

Paper No. ____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,

Patent Owner

U.S. Patent No. 7,373,449

Inter Partes Review No. IPR2024-00338

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S.
PATENT NO. 7,373,449**

Pursuant 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, and the authorization provided by the Board on July 8, 2024, Petitioner Samsung Electronics Co., Ltd. (“Samsung”) and Patent Owner Network Systems Technologies, LLC (“NST”) jointly move to terminate the *inter partes* review of U.S. Patent No. 7,373,449 (“the ’449 Patent”) (“Joint Motion”).

I. STATEMENT OF FACTS

Petitioner and Patent Owner have entered into a written confidential settlement agreement that presently resolves the parties’ disputes. The parties are concurrently filing a copy of the settlement agreement as Exhibit 2063. Pursuant to 35 U.S.C. § 317 and the Board’s precedential decision in *DTN, LLC v. Farms Tech., LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019), Patent Owner is also concurrently filing a copy of a collateral agreement referenced in the settlement agreement as Exhibit 2064 as a “Board Only” filing due to confidentiality obligations owed to a third party.

The undersigned represent that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding and that Exhibit 2063 is a true and accurate copy of the settlement agreement between the parties. Patent Owner represents that Exhibit 2064 is a true and accurate copy of the collateral agreement.

The parties are concurrently filing a request to treat Exhibits 2063 and 2064 as confidential business information pursuant to 35 U.S.C. § 317(b).

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

A. Brief Explanation

Termination is appropriate in this case because the Parties have resolved all of their disputes relating to this proceeding involving the ’449 Patent, as set forth in the confidential settlement agreement. *See* Exhibit 2063. Both Petitioner and Patent Owner support termination of the proceeding and the Board has not yet decided the merits of this proceeding.

B. Related Litigation

The ’449 Patent was previously asserted by Patent Owner in *Network System Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 2:22-cv-00481 (E.D. Tex. filed Dec. 19, 2022), but that case is no longer pending.

Patent Owner also asserted the '449 Patent in the following district court cases against defendants unrelated to Petitioner:

- *Network System Technologies, LLC v. Texas Instruments Inc.*, No. 2:22-cv-00482 (E.D. Tex. filed Dec. 19, 2022);
- *Network System Technologies, LLC v. Qualcomm Inc. et al.*, No. 1:22-cv-01331 (W.D. Tex. filed Dec. 19, 2022);
- *Network System Technologies, LLC v. Lenovo Group Ltd.*, No. 2:23-cv-00167 (E.D. Tex. filed Apr. 11, 2023);
- *Network System Technologies, LLC v. Ford Motor Co.*, No. 2:23-cv-00440 (E.D. Tex. filed Sept. 26, 2023); and
- *Network System Technologies, LLC v. OnePlus Technology (Shenzhen) Co., Ltd.*, No. 2:23-cv-00520 (E.D. Tex. filed Nov. 14, 2023).

Each of those cases remains pending.

C. Related Proceedings Before the Office

The '449 Patent is at issue in *Qualcomm Incorporated v. Network System Technologies, LLC*, IPR2024-01081. Additionally, in its Preliminary Response, Patent Owner identified the following Board proceedings as related matters:

- *Samsung Electronics Co., Ltd. v. Network System Technologies, LLC*, IPR2024-00339 (Patent 8,086,800 B2);
- *Qualcomm Inc. and Samsung Electronics Co., Ltd. v. Network System Technologies, LLC*, IPR2024-00343 (Patent 7,594,052 B2); and
- *Qualcomm Inc. and Samsung Electronics Co., Ltd. v. Network System Technologies, LLC*, IPR2024-00355 (Patent 8,072,893 B2).

(Paper No. 4 at 3).

On June 17, 2024, the Patent Trial and Appeal Board issued a Decision Denying Institution of *Inter Partes* Review in IPR2024-00355. (IPR2024-00355, Paper No. 9). On June 20, 2024, the Patent Trial and Appeal Board issued a Decision Denying Institution of *Inter Partes* Review in IPR2024-00339. (IPR2024-00339, Paper No. 13). On June 21, 2024, the Patent Trial and Appeal Board issued a Decision Granting Institution of *Inter Partes* Review in IPR2024-00343. (IPR2024-00343, Paper No. 11).

II. STATEMENT OF RELIEF REQUESTED

Due to the present resolution of the parties' disputes relating to the patent that is the subject of this IPR proceeding, the Parties jointly request termination of IPR2024-00338 under 35 U.S.C. § 317(a). The requested relief is appropriate because the Parties have resolved all of their disputes in this proceeding relating to the '449 Patent and the Board has not yet decided the merits of this proceeding. Because no petitioners remain after termination with respect to Samsung, the Board should exercise its discretion and terminate this proceeding in its entirety. "Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement." *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (P.T.A.B. July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). A true copy of the document resolving the disputes related to the '449 Patent is filed concurrently herewith. *See* Exhibits 2063,

2064; 37 CFR § 42.74(b). Further, a termination of this proceeding will promote efficiency and conserve the Board's and the parties' resources.

III. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR of the '449 Patent.

Dated: July 8, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Joint Motion to Terminate was served on July 8, 2024, upon the following parties via electronic service:

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