

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HEADWATER RESEARCH LLC,
Patent Owner.

Case IPR2023-01360
Patent 9,609,544

JOINT MOTION TO TERMINATE

UPDATED EXHIBIT LIST

SAMSUNG-1001 U.S. Patent No. 9,609,544 to Raleigh, et al. (“the ’544 Patent”)

SAMSUNG-1002 Excerpts from the Prosecution History of the ’544 Patent (“the Prosecution History”)

SAMSUNG-1003 Declaration and Curriculum Vitae of Dr. Kevin Butler

SAMSUNG-1004 Complaint, Headwater Research LLC v. Samsung Electronics Co., Ltd. et al., 2:22-cv-00422, E.D. Tex., October 26, 2022

SAMSUNG-1005 U.S. Pat. App. Pub. No. 2006/0039354 (“Rao”)

SAMSUNG-1006 U.S. Pat. App. Pub. No. 2009/0217065 (“Araujo”)

SAMSUNG-1007 U.S. Pat. No. 5,987,611 (“Freund”)

SAMSUNG-1008 U.S. Pat. No. 8,381,127 (“Singh”)

SAMSUNG-1009 U.S. Pat. App. Pub. No. 2009/0207817 (“Montemurro”)

SAMSUNG-1010 U.S. Pat. App. Pub. No. 2006/0039364 (“Wright”)

SAMSUNG-1011 Bajaj, et al., IETF RFC 3198, Web Services Policy 1.2 - Framework (WS-Policy), April 25, 2006, download-ed from the internet at <https://www.w3.org/Submission/WS-Policy/> on August 29, 2023.

SAMSUNG-1012 Sloman, et. al., "Security and management policy specification." IEEE Network, March/April 2002 pp. 10-19

SAMSUNG-1013 Lu, et. al., "Comparing system level power management policies." IEEE Design & Test of Computers, March/April 2001 pp. 10-19

SAMSUNG-1014 Davie, et al., IETF RFC 3246, An Expedited Forward-ing PHB (Per-Hop Behavior), March 2002, download-ed from the internet at <https://datatracker.ietf.org/doc/html/rfc3246> on Sep-tember 5, 2023

SAMSUNG-1015 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)

SAMSUNG-1016 Samsung Stipulation letter regarding IPR grounds in District court litigation

SAMSUNG-1017 First Amended Complaint, Headwater Research LLC v. Samsung Electronics Co., Ltd. et al., 2:22-cv-00422, E.D. Tex., November 30, 2022

SAMSUNG-1018 First Amended Docket Control Order, Headwater Research LLC v. Samsung Electronics Co., Ltd. et al., 2:22-cv-00422, E.D. Tex., April 21, 2023

SAMSUNG-1019 Excerpts, The New Penguin Dictionary of Computing, by Dick Pountain, 2001

SAMSUNG-1020 Westerinen, et al., IETF RFC 3198, Terminology for Policy-Based Management, November 2001, down-loaded from the internet at <https://www.ietf.org/rfc/rfc3198.txt> on August 15, 2023.

SAMSUNG-1021 U.S. Pat. No. 7,757,185 (“Paquette”)

SAMSUNG-1022 U.S. Pat. No. 7,023,909 (“Adams”)

SAMSUNG-1023 U.S. Pat. No. 9,408,070 (“Altbaum”)

SAMSUNG-1024 Yavatkar, IETF RFC 2753, A Framework for Policy-based Admission Control, January 2000, downloaded from the internet at <https://datatracker.ietf.org/doc/html/rfc2753> on September 5, 2023

SAMSUNG-1025 U.S. Pat. App. Pub. No. 2008/0080458 (“Cole”)

SAMSUNG-1026 U.S. Pat. No. 8,413,172 (“Sng”)

SAMSUNG-1027 CONFIDENTIAL Settlement Agreement

The Parties in this case have reached a settlement that addresses this proceeding. The Parties therefore contacted the Board on September 13, 2024, to inform the Board of the settlement and request instructions regarding termination of this proceeding. In accordance with the Board's email instructions received on September 16, 2024, the Parties hereby jointly submit this motion to terminate. The Parties respectfully request that the Board terminate IPR2023-01360.

Pursuant to 35 U.S.C. § 317(b), 37 C.F.R. § 42.74, and the Board's e-mail, the Parties have concurrently filed the Settlement Agreement as Exhibit 1027. The Parties state that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding. The Parties have concurrently filed a joint request to treat the Settlement Agreement as confidential business information pursuant to 37 C.F.R. § 42.74(c), consistent with the provisions of the Agreement.

The Board should terminate this proceeding because the parties 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).

The parties also have reached a resolution as to all the disputes in this proceeding and as to the patent at issue. Indeed, on September 13, 2024, the parties filed in Case No. 2:22-CV-00422-JRG-RSP a “Joint Stipulation dismissing with prejudice all of Headwater’s claims regarding U.S. Patent No. 9,609,544.”

Termination would save significant further expenditure of resources by the Parties and the Board. 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. For these reasons, termination of IPR2023-01360 is appropriate.

Respectfully submitted,

Dated September 26, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on September 26, 2024, a complete and entire copy of this Joint Motion to Terminate and Exhibit 1027 were provided by email, to the Patent Owner, by serving the correspondence addresses of record as follows:

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