

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INNOLUX CORPORATION
Petitioner

v.

PATENT OF SEMICONDUCTOR ENERGY LABORATORY CO., LTD.
Patent Owner

CASE IPR2013-00038
PATENT 7,956,978

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Patent Owner and Petitioner jointly request termination of *Inter Partes* Review Case No. IPR2013-00038 with respect to Petitioner, Innolux Corporation. No other petitioners remain in the proceeding.

Patent Owner and Petitioner respectfully submit that termination is appropriate because they have reached an agreement resolving the dispute involving the patent at issue in the above-captioned *Inter Partes* Review and because it is before full briefing on the issues raised in *Inter Partes* Review Case No. IPR2013-00038, nor has there been any ruling by the Board on the trial. Further, Petitioner represents that it will no longer participate even if the Board does not terminate this review. That means Petitioner will file no further papers. It also will not be conducting any further cross examination of Patent Owner's witnesses and will not be participating in any oral argument.

As required under 35 U.S.C. §317(b) and 37 C.F.R. § 42.74(b), filed herewith is a true copy of the written confidential Settlement Agreement and Mutual Release resolving the dispute in the above captioned *Inter Partes* Review and the related litigation (the "Settlement Agreement"). *See* Settl. All parties to the action in the United States District Court for the Central District of California, which alleged infringement against Chimei Innolux Corporation, Chi Mei Optoelectronics USA, Inc., Acer America Corporation, ViewSonic Corporation,

VIZIO, Inc., and Westinghouse Digital, LLC (the “California litigation”) have agreed to the dismissal of the California litigation, and the Rule 41 Stipulation of Dismissal has been filed in the United States District Court for the Central District of California. *See* DISM. The California litigation is currently stayed pending the completion of *Inter Partes* Review Case No. IPR2013-00038 and *inter partes* review proceedings involving five other patents asserted in the California litigation. Also filed is a true copy of the written confidential Patent License Agreement Re: Liquid Crystal Display Devices (the “License Agreement”). *See* LIC. The Settlement Agreement and the License Agreement resolve entirely the dispute between Patent Owner and Petitioner relating to the patent at issue in the above-captioned *Inter Partes* Review and the other five patents asserted in the California litigation and the *inter partes* reviews involving all six patents asserted in that litigation. There is no other litigation in any court or forum involving the Patent Owner and the parties who are defendants in the California litigation or the patent at issue in the above-captioned *Inter Partes* Review.

Patent Owner and Petitioner are concurrently filing a Joint Request that the Settlement Agreement attached hereto as Settl and the License Agreement attached hereto as LIC shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to

Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c).

The parties jointly request termination of IPR2013-00038. Patent Owner believes no fee is due with this filing. If necessary, however, the Commissioner is hereby authorized in this, concurrent, and future filings, to charge payment or credit any overpayment to Deposit Account 15-0030, (Customer ID No. 22850).

Dated: December 4, 2013

Respectfully submitted,

/Scott A. McKeown/

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