

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

NETWORK SYSTEM TECHNOLOGIES, LLC,
Patent Owner.

IPR2024-00343
Patent 7,594,052 B2

Before CHARLES J. BOUDREAU, JOHN R. KENNY, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

KENNY, *Administrative Patent Judge*.

ORDER

Settlement as to Samsung Electronics Co., Ltd.
35 U.S.C. § 317; 37 C.F.R. § 42.74

INTRODUCTION

With our authorization, Petitioner Samsung Electronics Co., Ltd. (“Samsung”) and Network System Technologies, LLC (“Patent Owner”) filed a Joint Motion to Terminate Samsung from the Proceeding. Paper 19 (“Mot.”). Further, with our authorization, Samsung and Patent Owner filed a Joint Request to Keep Confidential and Separate. Paper 18 (“Joint Req.”).

DISCUSSION

Samsung and Patent Owner represent that they have entered into a written confidential settlement agreement that presently resolves the parties’ disputes. Mot. 2. Further, Samsung and Patent Owner represent that Exhibit 2059 is a copy of their written settlement agreement and Exhibit 2060 is a collateral agreement referenced in the settlement agreement. *Id.* Samsung and Patent Owner further represent that there are no other agreements, oral or written, between Samsung and Patent Owner 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 Samsung and Patent Owner. *Id.* Further, Patent Owner represents that Exhibit 2060 is a true and accurate copy of the collateral agreement. *Id.* In addition, Samsung and Patent Owner represent that Petitioner Qualcomm Incorporated (“Qualcomm”) does not object to dismissing Samsung from this proceeding. *Id.* at 1.

In the Joint Request, Samsung and Patent Owner request that Exhibits 2059 and 2060 be treated as business confidential information and be kept separate from the file of the involved patent and this IPR. Joint Req. 1.

Under 35 U.S.C. § 317(a), “[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.” The Board has not yet decided the merits of this proceeding. Thus, we terminate this proceeding with respect to Samsung. Section 317(a) also provides that, if no petitioner remains in the *inter partes* review, the Office may terminate the review. In this proceeding, Qualcomm remains a petitioner. Thus, we do not terminate the review as to Qualcomm and Patent Owner.

After reviewing Exhibits 2059 and 2060, we find that they contain confidential business information, and we determine that good cause exists to treat them as business confidential information. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74. We further grant the request to keep Exhibits 2059 and 2060 separate from the file of the involved patent (US 7,594,052 B2, “’052 patent”). We, however, do not grant the request to keep Exhibits 2059 and 2060 separate from the file of this IPR. Samsung and Patent Owner cite no authority for keeping these exhibits separate from the file of this IPR, and these exhibits were filed in the electronic file for this IPR.

ORDER

It is

ORDERED that the parties’ Joint Motion to Terminate Samsung from this Proceeding (Paper 19) is *granted*; and

FURTHER ORDERED that this proceeding is terminated as to Samsung;

FURTHER ORDERED that this proceeding will continue between Qualcomm and Patent Owner;

FURTHER ORDERED that Samsung's and Patent Owner's joint request to treat Exhibits 2059 and 2060 as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and keep separate from the file of the '052 patent is granted; and

FURTHER ORDERED that Samsung's and Patent Owner's joint request to keep Exhibits 2059 and 2060 separate from the file of this IPR is denied.

IPR2024-00343
Patent 7,594,052 B2

For PETITIONER:

J. Derek Vandenburg
Aaron W. Pederson
Nathan D. Louwagie
Ryan D. Rypka
CARLSON CASPERS VANDENBURGH & LINDQUIST, P.A.
dvandenburg@carlsoncaspers.com
apederson@carlsoncaspers.com
nlouwagie@carlsoncaspers.com
rrypka@carlsoncaspers.com

F. Christopher Mizzo, P.C.
Gregory S. Arovas, P.C.
Alan Rabinowitz
KIRKLAND & ELLIS LLP
Samsung_NST_IPR@kirkland.com

For PATENT OWNER:

Jennifer Hayes
Daniel S. Stringfield
Angelo J. Christopher
Hang Zheng
NIXON PEABODY LLP
jenhayes@nixonpeabody.com
dstringfield@nixonpeabody.com
achristopher@nixonpeabody.com
hzheng@nixonpeabody.com