Paper No. ___

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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QUALCOMM INCORPORATED and
SAMSUNG ELECTRONICS CO., LTD.,

Petitioners

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,

Patent Owner

U.S. Patent No. 7,594,052

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Inter Partes Review No. IPR2024-00343

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**JOINT MOTION TO TERMINATE SAMSUNG
FROM THE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R. §§ 42.5(a) AND 42.74**

I. STATEMENT OF RELIEF REQUESTED

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 18, 2024, Petitioner Samsung Electronics Co., Ltd. ("Samsung") and Patent Owner Network Systems Technologies, LLC ("NST") jointly request termination of the above-captioned proceeding as to Samsung as a result of a settlement between Samsung and Patent Owner. Petitioner Qualcomm Incorporated ("Qualcomm") does noes not object to dismissing Samsung from this proceeding.

II. STATEMENT OF FACTS

In December of 2022, Patent Owner filed a complaint in the Eastern District of Texas asserting infringement by Samsung of certain claims of U.S. Patent No. 7,594,052 (the "'052 Patent"). The '052 Patent is also the subject of a complaint filed by Patent Owner in the Western District of Texas asserting infringement by Qualcomm.

Samsung and Qualcomm filed a petition seeking *inter partes* review of the '052 Patent on December 19, 2023. Patent Owner submitted its Preliminary Response on March 27, 2024 (Paper No. 7). On May 2, 2024, Petitioners filed a Reply to Patent Owner's Preliminary Response (Paper No. 9). On May 9, 2024, Patent Owner filed a Preliminary Sur-Reply (Paper No. 10). On June 21, 2024, the Patent Trial and Appeal Board issued its Decision Granting Institution of *Inter*

Partes Review (Paper No. 11). The Board has not yet decided the merits of this proceeding.

Samsung 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 2059 as a "Board Only" filing due to confidentiality obligations. Pursuant to 35 U.S.C. § 317 and the Board's precedential decision in *DTN, LLC v. Farms Tech., LLC*, IPR2018-01412, Paper 21 (June 14, 2019), Patent Owner is also concurrently filing a copy of a collateral agreement referenced in the settlement agreement as Exhibit 2060 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 dismissal of Samsung from the present proceeding and that Exhibit 2059 is a true and accurate copy of the settlement agreement between the parties. Patent Owner represents that Exhibit 2060 is a true and accurate copy of the collateral agreement.

III. ARGUMENT

A. Legal Standard

35 U.S.C. § 317(a) provides that "[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the

proceeding before the request for termination is filed." In addition, "[t]he Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding." 37 C.F.R. § 42.5(a).

B. The Board Should Exercise Its Discretion and Dismiss Samsung from the Above-Captioned Proceeding

As noted in the Statement of Facts, Samsung and Patent Owner have presently resolved the parties' disputes. Dismissing Samsung from the proceedings would effect the agreement between the Patent Owner and Samsung.

Dismissing Samsung from the proceedings would not prejudice Qualcomm because Qualcomm is represented by separate counsel.

C. Status of Related Matters

The '052 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) and *Network System Technologies, LLC v. Texas Instruments Inc.*, No. 2:22-cv-00482 (E.D. Tex. filed Dec. 19, 2022), but those cases are no longer pending.

Patent Owner also asserted the '052 Patent in the following district court cases against defendants unrelated to Samsung:

- *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.

IV. CONCLUSION

Samsung and Patent Owner respectfully request that the Board grant the parties' Joint Motion to dismiss Samsung from the proceeding.

Dated: July 18, 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 18, 2024, upon the following parties via electronic service:

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