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 IPR2024-01301

U.S. Patent No. 8,805,692

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER'S UPDATED EXHIBIT LIST

Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 8,805,692 ("'692")
1002	File History of U.S. Application No. 14/148,752 ("'692FH")
1003	Declaration of Michael T. Johnson ("Johnson")
1004	U.S. Patent Application Publication No. 2006/0132382 ("Jannard")
1005	U.S. Patent 7,529,677 B1 ("Wittenberg")
1006	Wittenberg Patent Application (No. 11/038,426) As-Filed
1007	U.S. Patent Application Publication No. 2006/0020960 ("Relan")
1008	U.S. Patent Application Publication No. 2003/0220835 ("Barnes")
1009	U.S. Patent Application Publication No. 2003/0130852 ("Tanaka")
1010	U.S. Patent Application Publication No. 2010/0311390 ("Black").
1011	U.S. Patent Application Publication No. 2007/0165875 ("Rezvani")
1012	United States District Courts National Judicial Caseload Profile
1013	U.S. Patent Application Publication No. 2006/0136378 ("Martin")
1014	Australian Patent Application No. 2005201979 Al
1015	Computer Dictionary, 2nd Edition, 1994, excerpt page 365.
1016	U.S. Patent No. 5,251,263 ("Andrea")
1017	Provisional Patent Application No. 60/806,769
1018	Spoken language Processing, Huang, 2001 ("SLP")), Page 482
1019	Complaint, *Staton Techiya, LLC v. Harman International Industries, Inc.*, C.A. No. 23-802 (JCG) (Dist. Del.), filed July 25, 2023

Exhibit No.	DESCRIPTION
1020	Declaration of Jonathan Bradford
1021	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 1021. 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 '692 patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex. 1021. 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)
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