

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL MULTIMEDIA TECHNOLOGY HOLDINGS, LTD.

and

TTE TECHNOLOGY, INC.,

Petitioners,

v.

NICHIA CORPORATION,

Patent Owner.

Case IPR2017-02000

Patent No. 7,915,631 B2

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Patent Owner Nichia Corporation (“Patent Owner”) and Petitioners TCL Multimedia Technology Holdings, Ltd. and TTE Technology, Inc. (“Petitioners”) jointly move the Patent Trial and Appeal Board (“Board”) to terminate the following *inter partes* review proceeding in its entirety:

| IPR Case No. | Patent No. |
|---------------------|-------------------|
| IPR2017-02000 | 7,915,631 |

The parties notified the Board of the parties’ settlement by email correspondence dated February 22, 2018, and received authorization to file this Motion to Terminate by order dated February 26, 2018. Pap. 8. In support of the Motion to Terminate Proceeding, the parties state as follows:

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner have separately filed herewith a true copy (including counterparts) of the confidential settlement agreement and the purchase agreement. Because the settlement agreement and purchase agreement are confidential, the parties respectfully request that they be treated as business confidential information, be kept separate from the underlying patent file, and be made available only as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and have filed herewith a separate paper setting forth this request.

The statutory provision on a settlement relating to *inter partes* reviews provides that an *inter partes* review “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. It also provides that, “[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a).” *Id.*

This proceeding is in the preliminary stage. This *inter partes* review has not been instituted. Petitioner filed its petition for *inter partes* review on August 25, 2017, and Patent Owner filed a preliminary response on February 9, 2018. The parties have settled their dispute and have agreed to file a stipulated dismissal in the district court litigation in which U.S. Patent No. 7,915,631 had been asserted (Case No. 1:16-cv-00681 (RGA) (D. Del.)). The parties also agreed to terminate this *inter partes* review as well as other *inter partes* review proceedings concerning related patents that had been asserted in that litigation, namely IPR2017-01998, -01999, -02001, and are simultaneously filing corresponding motions in those proceedings.¹

¹ Patent Owner notes that an IPR petition filed by different petitioners challenging claims of U.S. Patent No. 7,15,631 is still pending. *See Lowe’s Companies, Inc. et*

As noted above, the parties' settlement agreement and purchase agreement have been made in writing, and true and correct copies shall be filed with this Office as business confidential information pursuant to 35 U.S.C. § 317(b).

Because the Board has not decided the merits of this *inter partes* review proceeding, Section 317 provides that the proceeding should be terminated with respect to Petitioners. Moreover, because TCL Multimedia Technology Holdings, Ltd. and TTE Technology, Inc. are the only petitioners in the proceeding, once the proceeding is terminated with respect to them, no petitioner will remain in the *inter partes* review, and the Office may terminate the review in its entirety under Section 317. Patent Owner and Petitioners jointly submit that the Board should do so.

Because this proceeding has not yet been instituted and Patent Owner only just filed its preliminary response on February 9, 2018, termination would save significant expenditure of resources by the Board and would further the purpose of IPR proceedings to provide an efficient and less costly alternative forum for patent disputes (including by encouraging settlement). The Board has routinely terminated proceedings at the request of settling parties in cases that have progressed much further than the present proceeding, *see, e.g., Apex Medical Corp. al. v. Nichia Corporation*, IPR2018-00066. Patent Owner filed its preliminary response to that petition on January 26, 2018.

v. *Resmed Ltd.*, IPR2013-00512, Pap. 39, at 24 (Sept. 12, 2014) (granting motion to terminate in its entirety notwithstanding that instituted proceeding was fully briefed); *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00018, Pap. 52, at 2 (June 17, 2014) (granting motion to terminate instituted proceeding in its entirety after final oral hearing); see also *ARM, Ltd. v. Godo Kaisha IP Bridge 1*, IPR2017-00527, Pap. 10, at 2-3 (May 12, 2017) (granting motion to terminate in its entirety after preliminary response but prior to institution). The parties respectfully request that the Board terminate this *inter partes* review proceeding in its entirety. Indeed, the Board has stated an *expectation* that proceedings such as this one will be terminated after the filing of a settlement agreement: “[t]here are strong public policy reasons to favor settlement between the parties to a 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. 35 U.S.C. § 317(a), as amended. . . .” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (emphasis added). For at least the reasons noted above, the Board’s expectation that such proceedings should be terminated is proper and well justified here.

III. CONCLUSION

Wherefore, Patent Owner and Petitioners respectfully request that the Board grant the parties’ Joint Motion to Terminate Case Number IPR2017-02000 in its

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.