UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

WILUS INSTITUTE OF STANDARDS AND TECHNOLOGY INC.,
Patent Owner.

Case No. IPR2025-01164
U.S. Patent No. 12,004,262

JOINT MOTION TO TERMINATE PROCEEDING

Patent Owner Wilus Institute of Standards and Technology Inc. ("Wilus") and Petitioner Samsung Electronics Co., Ltd. ("Samsung") have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request termination of the *inter partes* review of U.S. Patent No. 12,004,262 ("Patent-in-Suit"), Case No. IPR2025-01164. The parties were authorized to file this Joint Motion by the Board via email on July 21, 2026.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement that resolves the disputes in the above-captioned *inter partes* review is filed herewith as Exhibit 1201. The parties also submit a sublicense agreement as Exhibit 1202. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Wilus and Samsung are concurrently filing a Joint Request to Treat the Agreements as Business Confidential Information and to Keep the Agreements Separate, which asks the Board to treat the settlement agreements as business confidential information, and to keep them separate from the files of this proceeding and the files of the Patent-in-Suit.

I. STATEMENT OF PRECISE RELIEF REQUESTED

Wilus and Samsung jointly request that the Board terminate IPR2025-01164 in its entirety.

II. REASONS WHY TERMINATION IS APPROPRIATE

Termination of IPR2025-01164 in its entirety is appropriate. Samsung is the only Petitioner in IPR2025-01164. Samsung no longer intends to participate in this IPR, so IPR2025-01164 should be terminated. The lawsuit between Wilus and Samsung involving the Patent-at-Issue is being dismissed pursuant to the parties' settlement.

Termination of this IPR is warranted to conserve resources of the Board, to conserve resources of the parties, and to promote a speedy and just resolution of the present IPR proceeding. The Board has recognized that "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding," and as such, the Board "expects" a proceeding to be terminated at the parties' request "unless the Board has already decided the merits of the proceeding." Consolidated Trial Practice Guide, November 2019, p. 86.

The parties have met the statutory requirement that they file a "joint request" to terminate before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall

be terminated upon such joint request "unless the Office has decided the merits of the proceeding before the request for termination is filed." There are no other preconditions recited in 35 U.S.C. § 317(a).

As mentioned above, the parties have reached a resolution to resolve the dispute in this proceeding. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the agreements made in connection with, or in contemplation of, the termination of the proceeding are in writing, and true and correct copies are being filed concurrently herewith. The parties certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

Termination would save significant further expenditure of resources by the parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further resolutions, as patent owners in similar situations would have a strong disincentive to resolve the dispute if they perceived that an *inter partes* review would continue regardless of a resolution.

III. CONCLUSION

Wilus and Samsung have settled the disputes in the above-captioned *inter partes* review relating to the Patent-at-Issue. The Board instituted trial on January 9, 2026, and has not decided the merits of this proceeding or entered a final written decision. Accordingly, Wilus and Samsung request that the Board terminate IPR2025-01164 in its entirety.

Dated: July 24, 2026

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on July 24, 2026, a complete and entire copy of this Joint Motion to Terminate Proceeding was provided via email, to Patent Owner by serving the email correspondence addresses of record as follows:

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