UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC., HARMAN INTERNATIONAL INDUSTRIES, INC.

Petitioners

v.

STATON TECHIYA, LLC,

Patent Owner

Case IPR2024-01015

U.S. Patent No. 11,665,493

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,665,493 ("'493")
1002	Declaration of Dr. Kyriakakis ("*Kyriakakis*")
1003	Curriculum Vitae of Dr. Kyriakakis
1004	File History of U.S. Patent 11,655,493 ("'493FH")
1005	U.S. Provisional Application 61/098,250
1006	U.S. Application 12/555,864
1007	U.S. App. Pub. No. 20070299362 ("*Epley*")
1008	U.S. App. Pub. No. 2005/0096899 ("*Padhi*")
1009	U.S. App. Pub. No. 2005/0123146 ("*Voix*")
1010	Certified Translation of Japanese Patent Application Publication 2002-204500 ("*Hayashi*")
1011	Japanese Patent Application Publication 2002-204500
1012	U.S. Patent 5,182,744 ("*Bourk*")
1013	U.S. Patent Appl. Pub. No. 2008/0107287 ("Beard")
1014	U.S. Patent No. 10,979,836 ("'836 patent") *Ex Parte Reexamination*, Final Rejection (07/28/2023)
1015	U.S. Patent No. 6,567,524 ("*Svean*")
1016	U.S. Patent No. 7,039,195B1
1017	*Staton Techiya, LLC et al v. Samsung Electronics Co., Ltd. et al,* Case No. 2-21-cv-00413, (E.D. Tex, Feb. 8, 2023), Claim Construction Order Dkt. No. 285 (regarding U.S. Patent No. 9,609,424 ("the '424 patent"))

Exhibit No.	DESCRIPTION
1018	Patent Owner appeal – ’836 EPR
1019	U.S. Patent No. 6,671,643
1020	United States District Courts – National Judicial Caseload Profile
1021	Sotera Stipulation
1022	Stay Order issued in Staton Techiya, LLC v. Samsung Electronics Co., Ltd. et al., 2:23-cv-00319-JRG-RSP (E.D. Tex. Oct. 30, 2024)
1023	Confidential Settlement Agreement Between Samsung and Techiya

Petitioners Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Harman International Industries, 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 1023. 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 '493 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex. 1023. 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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