UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. AND
SAMSUNG ELECTRONICS AMERICA, INC.,

Petitioners

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,

Patent Owner

Case IPR2025-00462

Patent No. 8,451,339

JOINT MOTION TO TERMINATE DUE TO SETTLEMENT[1]

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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[1] This Joint Motion was authorized by the Board in an e-mail dated 5/23/25.

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PATENT OWNER'S LIST OF EXHIBITS	
EX. 2001	Redacted Transcript, *Optimum Imaging Technologies LLC v. Nikon Corporation,* No. 4:23-cv-00923-ALM, Dkt. 84 (E.D. Tex. April 29, 2025)
EX. 2002	Joint Notice of Settlement and Request to Stay All Deadlines, *Optimum Imaging Technologies LLC v. Samsung Electronics Co., Ltd., et al.,* No. 4:23-cv-00927-ALM, Dkt. 114 (E.D. Tex. April 15, 2025)
EX. 2003	Amended Scheduling Order, *Optimum Imaging Technologies LLC v. Samsung Electronics Co., Ltd., et al.,* No. 4:23-cv-00927-ALM, Dkt. 78 (E.D. Tex. Feb. 14, 2025)
EX. 2004	Order granting Joint Motion to Dismiss, *Optimum Imaging Technologies LLC v. Fujifilm Corporation,* No. 4:23-cv-00922-ALM, Dkt. 75 (E.D. Tex. May 10, 2025)
EX. 2005	Joint Motion to Dismiss, *Optimum Imaging Technologies LLC v. Olympus Corporation, et al.,* No. 4:23-cv-00924-ALM, Dkt. 75 (E.D. Tex. April 25, 2025)
EX. 2006	Settlement Agreement (Board and Parties Only)
EX. 2007	Collateral Agreement (Board Only)

I. INTRODUCTION

Patent Owner Optimum Imaging Technologies LLC and Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. (collectively, "the Parties") have settled their disputes. Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, the Parties jointly request termination of this IPR in its entirety.

The Parties concurrently file another joint motion requesting that the Board treat EXS. 2006-2007 as business confidential information and keep EXS. 2006-2007 separate from the patent files.

II. THE PARTIES HAVE SETTLED THEIR DISPUTES

The Parties have resolved all disputes between them and with regard to the challenged patent. In compliance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), true and correct copies of the settlement and collateral agreements (EXS. 2006-2007) that resolve the disputes between the Parties are concurrently filed with this Joint Motion.[2] The Parties jointly certify that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination sought.

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[2] Due to the confidentiality terms of these agreements, Patent Owner is filing EX. 2006 as "Board and Parties Only" and Patent Owner is filing EX. 2007 as "Board Only."

Moreover, the Parties contemplate no new district court or administrative proceeding between them in the foreseeable future.

Furthermore, all pending district court proceedings involving the challenged patent have been settled and have been dismissed or are in the process of being dismissed. Patent Owner and Petitioner are the only parties to this proceeding.

III. THE PARTIES JOINTLY REQUEST TERMINATION AS TO THE PETITIONERS

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."

Consistent with the spirit of § 317(a), the Parties jointly request termination as to Petitioner Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. This IPR is pending pre-institution and Patent Owner has not yet filed any substantive brief addressing the merits. The Director has not entered a decision regarding discretionary denial and the panel has not entered a decision regarding the merits. Petitioner will no longer be participating in this IPR due to settlement.

IV. THE PARTIES JOINTLY REQUEST TERMINATION OF THIS IPR IN ITS ENTIRETY

"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." Consolidated Trial Practice Guide at 86 (November 2019). The Parties jointly request termination of this IPR in its entirety in support of the public policy considerations. Termination is appropriate at least because there are no other petitioners in this proceeding, there has been no decision regarding discretionary denial, no decision regarding institution, and there has been no decision on the merits. Termination will conserve the limited resources of the Board.

V. CONCLUSION

For at least the foregoing reasons, the Parties respectfully request termination as to the petitioners and termination of this IPR in its entirety.

Respectfully submitted on May 23, 2025,

By: */s/ Thomas M. Dunham*
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CERTIFICATE OF COMPLIANCE

This Joint Motion complies with the type-volume and general format requirements under 37 C.F.R. §§ 42.24(a)(1)(v) and 42.6(a).

Respectfully submitted,

Date: May 23, 2025

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LLC

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that this Joint Motion and EX. 2006 were served on the undersigned date via email, as authorized by Petitioners, at the following email addresses:

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