UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

STATON TECHIYA, LLC,

Patent Owner

Case IPR2024-01004

U.S. Patent No. 11,710,473

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,710,473 ("*'473pat.*")
1002	Declaration of Dr. Kyriakakis ("*Kyriakakis*")
1003	Curriculum Vitae of Dr. Kyriakakis
1004	File History of U.S. Patent 11,710,473
1005	U.S. Provisional Application 60/885,917
1006	U.S. Application 17/321,892 ("'892App")
1007	U.S. Patent 11,244,666 ("'666 patent")
1008	File History of U.S. Patent 11,244,666
1009	File History of U.S. Appl. No. 90/019,169, Samsung Electronics Co., Ltd. and Samsung Electronics, America, Inc., Request for *Ex Parte Reexamination* of U.S. Pat. No. 11,244,666, Date: Feb. 24, 2023
1010	Family Tree for the '473 Patent
1011	Order on Claim Construction issued in *Staton Techiya, LLC et al. v. Samsung Electronics Co., Ltd. et al*., 2:21-cv-00413-JRG-RSP (E.D. Tex. Dec. 17, 2023)
1012	Order Granting Proposed Docket Control Order in *Staton Techiya, LLC et al. v. Samsung Electronics Co., Ltd. et al*., 2:23-cv-00319 (E.D. Tex. Feb. 8, 2023)
1013	Letter from Nikhil Krishnan to Thomas J Friel, Jr.
1014	RESERVED
1015	RESERVED
1016	RESERVED

Exhibit No.	DESCRIPTION
1017	RESERVED
1018	RESERVED
1019	RESERVED
1020	RESERVED
1021	RESERVED
1022	RESERVED
1023	U.S. Patent 4,455,677 ("*Fox*")
1024	U.S. Patent 4,827,458 ("*d'Arc*")
1025	EP0495653A ("*Smiedt*")
1026	U.S. Patent 5,647,011 ("*Garvis*")
1027	U.S. Patent 6,782,106 ("*Kong*")
1028	Sumit Basu et al., *Smart Headphones: Enhancing Auditory Awareness Through Robust Speech Detection and Source Localization*, 5 IEEE INT'L CONF. ON ACOUSTICS SPEECH & SIGNAL PROCESSING PROC. 3361 (2001)
1029	Florian Mueller & Matthew Karau, *Transparent Hearing*, CHI '02 EXTENDED ABSTRACTS ON HUM. FACTORS IN COMPUTING SYS. 730 (2002)
1030	U.S. Publication 2001/0046304A1 ("*Rast*")
1031	U.S. Patent 4,947,432 ("*Topholm432*")
1032	U.S. Patent 5,202,927 ("*Topholm927*")
1033	RESERVED
1034	RESERVED

Exhibit No.	DESCRIPTION
1035	RESERVED
1036	Excerpts from ROBERT OSHANA, DSP SOFTWARE DEVELOPMENT TECHNIQUES FOR EMBEDDED AND REAL-TIME SYSTEMS (2006) ("*Oshana*")
1037	RESERVED
1038	RESERVED
1039	RESERVED
1040	RESERVED
1041	RESERVED
1042	RESERVED
1043	RESERVED
1044	RESERVED
1045	RESERVED
1046	RESERVED
1047	RESERVED
1048	RESERVED
1049	RESERVED
1050	RESERVED
1051	U.S. Patent 7,903,826 ("*Boersma*")
1052	U.S. Publication 2018/0160211 ("*Kirsch*")
1053	U.S. Publication 2015/0195641 ("*DiCenso*")
1054	U.S. Publication 2008/0181419 ("*Goldstein*")

Exhibit No.	DESCRIPTION
1055	U.S. Publication 2020/0380945 ("*Woodruff*")
1056	Exhibit A06 to Techiya's Infringement Contentions and Claim Chart for U.S Patent 11,710,473
1057	U.S. Publication 2006/0120545A1 ("*Rasmussen*")
1058	*Kuo*, et al., "Active Noise Control: A Tutorial Review," In Proc. IEEE 87(6) (June 1999) ("*Kuo*")
1059	Stay Order issued in *Staton Techiya, LLC v. Samsung Electronics Co., Let. Et al.*, 2:23-cv-00319-JRG-RSP (E.D. Tex. Oct. 30, 2024)
1060	Confidential Settlement Agreement Between Samsung and Techiya

Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. ("Petitioners"), and Patent Owner Staton Techiya, LLC ("Patent Owner") have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioners and Patent Owner move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

Petitioners and Patent Owner have reached agreement (the "Settlement Agreement") to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 1060. The Settlement Agreement is being filed electronically with access to "Board Only." A "*Joint Request to Treat Settlement Agreement as Business Confidential Information"* is being filed concurrently with this Joint Motion to Terminate Proceeding, to treat the Settlement Agreement 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).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and all 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 Settling Parties jointly request, for the following reasons.

First, 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).

Second, the parties have reached a settlement as to all the disputes in this proceeding and as to the '473 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex. 1060. The parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). There are no other agreements, written or oral, between or among the parties made in connection with, or in contemplation of, the dismissal of the 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 settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. Conclusion

For the foregoing reasons, Petitioners and Patent Owner respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: December 9, 2024

/Ali R. Sharifahmadian/
Ali R. Sharifahmadian (Reg. No. 48,202)
Counsel for Petitioners

Respectfully submitted,

Date: December 9, 2024

/Ojeiku Aisiku/
Ojeiku Aisiku (Reg. No. 71,180)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I certify that on December 9, 2024, I caused a true and correct copy of the foregoing Joint Motion to Terminate Proceeding to be served on the Patent Owner via electronic mail to Patent Owner's counsel of record below and pending substitute counsel:

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