

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sony Corporation
Petitioner

v.

FUJIFILM Corporation
Patent Owner

Case IPR2018-00877
U.S. Patent No. 6,462,905

**JOINT MOTION TO TERMINATE PROCEEDING UNDER 35 U.S.C §327
AND JOINT REQUEST TO KEEP PAPERS SEPARATE AS BUSINESS
CONFIDENTIAL INFORMATION**

I. RELIEF REQUESTED

In accordance with 35 U.S.C. § 327, Sony Corporation (“Petitioner”) and FUJIFILM Corporation (“Patent Owner”) (collectively, the “Parties”), jointly file this motion requesting termination of Inter Partes Review No. IPR2018-00877 (“IPR Proceeding”) in its entirety. The Parties additionally request that the Parties’ settlement agreement be treated in its entirety as Business Confidential Information and be kept separate from the files of U.S. Patent No. 6,462,905 (the “’905 patent”) pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The IPR Proceeding was filed on March 30, 2018 as a petition for inter partes review of the ’905 patent. The IPR Proceeding was instituted on October 9, 2018

Sony and FUJIFILM reached an agreement to terminate this IPR Proceeding and entered into a Worldwide Resolution Agreement and Patent Cross-License (the “Agreement”). The Agreement has been made in writing, and a true copy of the same is attached as Exhibit A.¹ There are no additional collateral agreements or undertakings made in connection with, or in contemplation of, termination of this proceeding.

¹ As set forth below, the Settlement Agreement is being filed electronically via the PTAB’s E2E System as “Parties and Board Only” and the Parties request it be treated as business confidential information.

II. REASONS WHY TERMINATION IS PROPER

Termination is appropriate under 35 U.S.C. § 327(a) because the Parties are jointly requesting termination, and the Office has not “decided the merits of the proceeding before the request for termination [wa]s filed.” 35 U.S.C. § 327(a). In this IPR Proceeding, oral arguments were heard on June 21, 2019 and no decision on the merits has been made. Further, the Patent Office Trial Practice Guidelines provide that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding,” and “[t]he 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.” Federal Register Vol. 77, No. 157, p. 48768. As no decision on the merits has been made in this IPR Proceeding, the strong public policy favoring settlement supports termination here.

III. IDENTIFICATION OF RELATED PROCEEDINGS

The '905 patent is subject to the following related proceedings between the Parties:

- *Sony Corp. v. Fujifilm Corp.*, IPR No. 2018-00876 (filed March 30, 2018)
- *Certain Magnetic Data Storage Tapes and Cartridges Containing the Same*, 337-TA-1076 (USITC Sept. 19, 2017);
- *Fujifilm Corp. v. Sony Corp.*, 1-17-cv-01309 (D. Del. 2017).

With respect to the related IPR proceeding, the Board has instituted trial on IPR No. 2018-00876 and heard oral arguments on June 21, 2019 along with oral arguments in this IPR Proceeding. The parties are in the process of jointly seeking

to rescind the remedial orders issued in the related ITC investigation and to dismiss the related district court proceeding.

Based on the foregoing, the Parties jointly request termination of Inter Partes Review No. IPR2018-00877.

IV. REQUEST TO TREAT SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION

The Parties hereby jointly request that the Agreement filed herewith as Exhibit A be treated as business confidential information, be kept separate from the file of the above captioned IPR, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c). In view of that request, the Agreement has been filed for access by the “Parties and Board Only.”

Respectfully submitted,

BAKER BOTTS L.L.P.

Date: July 24, 2019

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