

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

NETLIST, INC.,

Patent Owner

IPR2025-01431
Patent 10,025,731

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW DUE TO
SETTLEMENT (POST INSTITUTION)**

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 & .74, Petitioner and Patent Owner jointly move to terminate this *Inter Partes* Review due to a settlement post institution but before any oral argument or Final Written Decision. In accordance with 37 C.F.R. § 42.20(b), this joint motion was authorized by the Board in its email dated August 18, 2026. Along with this joint motion to terminate, the parties are concurrently submitting a true copy of their confidential settlement agreement and collateral agreements as Exhibit 1136 along with a joint request to keep Exhibit 1136 confidential and separate from the file of the involved patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

II. ARGUMENT

“There are strong public policy reasons to favor settlement between the parties to a proceeding.” Trial Practice Guide § N, *available at* <https://www.uspto.gov/patents/ptab/trial-practice-guide#2NSettlement>. “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.” *Id.* (citing 35 U.S.C. §§ 317(a), 327).

The Board has not already decided the merits of this proceeding, and thus termination is appropriate pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, for at least the following reasons.

By filing this joint motion, the parties have complied with the requirement that they file a “joint request” to terminate this proceeding before “the Office has decided the merits of the proceeding,” and the parties agree that immediate termination is appropriate given that “no petitioner remains.” *See* 35 U.S.C. § 317(a) (“An 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. . . . If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).”); *see also Kokusai Elec. Corp. v. ASM IP Holding B.V.*, IPR2018-01151, Paper 38 (PTAB Aug. 20, 2019) (informative) (“Given the parties’ joint request, we must terminate the proceeding with respect to Petitioner unless we have decided the merits of the proceeding.”).

As shown by Exhibit 1136, the parties have also complied with the requirement that they file a “true copy” of their settlement agreement and “any collateral agreements . . . made in connection with, or in contemplation of, the termination” of this proceeding. *See* 35 U.S.C. § 317(b) (“Any agreement or

understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of the inter partes review as between the parties.”); 37 C.F.R. § 42.74(b) (“Any agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.”); *see also DTN, LLC v. Farms Tech., LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019) (precedential) (requiring filing of collateral agreements).

The parties certify, as requested by the Board’s email, that “there are no other agreements (other than those filed with the Board), oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.”

Concurrently with this motion, the parties are filing a joint request to keep Exhibit 1136 confidential and separate from the file of the involved patents pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

Finally, good cause exists for this joint motion to terminate this proceeding due to settlement because termination would save significant further expenditure of

resources by the parties and Board. Termination upon settlement, as requested, would also further the purpose of AIA proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Maintaining this proceeding, contrary to the joint request of the parties, would discourage future settlements by other parties, as patent owners in similar situations would have a strong disincentive to resolve the dispute if they perceived that an AIA proceeding would continue regardless of a settlement.

III. CONCLUSION

For the reasons above, Petitioner and Patent Owner jointly move to terminate this *Inter Partes* Review due to a settlement post institution but before any oral argument or Final Written Decision.

Dated: August 18, 2026

/ Richard M. Bemben /

Richard M. Bemben, Reg. #68,658
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1101 K Street NW, 10th Floor
Washington, DC 20005
T: (202) 772-8549
F: (202) 371-2540

Lead Counsel for Patent Owner
Netlist, Inc.

Dated: August 18, 2026

/Eliot D. Williams/

Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street NW
Washington, DC 20001
T: (202) 639-1334
F: (202) 639-1167

Lead Counsel for Petitioner
Samsung Electronics Co., Ltd.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 18th day of August, 2026, this **Joint Motion to Terminate *Inter Partes* Review Due to Settlement (Post Institution)** was served by email on the following counsel for Patent Owner:

Richard M. Bemben (Reg. No. 68,658) STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1101 K Street NW, 10th Floor Washington, DC 20005 Phone: (202) 772-8549 Fax: (202) 371-2540 Email: PTAB@sternekessler.com rbemben-PTAB@sternekessler.com	Jennifer Meyer Chagnon (Reg. No. 55,440) STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1101 K Street NW, 10th Floor Washington, DC 20005 Phone: (202) 772-8890 Fax: (202) 371-2540 Email: PTAB@sternekessler.com jchagnon-PTAB@sternekessler.com
Richard C. Kim (Reg. No. 40,046) NETLIST, INC. 111 Academy Way, Suite 100 Irvine, California 92617 Phone: (949) 679-0124 Email: PTAB@sternekessler.com rkim@netlist.com	Raymond K. Chan (Reg. No. 66,164) NETLIST, INC. 111 Academy Way, Suite 100 Irvine, California 92617 Phone: (949) 679-0101 Email: PTAB@sternekessler.com rchan@netlist.com
Francisco A. Rubio-Campos (Reg. No. 45,358) NETLIST, INC. 111 Academy Way, Suite 100 Irvine, California 92617 Phone: (949) 377-0296 Email: PTAB@sternekessler.com frubio@netlist.com	

Dated: August 18, 2026

/Eliot D. Williams/
Eliot D. Williams, Reg. #50,822
BAKER BOTTS L.L.P.
700 K Street NW
Washington, DC 20001
T: (202) 639-1334
F: (202) 639-1167

*Counsel for Petitioner Samsung
Electronics Co., Ltd.*