

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLYMPUS CORPORATION, OLYMPUS CORPORATION OF THE
AMERICAS, and OLYMPUS AMERICA INC.,
Petitioners,

v.

MAXELL LTD.,
Patent Owner.

Case: IPR2018-00904

U.S. Patent No. 8,339,493

**PETITIONER'S AUTHORIZED UNOPPOSED MOTION TO DISMISS
PROCEEDING WITH PREJUDICE**

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

December 18, 2018

I. INTRODUCTION

Pursuant to the Board's authorization via email on November 21, 2018 and conference call on November 30, 2018, Petitioners Olympus Corporation, Olympus Corporation of the Americas, and Olympus America Inc. (hereinafter "Petitioner") file this motion to dismiss this proceeding with prejudice.¹

This proceeding is in its preliminary phase and is well-suited for dismissal. Patent Owner, Maxell, Ltd. ("Maxell"), has filed a Preliminary Response, but the Board has yet to reach the merits and issue a decision on institution. Petitioner respectfully requests that the Board dismiss IPR2018-00904 with prejudice to preserve the Board's and parties' resources and to achieve a just, speedy, and inexpensive resolution to this dispute. Patent Owner has indicated that it does not oppose this motion.

II. BACKGROUND AND PROCEDURAL HISTORY

This is one of several IPR proceedings involving patents in Maxell's patent portfolio. This petition was filed on June 20, 2018. Patent Owner timely filed its Preliminary Response on November 9, 2018. The Petition is currently pending before the Board. The parties have resolved their dispute as to U.S. Patent No.

¹ Substantively identical motions are being filed in all pending proceedings between Olympus and Maxell: IPR2018-00904, IPR2018-00906, IPR2018-00908, IPR2018-00909, IPR2018-00910, and IPR2018-00911.

8,339,493, the patent challenged in the instant proceeding, as well as all other patents in IPR proceedings between Olympus and Maxell, as evidenced by the settlement agreement submitted herewith pursuant to 37 C.F.R. § 42.74(b).²

III. ARGUMENT

Good cause exists to dismiss Petitioner's petition in IPR2018-00904. Dismissal would preserve the Board's and the parties' resources, and would expeditiously resolve Petitioner's request, furthering the purpose of IPR challenges. 37 C.F.R. §42.1(b). This proceeding is in its preliminary stage as the Board has not yet reached the merits or issued a decision on institution. Patent Owner would not be prejudiced by dismissal—especially where Petitioner is requesting to dismiss the proceeding with prejudice.

The Board “may terminate a trial without rendering a final written decision, where appropriate.” 37 C.F.R. §42.72. Further, the rules governing IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Id.* §42.1(b). In determining whether dismissal is

² Submitted concurrently herewith is a request by Petitioner and Patent Owner that the settlement agreement be treated as business confidential information, be kept separate from the file of the involved patent, 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. § 317(b) and 37 C.F.R. § 42.74(c).

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“appropriate,” the Board primarily examines the stage and nature of the proceedings. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, Case IPR2015-01270, Paper 12 at 3 (PTAB Dec. 9, 2015).

Proceedings that are in their preliminary proceeding stages—*i.e.*, before the Board issues an institution decision—are well-suited for dismissal. *See id.* (granting opposed motion to terminate proceeding during the preliminary proceeding stage of underlying IPR proceeding); *HTC Corp. v. Patentmarks Commc'ns, LLC*, Case IPR2014-00907, Paper 7 at 3 (PTAB Aug. 26, 2014) (granting unopposed motion to terminate noting that a “decision on the Petition . . . has not yet been rendered. Under these circumstances, we determine that it is appropriate . . . to terminate this proceed without rendering a final written decision.”). As acknowledged by the Board in its November 21, 2018 email and November 30, 2018 conference call, as this proceeding is in the preliminary phase dismissal would be proper.

Dismissing this proceeding would further the purpose of *inter partes* review proceedings by justly and expeditiously resolving this dispute without subjecting the Board and the parties to unnecessary expense in taking the proceeding through trial. The parties will incur substantial expense in preparing and presenting expert declarants for depositions, submitting substantive briefs and motions, and presenting at an oral hearing. The Board will also likely have to expend a

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significant amount of resources if it declines to dismiss the proceeding. As an example, the Board would likely be requested to address various procedural disputes, preside over an oral hearing, and draft a substantive decision on institution and a final written decision on the merits. These resources and obligations can be spared by dismissing the proceeding.

As stated in 35 U.S.C. § 317(a) and 37 C.F.R. § 42.73(d), because Petitioner and Patent Owner jointly request this dismissal, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

IV. CONCLUSION

For all the reasons stated above, Petitioner respectfully requests that the Board dismiss the underlying Petition in IPR2018-00904 with prejudice.

Dated: December 18, 2018

Respectfully submitted,

/Matthew J. Moffa/

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