

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

HARMAN INTERNATIONAL INDUSTRIES, INC.

Petitioner

v.

ST CASESTECH, LLC,

Patent Owner

---

Case IPR2024-01299

U.S. Patent No. 8,319,620

---

**JOINT MOTION TO TERMINATE PROCEEDING**

**PETITIONER’S UPDATED EXHIBIT LIST**

| <b>Exhibit No.</b> | <b>DESCRIPTION</b>                                                                                                                                       |
|--------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------|
| 1001               | U.S. Patent No. 8,319,620 (“620”)                                                                                                                        |
| 1002               | File History of U.S. Application No. 12/487,639 (“’620FH”)                                                                                               |
| 1003               | Declaration of Dr. Sayfe Kiaei in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,319,620 (“Kiaei”)                              |
| 1004               | Certified Translation of Korean Patent Application Publication No. KR10-2004-0091262 (“Kim”)                                                             |
| 1005               | Korean Patent Application Publication No. 10-2004-0091262                                                                                                |
| 1006               | Certified Translation of Japanese Patent Publication No. JPH06-325291 (“Kobayashi”)                                                                      |
| 1007               | Japanese Patent Publication No. JPH06-325291                                                                                                             |
| 1008               | Certified Translation of German Patent Application Publication No. DE19749372 (“Bergholz”)                                                               |
| 1009               | German Patent Application Publication No. DE19749372                                                                                                     |
| 1010               | U.S. Patent No. 6,360,187 (“Hermann”)                                                                                                                    |
| 1011               | U.S. Patent No. 7,791,499 (“Mohan”)                                                                                                                      |
| 1012               | U.S. Patent No. 6,150,927 (“Nesbitt”)                                                                                                                    |
| 1013               | United States District Courts - National Judicial Caseload Profile                                                                                       |
| 1014               | Complaint for Patent Infringement, <i>Staton Techiya, LLC v. Harman International Industries, Inc.</i> , No. 1:23-cv-801, D.I. 1 (D. Del. July 25, 2023) |
| 1015               | Ito, <i>Visual Distraction While Driving: Trends in Research and Standardization</i> , 25 IATSS Research 20-28 (2001) (“Ito”)                            |
| 1016               | U.S. Patent Application Publication No. 2005/0074131                                                                                                     |

| <b>Exhibit No.</b> | <b>DESCRIPTION</b>                                                                                                           |
|--------------------|------------------------------------------------------------------------------------------------------------------------------|
| 1017               | U.S. Patent Application Publication No. 2006/0030987 (“Akita”)                                                               |
| 1018               | U.S. Patent Application Publication No. 2003/0138118 (“Stahl”)                                                               |
| 1019               | Excerpts of MICHAEL H. COHEN, VOICE USER INTERFACE DESIGN (2004) (“Cohen”)                                                   |
| 1020               | U.S. Patent Application Publication No. 2006/0116175 (“Chu”)                                                                 |
| 1021               | U.S. Patent No. 6,219,645 (“Byers”)                                                                                          |
| 1022               | U.S. Patent Application Publication No. 2005/0154505 (“Nakamura”)                                                            |
| 1023               | U.S. Patent Application Publication No. 2008/0117038 (“Stark”)                                                               |
| 1024               | Declaration of Jonathan Bradford in Support of Petition for <i>Inter Partes</i> Review of United States Patent No. 8,319,620 |
| 1025               | Confidential Settlement Agreement Between Samsung and Techiya                                                                |

Petitioner Harman International Industries, Inc. (“Petitioner”), and Patent Owner ST CasesTech, LLC (“Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner and Patent Owner move to terminate the present *inter partes* review proceeding.

## **I. STATEMENT OF FACTS**

Petitioner 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 1025. The Settlement Agreement is being filed electronically with access to “Board Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, 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 ’620 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex. 1025. 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, Petitioner and Patent Owner respectfully request termination of this *inter partes* review.

[signatures on next page]

Respectfully submitted,

Date: December 19, 2024

/James L. Davis, Jr./  
James L. Davis, Jr. (57,325)  
*Attorneys for Petitioner*

Respectfully submitted,

Date: December 19, 2024

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

**CERTIFICATE OF SERVICE**

I certify that on December 19, 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:

Ojeiku Aisiku (oaisiku@kslaw.com)  
Roy Falik (rfalik@kslaw.com)  
James P. Brogan (jbrogan@steptoe.com)

/James L. Davis, Jr./

Name: James L. Davis, Jr.