

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC.; CANON USA, INC.;
CANON FINANCIAL SERVICES, INC.; FUJIFILM CORPORATION;
FUJIFILM HOLDINGS AMERICA CORPORATION;
FUJIFILM NORTH AMERICA CORPORATION; JVC KENWOOD
CORPORATION; JVCKENWOOD USA CORPORATION;
NIKON CORPORATION; NIKON INC.; OLYMPUS CORPORATION;
OLYMPUS AMERICA INC.; PANASONIC CORPORATION;
PANASONIC CORPORATION OF NORTH AMERICA;
SAMSUNG ELECTRONICS CO., LTD.;
SAMSUNG ELECTRONICS AMERICA, INC.; AND LG ELECTRONICS, INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG
Patent Owner.

Case IPR2016-01211¹
Patent 8,504,746

**JOINT MOTION TO TERMINATE
WITH RESPECT TO LG ELECTRONICS, INC.
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

¹ Case IPR2017-00678, filed by LG Electronics, Inc., and Case IPR2017-00710, filed by Huawei Device Co., Ltd., have been joined with this proceeding.

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of November 28, 2017, Petitioner LG Electronics, Inc. ("LG") and Patent Owner Papst Licensing GmbH & Co. KG ("Patent Owner" or "Papst") jointly move to terminate the present *inter partes* review proceeding with respect to LG in light of Patent Owner and LG's settlement of their dispute regarding U.S. Patent No. 8,504,746 ("the '746 patent").

LG and Patent Owner are concurrently filing a true and complete copy of their written Settlement Agreement (Confidential Exhibit 2013) in connection with this matter as required by the statute. LG and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding with respect to LG. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

LEGAL STANDARD

An *inter partes* review proceeding “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014).

ARGUMENT

Termination of the present *inter partes* review proceeding with respect to LG is appropriate because (1) LG and Patent Owner have settled their dispute regarding the '746 patent and have agreed to terminate the proceeding with respect to LG, (2) the Office has not yet decided the merits of the proceeding, (3) the termination with respect to LG will not materially affect the proceeding, and (4) public policy favors the termination.

First, the Settlement Agreement completely resolves the controversy between Patent Owner and LG relating to the '746 patent. LG Electronics USA,

Inc., and LG Electronics Mobilecomm USA, Inc., which are two of the real parties in interest in the present proceeding, were named defendants in *Papst Licensing GmbH & Co. KG v. Apple Inc.*, No. 6:15-cv-1095-RWS (E.D. Tex) and the consolidated case *Papst Licensing GmbH & Co. KG v. LG Electronics, Inc.*, No. 6:15-cv-1099-RWS (E.D. Tex.). On November 27, 2017, the district court granted the parties' Joint Motion to Dismiss, dismissing all the claims asserted by Papst against the LG entities, and all counterclaims asserted by the LG entities against Papst, with prejudice. *Papst Licensing v. Apple Inc.*, 6:15-cv-1095-RWS (E.D. Tex.) (Dkt. No. 674).

Second, although the Board has instituted trial (Paper 11) and held an oral hearing, the Office has not decided the merits of the proceeding.

Third, the termination with respect to LG will not materially affect the proceeding. LG originally filed a separate petition for *inter partes* review. IPR2017-00678, Paper 1. On January 13, 2017, LG filed a motion requesting that its petition be instituted and the proceeding joined with this proceeding. IPR2017-00678, Paper 3. In its Motion for Joinder, LG agreed:

to incorporate its filings with those of the Canon Petitioners into a consolidated filing in the Canon IPR, unless the filing involves an issue unique to LG or states a point of disagreement related to the consolidated filing. In such circumstances, LG proposes to make a separate filing of no more than five pages.

Id. at 13. LG further agreed “to take a subordinate ‘understudy’ role in discovery.” *Id.* To date, LG has not identified any issues unique to LG, has not had any disagreement related to any consolidated filing, and has not made any separate filings. Because of LG’s subordinate role, this termination will not impact the proceedings. The proceeding is therefore expected to continue with the remaining petitioners.

Fourth, public policy favors the termination. As recognized by the rules of practice before the Board:

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.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding with respect to LG.

As to the remaining *Heartland Tanning* requirements, Exhibit A identifies each district court litigation that involves the ’746 patent or any related patents and discusses the current status of these related litigations. Exhibit B identifies all petitions for *Inter Partes* Review that have been filed against the ’746 patent or any related patent and discusses the status of each.

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