

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 IPR2024-01032

U.S. Patent No. 11,683,643

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONERS' UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent 11,683,643 (“’643pat.”)
1002	Declaration of Nathaniel Polish, Ph.D.
1003	Curriculum Vitae of Nathaniel Polish, Ph.D.
1004	File History of U.S. Patent 11,683,643
1005	U.S. Provisional Application 60/916,271
1006	U.S. Application 12/115,349
1007	U.S. Application 12/170,171
1008	U.S. Application 13/956,767
1009	U.S. Application 16/247,186
1010	Family tree for the ’643pat.
1011	Order on Claim Construction issued in <i>Staton Techiya, LLC et al. v. Samsung Electronics Co., Ltd. et al.</i> , 2:21-cv-00413-JRG-RSP (E.D. Tex. Dec. 17, 2023)
1012	Order Granting Proposed Docket Control Order in <i>Staton Techiya, LLC et al. v. Samsung Electronics Co., Ltd. et al.</i> , 2:23-cv-00319 (E.D. Tex. Dec. 17, 2023)
1013	<i>Samsung Electronics Co., Ltd. et al. v. Staton Techiya, LLC</i> , IPR2022-01078, Paper No. 26 (Nov. 13, 2023)
1014	Letter from Nikhil Krishnan to Thomas J. Friel, Jr.
1015	U.S. Patent 6,754,359 (“Svean”)
1016	U.S. Publication 2006/0153394A1 (“Beasley”)
1017	U.S. Patent 5,251,263 (“Andrea”)

Exhibit No.	DESCRIPTION
1018	U.S. Publication 2006/0140416 (“ <i>Berg</i> ”)
1019	U.S. Publication 2018/0115818A1 (“ <i>Asada</i> ”)
1020	U.S. Publication 2014/0270200A1 (“ <i>Usher</i> ”)
1021	U.S. Publication 2001/0046304A1 (“ <i>Rast</i> ”)
1022	U.S. Publication 2018/0160211A1 (“ <i>Kirsch</i> ”)
1023	EP1594344 (“ <i>Stirnemann</i> ”)
1024	U.S. Publication 2007/0009122A1 (“ <i>Hamacher</i> ”)
1025	U.S. 5,862,065 (“ <i>Muthusamy</i> ”)
1026	U.S. Publication 2002/0141599A1 (“ <i>Trajkovic</i> ”)
1027	U.S. Publication 2003/0147544A1 (“ <i>Lichtblau</i> ”)
1028	U.S. Patent 7,209,568 (“ <i>Arndt-568</i> ”)
1029	U.S. Patent 6,826,286 (“ <i>Arndt-286</i> ”)
1030	U.S. Publication 2020/0380945A1 (“ <i>Woodruff</i> ”)
1031	U.S. Patent 6,415,034 (“ <i>Hietanen</i> ”)
1032	EP 1385324 (“ <i>Pedersen</i> ”)
1033	U.S. Publication 2005/0168824 (“ <i>Travers</i> ”)
1034	U.S. Publication 2006/0135085 (“ <i>Chen</i> ”)
1035	Excerpt from COMPUTER DICTIONARY (2d ed. 1994) (“ <i>Computer Dictionary</i> ”)
1036	<i>Kuo et al.</i> , “Active Noise Control: A Tutorial Review,” In Proc. IEEE 87(6) (June 1999) (“ <i>Kuo</i> ”)
1037	U.S. Publication 2007/0223717A1 (“ <i>Boersma</i> ”)

Exhibit No.	DESCRIPTION
1038	U.S. Patent 5,636,351 (“ <i>Lee</i> ”)
1039	United States District Courts – National Judicial Caseload Profile
1040	Stay Order issued in <i>Staton Techiya, LLC v. Samsung Electronics Co., Ltd. et al.</i> , 2:23-cv-00319-JRG-RSP (E.D. Tex. Oct. 30, 2024)
1041	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 1041. 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 ’643 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex. 1041. 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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