The parties requested dismissal of the lawsuit between ImberaTek and Samsung, and ImberaTek and Samsung do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future.

III. CONCLUSION

ImberaTek and Samsung have settled all disputes relating to the Patent-in-Suit. This *inter partes* review is in an early stage, and the Board has not instituted and not entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request that the Board dismiss this

proceeding.

Dated: January 13, 2023

Respectfully submitted,

/s/ John Kappos

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on January 13, 2023, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via electronic mail to the attorneys of record for the Patent Owner:

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