

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS
AMERICA, INC., SAMSUNG SEMICONDUCTOR, INC., and SAMSUNG
AUSTIN SEMICONDUCTOR LLC,
Petitioners,

v.

W&WSENS DEVICES INC.,
Patent Owner.

Case IPR2025-00997
U.S. Patent No. 9,525,084

JOINT MOTION TO TERMINATE PROCEEDING

PATENT OWNER'S EXHIBIT LIST

EXHIBIT	DESCRIPTION
2001	Messages between W&Wsens and Samsung (April 25, 2019, through April 26, 2019)
2002	Messages between W&Wsens and Samsung (April 27-28, 2019, August 14, 2019, February 20, 2020)
2003	Messages between W&Wsens and Samsung (April 27, 2019, August 14-15, 2019, February 20, 2020)
2004	Messages between W&Wsens and Samsung (April 24-25, 2019, May 14, 2019, August 14, 2019, March 3, 2020)
2005	W&Wsens Devices Inc. presentation – Thin Silicon Photosensors for The Next Generation
2006	Intentionally omitted
2007	Intentionally omitted
2008	Excerpts from Plaintiff W&Wsens Devices Inc.'s First Supplemental Objections and Responses to Defendants' First Set of Interrogatories (Nos. 1 and 3), <i>W&Wsens Devices, Inc. v. Samsung Elecs. Co.</i> , No. 24-cv-00854-JRG, E.D. Tex., served April 3, 2025
2009	Excerpts from Plaintiff W&Wsens Devices Inc.'s Objections and Responses to Defendants' First Set of Interrogatories (Nos. 1- 3), <i>W&Wsens Devices, Inc. v. Samsung Elecs. Co.</i> , No. 24-cv-00854-JRG, E.D. Tex., served March 20, 2025
2010	Photon-trapping microstructures enable high-speed high-efficiency silicon photodiodes, <i>Nature Photonics</i> 11, 301-308 (2017)
2011	Complaint for Patent Infringement, <i>W&Wsens Devices, Inc. v. Samsung Elecs. Co.</i> , No. 24-cv-00854-JRG, Dkt. No. 1 (E.D. Tex. Oct. 21, 2024)

EXHIBIT	DESCRIPTION
2012	Second Amended Docket Control Order, <i>W&Wsens Devices, Inc. v. Samsung Elecs. Co.</i> , No. 24-cv-00854-JRG, Dkt. No. 54 (E.D. Tex. April 22, 2025)
2013	Order, <i>Resonant Sys., Inc. v. Sony Grp. Corp.</i> , No. 2:22-cv-00424-JRG, Dkt. No. 84 (E.D. Tex. July 9, 2024)
2014	Order, <i>Gen. Access Sols., Ltd. v. Cellco P'ship</i> , No. 2:22-cv-00394-JRG, Dkt. No. 225 (E.D. Tex. May 22, 2024)
2015	Order, <i>Cal. Inst. of Tech. v. Samsung Elecs. Co.</i> , No. 21-cv-00446-JRG, Dkt. No. 108 (E.D. Tex. Jan. 20, 2023)
2016	Excerpt from U.S. District Court – National Judicial Caseload Profile Federal for the Eastern District of Texas, available at https://www.uscourts.gov/statistics-reports/caseload-statistics-data-tables
2017	Excerpts from Defendants’ Supplemental Invalidity Contentions cover pleading, <i>W&Wsens Devices, Inc. v. Samsung Elecs. Co.</i> , No. 24-cv-00854-JRG, E.D. Tex., served May 30, 2025
2018	Intentionally omitted
2019	Intentionally omitted
2020	W&Wsens Devices Inc. presentation – Time-of-Flight Solutions For The Next Generation
2021	W&Wsens Devices Inc. presentation – Revolutionizing Optical Connectivity
2022	U.S. Patent No. 11,621,360
2023	U.S. Patent No. 12,087,871
2024	U.S. Patent No. 12,243,948
2025	Excerpts from File History of U.S. Patent No. 11,621,360

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EXHIBIT	DESCRIPTION
2026	Excerpts from File History of U.S. Patent No. 12,087,871
2027	Excerpts from File History of U.S. Patent No. 12,243,948
2028	Joint Motion for Entry of an Order of Partial Dismissal without Prejudice, <i>W&Wsens Devices Inc. v. Samsung Electronics Co.</i> , Case No. 2:24-cv-00854-JRG, Dkt. 82 (E.D. Tex. Oct. 7, 2025)
2029	Proposed Order Granting Joint Motion for Entry of an Order of Partial Dismissal Without Prejudice, <i>W&Wsens Devices Inc. v. Samsung Electronics Co.</i> , Case No. 2:24-cv-00854-JRG, Dkt. 82-1 (E.D. Tex. Oct. 7, 2025)

Petitioners, Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Semiconductor, Inc., and Samsung Austin Semiconductor LLC (“Petitioners”), and Patent Owner, W&Wsens Devices Inc. (“W&Wsens”), jointly move to terminate the present *inter partes* review proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74. This motion is authorized by the Board in its email dated October 14, 2025.

I. STATEMENT OF FACTS

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, No. IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

In a related litigation, *W&Wsens Devices Inc. v. Samsung Electronics Co.*, 2:24-cv-00854 (the “Related Action”), W&Wsens asserted against Petitioners claims based on W&Wsens patents, including U.S. Patent No. 9,525,084 (the “’084 Patent”). After meeting and conferring to narrow the issues in dispute, W&Wsens and Petitioners filed a Joint Motion for Entry of an Order of Partial Dismissal, attached hereto as Exhibit 2028, seeking to dismiss W&Wsens’ claims based on the

‘084 Patent against Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. *See* Ex. 2029 (Proposed Order for Partial Dismissal). As consideration for W&Wsens’ dismissal of its claims against Petitioners based on the ‘084 Patent, Petitioners agreed to seek dismissal of this IPR. Further, W&Wsens and Petitioners have agreed to dismiss the Related Action as to the remaining parties Samsung Semiconductor, Inc. and Samsung Austin Semiconductor LLC. Ex. 2029 at 2. Thus, W&Wsens is no longer asserting the ‘084 Patent against any of the Petitioners.

Under 37 C.F.R. § 42.74(b), a true and correct copy of the Joint Motion for Entry of an Order of Partial Dismissal is being filed as Exhibit 2028. In the Joint Motion for Entry of an Order of Partial Dismissal, W&Wsens and Petitioners agreed (1) to jointly request authorization to terminate this *inter partes* review and (2) that W&Wsens is authorized to represent that Petitioners join in such request for authorization as well as this joint motion to terminate the proceeding. Ex. 2028. There is no settlement agreement between the parties.

There are no other related proceedings currently before the Office regarding the ‘084 Patent.

II. RELIEF REQUESTED

W&Wsens and Petitioners jointly request that the Board dismiss the Petition and terminate this proceeding in its entirety. Termination is appropriate at this stage

and in view of stipulations between Petitioners and W&Wsens. 37 C.F.R. § 42.71(a) (“The Board . . . may grant, deny, or dismiss any petition”); *see also KioSoft Techs., LLC v. PayRange Inc.*, No. PGR2023-00042, Paper 9 at 2 (P.T.A.B. Feb 6, 2024) (terminating the proceeding and dismissing the petition in view of settlement prior to issuance of institution decision).

Good cause exists to terminate this proceeding for three reasons: (1) W&Wsens has agreed to dismiss its infringement claims against Petitioners based on the '084 patent, with Petitioners agreeing to seek dismissal of this proceeding in exchange; (2) this proceeding is still at an early stage because the Office has not yet decided whether to institute trial; and (3) terminating the proceeding now would thus serve the interests of preservation of Board resources as well as the mutual interest of the parties.

First, good cause exists to terminate this proceeding because the parties have jointly moved to dismiss W&Wsens’ claims against Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. based on the '084 Patent in the Related Action and to dismiss the Related Action altogether as to the remaining Petitioners. Ex. 2029. In view of the stipulation (Ex. 2028), future litigation between the parties involving the '084 Patent is not presently contemplated.

Second, good cause exists to terminate this proceeding because the proceeding remains in the pre-institution stage: the Board has not issued a decision

on institution, no hearings have been held, and briefing is limited to the Petitioners' initial petition and W&Wsens' request for discretionary denial. Given that this *inter partes* review is at an early stage, it would be appropriate to terminate the proceeding. 35 U.S.C. § 317(a).

Third, good cause also exists because termination would save significant further expenditure of resources by the parties and the Board. Ending this petition for IPR early promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. See Changes to Implement *Inter Partes* Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012). The USPTO can conserve its resources by terminating now, removing the need for the Board to consider either the discretionary denial or merits arguments and to render an Institution Decision or Final Written Decision.

III. CONCLUSION

For the foregoing reasons, W&Wsens and Petitioners respectfully request termination of this *inter partes* review of the '084 Patent.

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Respectfully submitted,

Date: October 17, 2025

/James Hannah/

James Hannah (Reg. No. 56,369)

Attorney for Patent Owners
W&Wsens Devices Inc.

/Joshua L. Goldberg/

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Attorney for Petitioners

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, that service was made on Petitioners as detailed below.

<i>Date of service</i>	October 17, 2025
<i>Manner of service</i>	Electronic Filing with the Board (joshua.goldberg@finnegan.com; benjamin.saidman@finnegan.com; abhay.watwe@finnegan.com; biju.chandran@finnegan.com; kai.rajan@finnegan.com)
<i>Documents served</i>	JOINT MOTION TO TERMINATE PROCEEDING
<i>Persons Served</i>	Finnegan, Henderson, Farabow, Garrett & Dunner, LLP: Joshua L. Goldberg Benjamin A. Saidman Abhay A. Watwe Biju I. Chandran Kai Rajan

/James Hannah/
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