

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**  

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ZTE (USA) Inc., OLYMPUS CORPORATION  
AND OLYMPUS AMERICA, INC.

Petitioners,

v.

Papst Licensing GmbH & Co. KG

Patent Owner.

Case No. IPR2017-00443<sup>1</sup>  
Patent No. 6,470,399 B1

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

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<sup>1</sup> Case IPR2017-01682 has 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 December 22, 2017, Petitioner Olympus Corporation and Olympus America, Inc. (collectively, "Olympus") 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 Olympus in light of Patent Owner and Olympus' settlement of their disputes.

Olympus and Patent Owner are concurrently filing a true and complete copy of their written Settlement Agreement (Confidential Exhibit 2012) in connection with this matter as required by statute. Olympus 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 Olympus. 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 Olympus is appropriate because (1) Olympus and Patent Owner have settled their disputes and have agreed to terminate the proceeding with respect to Olympus, (2) the Office has not yet decided the merits of the proceeding, (3) the proceeding is expected to continue with Petitioner ZTE (USA), Inc. (“ZTE”), and (4) public policy favors the termination.

*First*, the Settlement Agreement completely resolves the controversy between Patent Owner and Olympus relating to the '399 patent. Olympus

Corporation and Olympus America, Inc., which are two of the real parties in interest in the present proceeding, were named defendants in *Papst Licensing GmbH & Co., KG v. Olympus Corporation, et al.*, Case No. 1:15-cv-01749 (D.D.C.), *Papst Licensing GmbH & Co., KG v. Olympus Corporation, et al.*, Case No. 1:15-cv-00500 (D. Del.) and *Papst Licensing GmbH & Co. Kg v. Olympus Corp.*, Case No. 1:07-cv-02086 (D. Del.). On December 21, 2017, Olympus and Papst filed a motion requesting that all claims against the Olympus entities and all counterclaims by the Olympus entities be dismissed with prejudice.

*Second*, the Office has not decided the merits of the proceeding. Although the Board has instituted trial (Paper 7), the proceeding is still in the briefing stage and there is no determination of whether an oral hearing will occur.

*Third*, Olympus has joined in this IPR proceeding and ZTE is the remaining Petitioner (ZTE has also reached a settlement in principle with Patent Owner). ZTE is not a party to the Settlement Agreement and the parties have not requested that the proceeding be terminated with respect to ZTE. This termination will not impact petitioner ZTE and the proceeding is therefore expected to continue with ZTE as a petitioner (until such time as ZTE finalizes its settlement with Patent Owner).

*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 Olympus.

As to the remaining *Heartland Tanning* requirements, Exhibit A identifies each district court litigation that involves the '399 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 '399 patent or any related patent and discusses the status of each.

### **CONCLUSION**

For the foregoing reasons, Olympus and Patent Owner jointly and respectfully request that the instant proceeding be terminated with respect to Olympus.

Date: December 27, 2017

Respectfully submitted,

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