

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJITSU NETWORK COMMUNICATIONS, INC.
Petitioner

v.

THOMAS SWAN & CO. LTD.
Patent Owner

Case IPR2014-01384
Patent 7,664,395

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

Pursuant to 35 U.S.C. § 317(a), the Patent Owner Thomas Swan & Co. Ltd. and Petitioner Fujitsu Network Communications, Inc. (“FNC”) (collectively “Parties”) hereby jointly move for an order terminating the *inter partes* review, subject to the terms of the Settlement Agreement, dated October 21, 2014, entered into by the Parties.

The IPR Proceeding relates to a petition for *inter partes* review filed August 26, 2014, directed to Patent No. 7,664,395 (the “395 Patent”), and assigned case number IPR2014-01384. This *inter partes* review has not been instituted.

The Parties have settled their dispute, and have reached agreement to terminate this IPR Proceeding. The Parties’ Settlement Agreement has been made in writing, and a true copy of same is being filed concurrently herewith as an Exhibit.

In addition, the Parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

As stated in 35 U.S.C. § 317(a), because Petitioner and Patent Owner jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

1. Reasons Why Termination Is Appropriate.

Termination is proper under 35 U.S.C. § 317(a) because the Parties are jointly requesting termination, and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” Indeed, this *inter partes* review has not been instituted. Petitioner filed its petition for *inter partes* review on August 26, 2014, and was accorded a filing date of August 26, 2014. Patent Owner’s Preliminary Response is not due until December 2, 2014, and therefore no decision on instituting a trial has been reached and there has not been any decision on the merits in this proceeding. No Motions are outstanding in this proceeding.

As noted in the Patent Office Trial Practice Guidelines, “there are strong public policy reasons to favor settlement between the parties to a proceeding 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. 35 U.S.C. 317(a), as amended, and 35 U.S.C. 327.”¹ Accordingly, termination is appropriate here.

¹ See Federal Register Vol. 77, No. 157 at 48768.

2. Status of Related District Court Litigation.

The '395 Patent is the subject of the following pending litigation: *Thomas Swan & Co. Ltd. v. Finisar Corp., et al.*, No. 2:13-cv-178 (E.D. Tex.). The defendants in that case are Petitioner FNC and Finisar Corp. ("Finisar")² (collectively, "Defendants").

On September 12, 2014, the Parties notified the District Court that the Parties and Finisar had reached an agreement that settles in principle all matters in controversy between them and jointly requested a stay of the case (and any and all attendant deadlines) for thirty (30) days to allow settlement obligations to be met. Such obligations include the drafting and executing a final written settlement agreement.

Consistent therewith, pursuant to the Settlement Agreement, the Parties and Finisar shall file with the District Court a stipulated motion and proposed order dismissing with prejudice all claims and counterclaims pending between Thomas

² On February 26, 2014, Finisar filed a separate petition for *inter partes* review for the '395 Patent, which was assigned Case No. IPR2014-00461. Pursuant to the Settlement Agreement, Thomas Swan and Finisar shall submit a joint motion to terminate this proceeding as well.

Swan & Co. Ltd. and Defendants in that case.

3. Related IPR Proceedings

The Parties are also involved in the following IPR proceedings, and pursuant to the Settlement Agreement, shall submit a joint motion to terminate each of these proceedings as well:³

Case No.	Filing Date	Subject Patent
IPR2014-01383	August 26, 2014	US 7,145,710
IPR2014-01381	August 26, 2014	US 8,335,033
IPR2014-01382	August 26, 2014	US 8,089,683

³ On February 26, 2014, Finisar also filed petitions for *inter-partes* review for these same patents, and the petitions have been assigned the following case numbers: IPR2014-00460, IPR2014-00465, and IPR2014-00462, respectively. Pursuant to the Settlement Agreement, Thomas Swan and Finisar shall submit a joint motion to terminate each of these proceedings as well.

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