UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

SECURE COMMUNICATION TECHNOLOGIES, LLC,

Patent Owner.

Case IPR2025-01049

U.S. Patent No. 11,334,918

JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board's authorization by email dated August 14, 2025, Petitioners Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. ("Samsung") and Patent Owner Secure Communication Technologies, LLC ("SCT") jointly move to terminate the present *inter partes* review proceeding as a result of a Patent License Agreement between Samsung and SCT (the "Agreement"). The Agreement completely resolves all pending controversies between Samsung and SCT concerning U.S. Patent No. 11,334,918 ("the '918 patent").

The parties are concurrently filing true copies of their Agreement in connection with this matter as required by statute. The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Agreement be treated as business confidential information and kept separate from the file of the '918 patent. A joint request for such treatment pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently herewith.

II. STATEMENT OF FACTS

SCT asserted the '918 patent against Samsung in the action entitled *Secure*

Communication Technologies, LLC v. Samsung Electronics Co., Ltd., Case No. 2:24-cv-00484-JRG-RSP (E.D. Tex.) ("the Samsung Litigation"). SCT asserted two other patents against Samsung in that litigation, namely U.S. Patent Nos. 11,443,344 ("the '344 patent") and 11,687,971 ("the '971 patent").

On May 30, 2025, Samsung filed petitions for *inter partes* review against the three patents asserted in the Samsung Litigation. *See generally* IPR2025-01049 (the '918 patent), IPR2025-01050 (the '344 patent), IPR2025-01051 (the '971 patent). SCT's preliminary responses in those proceedings are due no later than September 18, 2025.

On August 7, 2025, the parties entered into the Agreement pursuant to which they agreed, among other things, to dismiss with prejudice the Samsung Litigation and to seek termination of this IPR proceeding. Concurrently herewith, the parties are filing joint motions to dismiss all claims in the Samsung Litigation with prejudice. Pursuant the Board's August 14, 2025 authorization email, the parties are also concurrently filing a joint motion to terminate in IPR2025-01050 and IPR2025-01051. Collectively, these joint filings before the Board and the district court will resolve all pending disputes between SCT and Samsung.

III. LEGAL STANDARD

35 U.S.C. § 317(a) provides that "[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." 37 C.F.R. § 42.72 similarly provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a)." The Trial Practice Guide also observes that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding" and that 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." 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

IV. GOOD CAUSE EXISTS TO TERMINATE THIS PROCEEDING.

Termination of the instant IPR is appropriate because the parties have settled their entire dispute concerning the '918 patent, and the Board has not yet decided the merits of this proceeding—and the Board has not even instituted review here. Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding. "Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement." *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (P.T.A.B. July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)). Patent Owner submits that terminating this proceeding promotes the Congressional goal to establish a more efficient and streamlined patent system that, inter alia, limits unnecessary and counterproductive

litigation costs. *See* "Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents," Final Rule, 77 Fed. Reg. 48680 (Aug. 14, 2012).

Accepting these principles, the Board has terminated proceedings based upon joint or unopposed motions to terminate. *See, e.g.*, *Staylinked Corp. v. Ivanti, Inc.*, IPR2021-00022, Paper 10 (P.T.A.B. Feb. 4, 2021) (granting unopposed motion); *World Programming LTD. v. SAS Institute, Inc.,* IPR2019-01457 Paper 22 at 2 (P.T.A.B. Dec. 27, 2019); *Samsung v. Nvidia*, IPR2015-01270, Paper 12 (P.T.A.B. Dec. 9, 2015).

V. CONCLUSION

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion and terminate this proceeding. The parties also request that the Board grant the parties' joint request to treat the Agreement as business confidential information and keep it separate from the file of the '918 patent and this *inter partes* review proceeding.

Dated: August 14, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Joint Motion to Terminate was served August 14, 2025, to Lead and Back-up Counsel for Petitioner at the service address provided in Petitioner's Mandatory Notices:

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