

Christopher, Angelo

From: Trials <Trials@USPTO.GOV>
Sent: Monday, July 8, 2024 1:47 PM
To: Hayes, Jennifer; Trials
Cc: chris.mizzo@kirkland.com; Sasmung_NST_IPR@kirkland.com; Stringfield, Daniel; Christopher, Angelo; alan.rabinowitz@kirkland.com; Arovas, Greg (garovas@kirkland.com)
Subject: RE: IPR2024-00338 - Request for Authorization to File Motion to Terminate Proceeding

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Counsel,

In IPR2024-00338, the Board authorizes the parties to file a joint motion to terminate the proceeding and a separate joint request to treat the parties' settlement agreement and any collateral agreement as business confidential information under 37 C.F.R. § 42.74(c).

The parties are reminded of their obligation under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) to file a complete (unredacted) copy of any settlement agreement and any collateral agreement (including any license agreement) with the Board as an exhibit. In their joint motion to terminate, the parties should include a statement that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding, assuming such statement is correct. If the parties cannot make such statement, the other agreement(s) must be filed under 37 C.F.R. § 42.74.

The parties must file each confidential agreement electronically in the Patent Trial and Appeal Case Tracking System (P-TACTS) as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only"). The parties are directed to FAQ G2 on the Board's website at https://www.uspto.gov/sites/default/files/documents/p-tacts_faqs_20221007.pdf for guidance on how to file an agreement as confidential.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Hayes, Jennifer <jenhayes@nixonpeabody.com>
Sent: Tuesday, July 2, 2024 11:11 AM
To: Trials <Trials@USPTO.GOV>
Cc: chris.mizzo@kirkland.com; Sasmung_NST_IPR@kirkland.com; Stringfield, Daniel <dstringfield@nixonpeabody.com>; Christopher, Angelo <achristopher@nixonpeabody.com>; alan.rabinowitz@kirkland.com; Arovas, Greg (garovas@kirkland.com) <garovas@kirkland.com>
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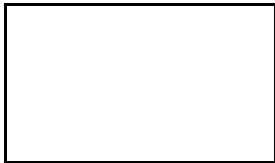
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Your Honors,

Judge Gilstrap granted the motion to dismiss in the related matters. The parties renew their request for authorization to file the motion to terminate the proceeding and request to keep the settlement and collateral agreements as business confidential information and Board only, respectively.

Regards,

Jennifer Hayes



Jennifer Hayes

Partner

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From: Hayes, Jennifer

Sent: Friday, June 28, 2024 10:55 AM

To: 'trials@uspto.gov' <trials@uspto.gov>

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Your Honors,

Yesterday evening, the parties to IPR2024-00338 filed a joint motion to dismiss the Related Matter, *Network System Technologies, LLC v. Samsung Electronics Co., Ltd. et al.*, No. 2:22-cv-00481 (E.D. Tex.), based on a settlement agreement between the parties.

The parties therefore respectfully request authorization to file, upon their joint motion to dismiss the Related Matter being granted, a motion to terminate this proceeding. In connection therewith, the parties will file a copy of the settlement agreement as business confidential information and Patent Owner will file a copy of a collateral agreement as a "Board Only" exhibit given confidentiality obligations owed to a third party. The parties also request authorization to file a request to keep the settlement and collateral agreements as business confidential information and "Board Only," respectively, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The parties are available for a conference call with the Board to discuss this request.

Regards,

Jennifer Hayes
Lead Counsel for Patent Owner
Reg. No. 50,845



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