

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINTEK CORPORATION
Petitioner,

v.

TPK TOUCH SOLUTIONS INC.
Patent Owner

Case IPR2013-00567, IPR2014-00541
U.S. Patent No. 8,217,902

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a), Petitioner Wintek Corporation and Patent Owner TPK Touch Solutions Inc. jointly request termination of IPR2013-00567 and IPR2014-00541 (which has been joined to IPR2013-00567), which are directed to U.S. Patent No. 8,217,902. The parties have settled their disputes insofar as they relate to U.S. Patent No. 8,217,902, and have reached agreement to terminate this *inter partes* review.

The parties have entered into a written Settlement Agreement, a true copy of which has been submitted as Exhibit No. 2029. The parties desire and jointly request that this Settlement Agreement be treated as confidential business information and that it be kept separate from the files of U.S. Patent No. 8,217,902 and this *inter partes* review proceeding in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties concurrently are filing a separate joint request to this effect.

Pursuant to the Settlement Agreement, the parties have resolved all litigations and proceedings relating to U.S. Patent No. 8,217,902, including *TPK Touch Solutions Inc. v. Wintek Corp.*, Civ. A. No. 3:13-CV-02218-VC (N.D. Cal.) (“California Action”). Specifically, pursuant to sections 1.6.1 and 7.1 of the Settlement Agreement, the parties have agreed to dismiss the California Action with prejudice. Patent Owner further represents that there are currently no other pending proceedings involving U.S. Patent No. 8,217,902, except for *ex parte*

reexamination Control No. 90/012,869, which is presently stayed and includes additional claims not affected by any *inter partes* review proceedings. Moreover, Patent Owner represents that it does not contemplate initiating any proceedings involving U.S. Patent No. 8,217,902 in the foreseeable future, either against Petitioner or any third party.

The parties respectfully submit that termination is appropriate because Patent Owner has agreed to license U.S. Patent No. 8,217,902 to Petitioner (*see* Settlement Agreement § 2.1), the parties have settled all disputes with respect to U.S. Patent No. 8,217,902 and the parties have agreed to terminate this *inter partes* review. No public interest or other factors militate against termination of this proceeding.

In view of the foregoing, the parties jointly and respectfully request that the instant proceeding be terminated.

Date: November 25, 2014

Respectfully submitted,

By: /Joseph E. Palys, Reg. No. 46508/
Joseph E. Palys, Reg. No. 46,508
Email: josephpalys@paulhastings.com
Naveen Modi, Reg. No. 46,224
Email: naveenmodi@paulhastings.com
PAUL HASTINGS LLP

*Attorneys for Petitioner –
Wintek Corporation*

Case Nos. IPR2013-00567, IPR2014-00541
Joint Motion To Terminate

/Joseph J. Richetti, Reg. No. 47024/
Joseph J. Richetti, Reg. No. 47,024
Email: joe.richetti@bryancave.com
BRYAN CAVE LLP

David Bilsker, Reg. No. 39,611
Email: davidbilsker@quinnemanuel.com
QUINN EMANUEL URQUHART &
SULLIVAN, LLP

*Attorneys for Patent Owner –
TPK Touch Solutions Inc.*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 was served electronically via e-mail on November 25, 2014, in its entirety on the following:

Joseph E. Palys
PAUL HASTINGS LLP
875 15th Street, N.W.
Washington, DC 20005
josephpalys@paulhastings.com

Naveen Modi
PAUL HASTINGS LLP
875 15th Street, N.W.
Washington, DC 20005
naveen.modi@paulhastings.com

Respectfully submitted,

By: /Joseph J. Richetti, Reg. No. 47024/
Joseph J. Richetti
Lead Attorney for Patent Owner
Reg. No. 47,024
BRYAN CAVE LLP
1290 Avenue of the Americas
New York, NY 10104
General Tel: (212) 541-2000
Direct Tel: (212) 541-1092
Fax: (212) 541-4630
Email: joe.richetti@bryancave.com

*Attorney for Patent Owner –
TPK Touch Solutions Inc.*

Date: November 25, 2014