

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD. and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

INVENSAS CORPORATION,
Patent Owner.

Cases

IPR2018-01265 (Patent 6,054,336)
IPR2018-01266 (Patent 6,566,167 B1)
IPR2018-01267 (Patent 6,825,554 B2)¹

Before MICHAEL R. ZECHER, LYNNE E. PETTIGREW, and
JOHN D. HAMANN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION

Granting Parties' Joint Motions to Terminate Proceeding
37 C.F.R. §§ 42.71(a) and 42.74

¹ This Decision addresses an issue that is identical in all three cases. We, therefore, exercise our discretion to issue one Decision to be filed in each case.

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IPR2018-01266 (Patent 6,566,167 B1)
IPR2018-01267 (Patent 6,825,554 B2)

I. DISCUSSION

On December 13, 2018, the parties jointly filed the following documents in each proceeding identified above: (1) a Joint Motion to Terminate Proceeding (Case IPR2018-01265, Paper 8; Case IPR2018-01266, Paper 8; Case IPR2018-01267, Paper 8); (2) a true copy of the parties' settlement agreement (Case IPR2018-01265, Ex. 1012; Case IPR2018-01266, Ex. 1024; Case IPR2018-01267, Ex. 1024), along with a consent letter (Case IPR2018-01265, Ex. 1013; Case IPR2018-01266, Ex. 1025; Case IPR2018-01267, Ex. 1025); and (3) a joint request to treat both the settlement agreement and the consent letter as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Case IPR2018-01265, Paper 9; Case IPR2018-01266, Paper 9; Case IPR2018-01267, Paper 9).

These proceedings are still in their preliminary stages. Petitioner, Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc., filed a Petition in each proceeding requesting the following: (1) an *inter partes* review of claims 1–3 of U.S. Patent No. 6,054,336 (“the ’336 patent”) (Case IPR2018-01265, Paper 1); (2) an *inter partes* review of claims 1–12 of U.S. Patent No. 6,556,167 B1 (“the ’167 patent”) (Case IPR2018-01266, Paper 1); and (3) an *inter partes* review of claims 1–5 of U.S. Patent No. 6,825,554 B2 (“the ’554 patent”) (Case IPR2018-01267, Paper 1). Patent Owner, Invensas Corporation, filed a Preliminary Response in each proceeding (Case IPR2018-01265, Paper 7; Case IPR2018-01266, Paper 7; Case IPR2018-01267, Paper 7), but we have not issued a decision on institution.

In the Joint Motions to Terminate Proceeding, the parties represent that they have settled all their disputes regarding the ’336 patent, the ’167 patent, and the

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'554 patent. Case IPR2018-01265, Paper 8, 1; Case IPR2018-01266, Paper 8, 1, Case IPR2018-01267, Paper 8, 1. The parties also represent that all three patents were the subject of a district court case, captioned *Invensas Corporation v. Samsung Electronics, Co., Ltd.*, No. 2:17-cv-00670-RWS-RSP (E.D. Tex.), which the parties stipulated to dismiss with prejudice. Case IPR2018-01265, Paper 8, 1; Case IPR2018-01266, Paper 8, 1, Case IPR2018-01267, Paper 8, 1. Under these particular circumstances, we determine that it is appropriate to dismiss all three Petitions without rendering any further decisions, thereby terminating these proceedings. *See* 37 C.F.R. § 42.71(a).

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' requests to treat both the settlement agreement (Case IPR2018-01265, Ex. 1012; Case IPR2018-01266, Ex. 1024; Case IPR2018-01267, Ex. 1024) and the consent letter (Case IPR2018-01265, Ex. 1013; Case IPR2018-01266, Ex. 1025; Case IPR2018-01267, Ex. 1025) as business confidential information under 37 C.F.R. § 42.74(c) are *granted*; and

FURTHER ORDERED that the parties' Joint Motions to Terminate Proceeding are *granted*, and all three Petitions are dismissed resulting in termination of these proceedings.

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