

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.
Petitioner

v.

NICHIA CORPORATION,
Patent Owner

Case IPR2018-01100
Patent 7,915,631 B2

Before BRIAN J. McNAMARA, STACEY G. WHITE and
NABEEL U. KHAN, *Administrative Patent Judges*

KHAN, *Administrative Patent Judge.*

ORDER AUTHORIZING FILING OF JOINT MOTION TO DISMISS
Conduct of the Proceeding
37 C.F.R. § 42.5

On May 16, 2018 Vizio, Inc., filed a Petition requesting *inter partes* review of U.S. Patent No. 7,915,631 B2 (“the ’631 Patent”). Paper 2. In e-mail correspondence on June 12, 2018, the parties requested “leave to file a joint motion to terminate this proceeding (IPR2018-01100) in its entirety.” The parties informed the Board that the sole independent claim of the ’631 Patent has been found indefinite in federal district court litigation and in light of that development, they would like to terminate this proceeding to conserve both the Board’s and the parties’ resources.

This matter is in its preliminary stages. Patent Owner has not filed a Patent Owner Preliminary Response, and we have not yet rendered a decision whether to institute a trial. Because we have not instituted review, there is no *inter partes* review proceeding to terminate. *See* 35 U.S.C. § 317 (applying to “[a]n inter partes review instituted under this chapter”). At this early stage of the proceeding it may be appropriate, instead, to dismiss the Petition under 37 C.F.R. § 42.71(a) and/or § 42.74.

Accordingly, the parties are authorized to file a Joint Motion to Dismiss. The Joint Motion to Dismiss must update the Board concerning the status of any litigation or proceeding, including, but not limited to proceedings in the U.S. Patent and Trademark Office involving the ’631 patent, and advise the Board whether any litigation or proceeding involving the ’631 patent is contemplated in the foreseeable future.

The Joint Motion to Dismiss also must include a copy of any agreement including any collateral agreements referred to in such agreement or understanding made in connection with, or in contemplation of the termination of the proceeding or include a statement certifying that there are no such collateral agreements or understandings. A party to a settlement

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may request that any written agreement be treated as business confidential information and be kept separate from the files of an involved patent. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). The request must be filed with the settlement. *Id.*

It is **ORDERED** that the parties are authorized to file a Joint Motion to Dismiss.

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