

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,

Petitioner

v.

MEMJET TECHNOLOGY LIMITED,

Patent Owner

Inter Partes Review No. 2016-00537

Patent No. 7,156,492

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner HP Inc. (formerly known as Hewlett-Packard Company) (“HP”) and Patent Owner Memjet Technology Limited (collectively, “the Parties”) hereby jointly request termination of the instant proceeding pursuant to 37 C.F.R. §§ 42.5(a), 42.71(a), and 42.72.

The Board authorized the Parties to file this motion in a telephone conference on July 1, 2016.

Termination of this proceeding is proper. As the Office Patent Trial Practice Guide recognizes, “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.” 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In this case, the parties have settled their disputes relating to U.S. Patent No. 7,156,492 (“the ’492 patent”), the review of which forms the basis for this proceeding. The Board has not decided whether to institute *Inter Partes* Review. As such, termination of the proceeding at this early stage will conserve the Board’s resources. Therefore, it is respectfully submitted that the Board should exercise its authority under 37 C.F.R. §§ 42.5(a), 42.71(a) and 42.72 and terminate this proceeding.

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Settlement is in writing, and a true copy of the Settlement is submitted as Exhibit 1013. The Parties’ are separately moving, pursuant to 37 C.F.R. § 42.74(c), to have the Settlement treated as business confidential information. In the event that a third party submits a

written request to the Board for a copy of the settlement agreement (Exhibit 1013) along with a purported showing of good cause, due to the highly sensitive nature of the agreement, the Parties would like to be notified of such request and be given the opportunity to respond thereto.

In addition to an explanation as to why termination is proper, the Board has, in some instances, required the Parties to identify all parties in any related litigation involving the patent at issue, identify any related proceedings currently before the Office, and discuss the status of each such related litigation or proceeding. *See, e.g.*, IPR2014-00018, Paper 26 at 2 (July 28, 2014). The Parties provide this information below.

The '492 patent was subject of litigation in the Southern District of California, captioned *Memjet Technology Limited v. Hewlett-Packard Company*, Case No. 3:15-cv-01769-BEN-BLM. The Parties to that action were Memjet Technology Limited, Memjet Ltd., Memjet US Services, Inc., Memjet Holdings Ltd., and HP Inc. (formerly known as Hewlett-Packard Company). That action is also subject of the Parties' Settlement, and the Parties will soon move the Court to dismiss the action. There are no other pending proceedings between the Parties involving the '492 patent.

The '492 patent is also subject of IPR2016-00873. In addition, the Parties' Settlement extends to the following United States Patents that are the subject of

pending IPR proceedings:

1. IPR2016-00746 (6,575,549)
2. IPR2016-00752 (6,880,914)
3. IPR2016-00790 (8,678,550)
4. IPR2016-00791 (8,678,550)
5. IPR2016-00839 (8,696,096)
6. IPR2016-00867 (8,662,636)
7. IPR2016-00869 (8,662,636)
8. IPR2016-00913 (7,325,986)

Concurrent with this motion, the Parties are filing motions to terminate in the above-identified proceedings.

Respectfully submitted,

Date: July 6, 2016

/Dion M. Bregman/
Dion M. Bregman
USPTO Reg. No. 45,645
MORGAN, LEWIS & BOCKIUS LLP
1400 Page Mill Road
Palo Alto, CA 94304
Telephone: 650.843.4000
Fax: 650.843.4001
Email: dion.bregman@morganlewis.com

Attorneys for Petitioner
HP INC.

Date: July 6, 2016

/James M. Glass/
James M. Glass
USPTO Reg. No. 46,729
QUINN EMANUEL URQUHART &
SULLIVAN LLP
51 Madison Ave, 22nd Fl.
New York, NY 10010
Telephone: (212) 849-7000
Fax: (212) 849-7100
Email: jimglass@quinnemanuel.com

Attorneys for Patent Owner
MEMJET TECHNOLOGY LIMITED

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.