

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ZTE (USA) INC., ZTE CORPORATION,  
OLYMPUS CORPORATION; OLYMPUS AMERICA INC.,  
SAMSUNG ELECTRONICS CO., LTD., AND  
SAMSUNG ELECTRONICS AMERICA, INC.,  
Petitioners,

v.

PAPST LICENSING GMBH & CO. KG  
Patent Owner.

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Case IPR2017-00714<sup>1</sup>  
Patent 6,470,399

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

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization of January 3, 2018, Petitioners Olympus Corporation and Olympus America Inc. (collectively, "Olympus") and Patent Owner Papst Licensing GmbH

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<sup>1</sup> Case IPR2017-01808 has been joined with this proceeding.

& 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’s settlement of their disputes.

Olympus and Patent Owner are concurrently filing a true and complete copy of their written Settlement Agreement (Confidential Exhibit 2007) 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 termination with respect to Olympus 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 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. 1:07-cv-00415 (D. Del.) and *Papst Licensing GmbH & Co. Kg v. Olympus Corp.*, Case No. 1:07-cv-02086 (D. Del.), which were consolidated into *In re: Papst Licensing Digital Camera Patent Litigation MDL 1880*, Case No. 1:07-mc-493-RDM) (D.D.C.). The parties have filed a joint stipulation requesting dismissal of the district court cases.

*Second*, although the Board has instituted trial (Paper 16), the Office has not decided the merits of the proceeding.

*Third*, the termination with respect to Olympus will not materially affect the proceeding. Olympus originally filed a separate petition for *inter partes* review. IPR2017-01808, Paper 3. On July 20, 2017, Olympus filed a motion requesting that its petition be instituted and the proceeding joined with this proceeding. IPR2017-01808, Paper 4. In its Motion for Joinder, Olympus agreed “to adhere to all applicable deadlines set forth in the ZTE IPR [2017-00714]” and “to adopt any papers submitted by ZTE in the joined IPR proceeding.” *Id.* at 7. Olympus further stated:

Petitioner intends to maintain a passive understudy role in the joined proceeding. Petitioner will assume a primary role only if ZTE ceases to participate in the IPR, or to the extent ZTE willingly seeks more prominent participation from Petitioner’s counsel. These concessions by Petitioner remove any potential “complication or delay” in connection with joinder, while providing the parties an opportunity to

address all issues that may arise and avoiding any undue burden on Papst, ZTE, and the Board.

*Id.* at 8-9. Moreover, Olympus's co-petitioner Samsung will remain a petitioner in this proceeding. To date, Olympus has not identified any issues unique to Olympus, has not had any disagreement related to any consolidated filing, and has not made any separate filings. Because of Olympus'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 '399 patent or any related patents and discusses the current status of these related litigations. Exhibit B identifies all

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