

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. 2016-00873

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 1009. 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 1009) 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 IPR2016-00537. 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

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