

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Samsung Electronics Co., Ltd.,
Petitioner,

v.

SiOnyx, LLC,
Patent Owner.

Case No. IPR2024-01430
Patent No. 11,069,737

JOINT MOTION TO TERMINATE THE PROCEEDING

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.72, and the Board’s authorization of March 21, 2025, Petitioner Samsung Electronics Co., Ltd. and Patent Owner SiOnyx, LLC (collectively “the parties”) jointly move to terminate the present *inter partes* review proceeding regarding U.S. Patent No. 11,069,737 (“the ’737 patent”).

I. PROCEDURAL BACKGROUND

Petitioner filed the petition for this IPR on September 24, 2024. On the same day, Petitioner filed a parallel petition in IPR2024-01431. The Board has not yet issued a decision on institution for either petition.

On January 22, 2025, Patent Owner submitted a preliminary response in which Patent Owner did not raise any *Fintiv* arguments.

On February 28, 2025, the USPTO rescinded former Director Vidal’s 2022 guidance memorandum, which had provided that “the PTAB no longer discretionarily denies petitions based on applying *Fintiv* to a parallel ITC proceeding.”

On March 13, 2025, Patent Owner submitted a supplemental submission in support of discretionary denial of petitions in view of a parallel ITC proceeding.

On March 20, 2025, Petitioner requested authorization to file a joint motion to terminate this IPR and submitted a response to Patent Owner’s submission, stating that “Petitioner is agreeing to narrow its challenges to U.S. Patent No. 11,069,737 before the Board by moving to terminate this IPR petition.” Paper 19 at 1.

II. JOINT MOTION TO TERMINATE THE PROCEEDING

The parties jointly request that this *inter partes* review be terminated in order to narrow the issues for the Board regarding Petitioner's challenges to the '737 patent.

Under 35 U.S.C. § 317(a), "[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed."

Termination of the present *inter partes* review is appropriate because the parties have agreed to narrow their dispute regarding the '737 patent and the Office has not yet decided the merits of the proceeding. There are no pertinent agreements or understandings between the patent owner and the petitioner under 35 U.S.C. § 317(b) or 37 C.F.R. § 42.74(b).

Therefore, the parties respectfully submit that this *inter partes* review should be terminated.

Date: April 1, 2025

Respectfully submitted,

By: /Scott C. Weidenfeller/

Scott C. Weidenfeller

Registration No.: 54,531

David A. Garr

Registration No.: 74,932

Alice J. Ahn

Registration No.: 79,829

IPR2024-01430

Patent No. 11,069,737

COVINGTON & BURLING LLP

One CityCenter, 850 Tenth Street, NW

Washington, DC 20001

Counsel for Petitioner

By: /Alison L. McCarthy/

Alison L. McCarthy (Lead Counsel)

Registration No. 51,998

Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that the foregoing Joint Motion to Terminate the Proceeding was served by electronic mail on the following counsel of record for patent owner:

alison.mccarthy@troutman.com
Dustin.Ferzacca@Troutman.com
Andrew.Zappia@Troutman.com

Date: April 1, 2025

/Scott C. Weidenfeller/
Scott C. Weidenfeller (Reg. No. 54,531)