

Entered: December 21, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

DIGITALOPTICS CORPORATION MEMS,
Patent Owner.

Case IPR2018-01806
U.S. Patent No. 7,697,829

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

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board's December 20, 2018 correspondence, Petitioner Samsung Electronics Co., Ltd. ("Petitioner") and Patent Owner DigitalOptics Corporation MEMS ("Patent Owner") (collectively, "the Parties") jointly request termination of the *inter partes* review of U.S. Patent No. 7,697,829 ("829 patent"), Case No. IPR2018-01806.

Pursuant to 37 C.F.R. §§ 42.5 and 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 Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (P.T.A.B. Oct. 24, 2018).

This proceeding is still in its preliminary stages. A Petition for *inter partes* review was filed on October 3, 2018 (Paper No. 1), and the Board has not yet issued a decision on institution. The Parties have settled their dispute and respectfully submit that termination is proper here.

The '829 patent was the subject of a District Court action in the Eastern District of Texas, Civil Action No. 2-17-cv-00669, entitled *FotoNation Ltd. v. Samsung Electronics Co., Ltd.*, which action is being dismissed concurrently with prejudice. Dismissal of the Petition here would promote efficiency and minimize unnecessary costs.

The Parties executed a Confidential Settlement Agreement to terminate this proceeding effective December 7, 2018. This agreement was made binding on

Patent Owner DigitalOptics Corporation MEMS by Consent Letter of the same date. Both the Settlement Agreement and a Consent Letter are submitted concurrently herewith. In accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b), also submitted concurrently herewith is a joint request that the Confidential Settlement Agreement and Consent Letter be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c). A true and correct copy of the Settlement Agreement and Consent Letter are submitted with that Request as Confidential Exhibits 2001 and 2002.

Petitioner and Patent Owner certify that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding. Both Petitioner and Patent Owner support termination of the proceeding.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board dismiss this proceeding in its entirety.

Respectfully submitted,

Dated: December 21, 2018

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 21st day of December, 2018, a copy of **Joint Motion to Terminate** was served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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