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. IPR2025-00164
Patent No. 9,064,764

JOINT MOTION TO TERMINATE THE PROCEEDING AND JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of June 10, 2025, Petitioner Samsung Electronics Co., Ltd., ("Samsung") and Patent Owner SiOnyx, LLC ("SiOnyx") (collectively "the parties") jointly move to terminate the present *inter partes* review proceeding in light of the settlement of their dispute regarding U.S. Patent No. 9,064,764 ("the '764 patent"), and jointly request to treat as business confidential information the copy of the settlement agreement filed along with this paper (Confidential Exhibit 1026).

I. PROCEDURAL BACKGROUND

The Petition in this proceeding was filed on November 29, 2024, by Samsung. The Board has not yet issued a decision on institution.

On April 24, 2025, Patent Owner and RPX Corporation entered into a patent license agreement,[1] and on May 23, 2025, the parties entered into a settlement agreement that resolves the dispute between the parties regarding the '764 patent. *See* Confidential Exhibit 1026. In accordance with the settlement agreement, the parties contacted the Board by email, to request authorization to file a joint motion to terminate and joint request to file the settlement agreement as business

[1] The patent license agreement is not an agreement nor understanding entered into between Patent Owner and Petitioner.

confidential information. The Board authorized these filings in a responsive email on June 10, 2025.

II. JOINT MOTION TO TERMINATE THE PROCEEDING

First, the parties jointly request that this *inter partes* review be terminated in light of the settlement of their dispute regarding the ’764 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.” Additionally, the Board has explained:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . 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. 35 U.S.C. §§ 317(a), 327.

Consolidated Trial Practice Guide (November 2019) (“TPG”), page 86 § II.N.

Termination of the present *inter partes* review is appropriate because the parties have settled their dispute regarding the ’764 patent and the Office has not yet decided the merits of this proceeding.

Additionally, a true and complete copy of the settlement agreement is being filed along with this paper, *see* Confidential Exhibit 1026, and Patent Owner will

file a true and complete copy of the patent license agreement between Patent Owner and RPX Corporation referred to in that settlement agreement, *see* Confidential Exhibit 2005. The parties certify that there are no other agreements or understandings between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding.

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

III. JOINT REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION

Second, the parties jointly request that the agreements filed as Confidential Exhibit 1026 and Confidential Exhibit 2005 be treated as business confidential information and be kept separate from the publicly available files of the involved patent.

Section 317(b) provides that:

> At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

Likewise, 37 C.F.R. § 42.74(c) provides that:

> A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of

> an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:
>
> (1) To a Government agency on written request to the Board; or
>
> (2) To any other person upon written request to the Board to make the settlement agreement available, upon with the fee specified in § 42.15(d) and on a showing of good cause.

The present request, which is being filed along with the Settlement Agreement, is timely and in accordance with the foregoing authority.

Therefore, the parties respectfully submit that this request for confidential treatment should be granted.

Date: June 23, 2025

Respectfully submitted,

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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 and Joint Request to Treat Settlement Agreement as Business Confidential Information was served, together with Confidential Exhibit 1026, by electronic mail on the following counsel of record for Patent Owner:

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Dustin.Ferzacca@Troutman.com
Andrew.Zappia@Troutman.com

Date: June 23, 2025

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