

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners,

v.

APEX BEAM TECHNOLOGIES LLC,

Patent Owner.

Patent No. 10,951,271
Filing Date: June 27, 2019
Issue Date: March 16, 2021

Inventor: Xiaobo Zhang
Title: METHOD AND DEVICE FOR MULTI-ANTENNA
TRANSMISSION IN UE AND BASE STATION

JOINT MOTION TO TERMINATE PROCEEDING

Case No. IPR2023-00571

LIST OF EXHIBITS

Exhibit No.	Description
2001	Defendants' Patent L.R. 3-3 Invalidity Contentions and Subject Matter Ineligibility Contentions, <i>Apex Beam Technologies LLC v. Samsung Electronics Co., Ltd. et al.</i> , Case No. 2:22-cv-00188-JRG, served March 2, 2023
2002	Order Denying Motion to Stay Pending <i>Inter Partes</i> Review, Dkt. 55, <i>Apex Beam Technologies LLC v. Samsung Electronics Co., Ltd., et al.</i> , Case No. 2:22-cv-00188-JRG (E.D. Tex. June 14, 2023)
2003	Redline Comparison of the Declaration of Apostolos Kakaes, Ph.D. (Ex. 1003) to the Petition
2004	Declaration of Miguel Gomez ("Gomez Decl."), dated February 6, 2024 and Exhibit A, Curriculum Vitae of Miguel Gomez
2005	Deposition of Apostolos Kakaes, taken in <i>Samsung Elecs. Co., Ltd. and Samsung Elecs. America, Inc. v. Apex Beam Techs. LLC</i> , IPR2023-00571 and IPR2023-00747, on January 18, 2024 ("Kakaes Depo.")
2006	Excerpts from Steven M. Kaplan, Wiley Electrical and Electronics Engineering Dictionary (2004)
2007	Patent Owner's Demonstratives
2008	Confidential Settlement Agreement

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board’s email of August 29, 2024, Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, “Petitioner” or “Samsung”) and Patent Owner Apex Beam Technologies LLC (“Apex Beam” or “Patent Owner”) (collectively, the “Parties”) have reached a resolution and jointly move to terminate the above-captioned proceeding.

I. STATEMENT OF FACTS

The Parties have reached an agreement to resolve their disputes in the above-captioned *inter partes* review relating to U.S. Patent No. 10,951,271.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit a true copy of the confidential settlement agreement in its entirety, filed herewith as Exhibit 2008. A “Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate, to treat Exhibit 2008 as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties certify that there are no other collateral agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination sought.

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Parties jointly request, for the following reasons.

First, Samsung and Apex Beam have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, Samsung and Apex Beam have reached a resolution as to all the disputes in this proceeding and as to the ’271 patent. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the agreement made in connection with, or in contemplation of, the termination of the proceeding is in writing, and a true and

correct copy is being filed concurrently herewith as Exhibit 2008.¹ The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat this agreement as business confidential information and keep it separate from the files of the '271 patent. The Parties certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further resolutions, as patent owners in similar situations would have a strong disincentive to resolve the dispute if they perceived that an *inter partes* review would continue regardless of a resolution.

III. CONCLUSION

For the foregoing reasons, Samsung and Apex Beam respectfully request termination of this *inter partes* review.

¹ The agreement is being filed via the Patent Trial and Appeal Board Case Tracking System (PTACTS) system with access to the “Parties and Board Only.”

Dated: September 11, 2024

Respectfully submitted,

/s/ Vincent J. Rubino, III
Vincent J. Rubino, III (Reg. No. 68,594)
FABRICANT LLP
411 Theodore Fremd Avenue
Suite 206 South
Rye, New York 10580
Attorney for Patent Owner

/Joshua L. Goldberg/
Joshua L. Goldberg (Reg. No. 59,369)
FINNEGAN, HENDERSON,
FARABOW, GARRETT & DUNNER,
LLP
901 New York Avenue, NW
Washington, DC 20001
Counsel for Petitioner

CERTIFICATE OF SERVICE

A copy of the JOINT MOTION TO TERMINATE PROCEEDINGS and
Exhibit 2008 has been served on Petitioner's counsel of record as follows:

Joshua L. Goldberg
Email: joshua.goldberg@finnegan.com
Nicholas A. Cerulli
Email: nicholas.cerulli@finnegan.com
Mingji Jin
Email: mingji.jin@finnegan.com
Chen Zang
Email: chen.zang@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP**
901 New York Avenue, NW
Washington, DC 20001

Kevin D. Rodkey
Email: kevin.rodkey@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP**
271 17th Street NW, Suite 1400
Atlanta, GA 30363

Yi Yu
Email: yi.yu@finnegan.com
**FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP**
1875 Explorer Street
Reston, VA 20190-6023

*Attorneys for Samsung Electronics Co., Ltd.
and Samsung Electronics America, Inc.*

September 11, 2024

By: /Vincent J. Rubino, III /
Vincent J. Rubino, III (Reg. No. 68,594)
Lead Counsel for Patent Owner
FABRICANT LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796