

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SHARP CORPORATION, SHARP ELECTRONICS CORPORATION, and  
SHARP ELECTRONICS MANUFACTURING  
COMPANY OF AMERICA, INC.,  
Petitioner,

v.

SURPASS TECH INNOVATION LLC,  
Patent Owner.

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Case IPR2015-00913  
Patent No. 7,420,550 B2

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**JOINT MOTION TO TERMINATE PROCEEDING  
PURSUANT TO 35 U.S.C. § 317 AND  
TO TREAT SETTLEMENT AGREEMENT AS  
BUSINESS CONFIDENTIAL INFORMATION**

Pursuant to 35 U.S.C. § 317(a), Petitioners Sharp Corporation, Sharp Electronics Corporation, and Sharp Electronics Manufacturing Company of America, Inc. (collectively, “Sharp”) and Patent Owner Surpass Tech Innovation LLC (“Surpass”) jointly request termination, without prejudice or estoppel, of the *Inter Partes* Review of U.S. Patent No. 7,420,550, Case No. IPR2015-00913. The parties have been authorized by the Board, via email transmission, to file a joint motion to terminate this proceeding, and to move for the parties’ written settlement agreement to be treated as business confidential information pursuant to 35 U.S.C. § 317(b).

Sharp filed its petition for *Inter Partes* Review on March 20, 2015, and Surpass filed a preliminary response on July 1, 2015. The *Inter Partes* Review was subsequently instituted on September 9, 2015.

The parties have settled their dispute and have reached agreement to terminate this *Inter Partes* Review prior to the filing of a Patent Owner Response. Termination of this proceeding is proper at this stage because (a) the Board has not decided the merits of this proceeding, (b) upon termination of Petitioners’ involvement, no petitioner will remain in this proceeding, and (c) the parties are making this joint request under 35 U.S.C. § 317(a). For at least these reasons, termination of the *Inter Partes* Review is appropriate under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a). The ‘550 Patent is also subject to pending *Inter Partes*

Review Case No. IPR2015-00887, which is not affected by the Settlement Agreement between Sharp and Surpass.

In addition, The Office Patent Trial Practice Guide indicates that:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the 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. Office Patent Trial Practice Guide (Section II (N)).

The Settlement Agreement between Sharp and Surpass has been made in writing, and a true and correct copy as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) is being submitted concurrently herewith as Exhibit 2004. Sharp and Surpass request that this Settlement Agreement (Ex. 2004) be treated as **“business confidential information”** and be kept separate from the file of the involved patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties jointly request that the Settlement Agreement (Ex. 2004) be made available only to Federal Government agencies on written request or to any person only on a showing of good cause.

The ‘550 Patent is also the subject of litigation in the U.S. District Court for the District of Delaware, *Surpass Tech Innovation LLC v. Sharp Corporation et al.*

(Civil Action No. 1:14-cv-00338-LPS) (“the ‘338 Case”). In addition to Petitioners, the defendants in the ‘338 case include Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Sony Corporation, Sony Electronics Inc., Sony Corporation of America, Vizio, Inc (Del. Corp.), and Vizio, Inc. (Cal. Corp.). The District Court stayed the ‘338 Case on November 21, 2014. Petitioners and Patent Owner have settled the ‘338 Case with respect to all of the claims and counterclaims involving the ‘550 Patent, under the Settlement Agreement between Petitioners and Patent Owner. All of the parties to the ‘338 case jointly stipulated to the dismissal of all allegations relating to the ‘550 Patent in the ‘338 case. *See* JOINT STIPULATION FOR PARTIAL DISMISSAL OF CERTAIN CLAIMS AND COUNTERCLAIMS (D.I. 60, filed January 14, 2016) (Ex. 2005). On January 19, 2016, the Delaware district court entered the joint stipulation. Accordingly, the ‘550 Patent is no longer at issue in the ‘338 case.

The ‘550 Patent is also the subject of another litigation in the U.S. District Court for the District of Delaware, *Surpass Tech Innovation LLC v. Samsung Display Co., Ltd. et al.* (Civil Action No. 1:14-cv-00337-LPS) (“the ‘337 Case”). The defendants in the ‘337 Case are Samsung Display Co., Ltd., Samsung Electronics co., Ltd., Samsung Electronics America, Inc., Sony Corporation, Sony Electronics Inc., and Sony Corporation of America. The District Court also stayed the ‘337 Case on November 21, 2014. The ‘337 Case does not involve Petitioners

and is not affected by the Settlement Agreement between Petitioners and Patent Owner in this IPR proceeding.

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