

Case No. IPR2018-01100
Patent 7,915,631

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

NICHIA CORPORATION,
Patent Owner.

Case No. IPR2018-01100
Patent 7,915,631

**JOINT MOTION TO DISMISS PROCEEDINGS
UNDER 37 C.F.R. §§ 42.71(a) and 42.74**

Pursuant to 37 C.F.R. §§ 42.71(a) and 42.74, Petitioner VIZIO, Inc. (“VIZIO”) and Patent Owner Nichia Corporation (“Nichia”) respectfully request dismissal of IPR2018-01100 in its entirety.

The Board authorized this Motion by order dated June 26, 2018. Pap. 8.

BASIS FOR DISMISSAL

On May 29, 2018, a federal district court issued a claim construction order that held that a claim term in claim 1, the sole independent claim, of the '631 patent is indefinite. In view of that development, Petitioner believes that the dismissal of these proceedings would conserve both the Board's and the parties' resources. Patent Owner agrees to dismiss these proceedings, and that doing so would conserve resources, but reserves all rights with respect to that claim construction order.

Petitioner and Patent Owner certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the parties' joint request to dismiss the proceeding.

Dismissal is appropriate here. This proceeding is in the preliminary stage. This *inter partes* review has not been instituted. Petitioner filed its petition for *inter partes* review on May 24, 2018, and, although Petitioner has requested the Board accelerate the deadline for Patent Owner's preliminary response, the Board has not granted that request and Patent Owner's preliminary response is currently

not due until August 23, 2018. Accordingly, dismissal would promote efficiency and minimize unnecessary costs to the parties and to the Board. Because the Board has not decided the merits of this *inter partes* review proceeding, and due to the early stage of the proceeding, Patent Owner and Petitioner jointly submit that the Board should dismiss this proceeding in its entirety. *See, e.g., Samsung Elec. Co. LTD v. NVIDIA Corp.*, IPR2015-01270, Pap. 12 at 3-4 (Dec. 9, 2015) (exercising discretion to dismiss the petition at an “early juncture, to promote efficiency and minimize unnecessary costs”).

STATUS OF RELATED DISTRICT COURT ACTIONS

***Nichia/VIZIO* Litigation.** As discussed above, on May 29, 2018, in a litigation between the parties here, a federal district court issued a claim construction order finding indefinite a claim term recited in the sole independent claim of the '631 patent. *Nichia Corp. v. VIZIO, Inc.*, No. 8-16-cv-00545, Dkt. 127 at 25-29 (C.D. Cal. May 29, 2018). That litigation—which involves other asserted patents—is ongoing.

***Nichia/Lowe's* Litigation.** The other litigation involving the '631 patent that was identified by Patent Owner in its mandatory disclosures—*Nichia Corporation v. Lowe's Companies, Inc., Lowe's Home Centers, LLC, and L G Sourcing, Inc.*, Case No. 5:16-cv-00142 (W.D.N.C.)—has since settled and, on June 18, 2018, the parties filed a stipulation of dismissal.

Other Litigations. As discussed in Patent Owner's Mandatory Disclosures, all other judicial proceedings involving the '631 patent have been voluntarily dismissed after settlements. Pap. 6, at 2-3.

STATUS OF RELATED *INTER PARTES* REVIEW PROCEEDINGS

Lowe's IPR. On October 12, 2017, Lowe's Companies, Inc. *et al.* filed a petition challenging claims 1-2 and 6-11 of the '631 patent, and the Board granted institution on April 25, 2018. IPR2018-00066, Paps. 1 and 7. On June 16, 2018, Patent Owner and the petitioners in that proceeding filed a joint motion to terminate IPR2018-00066 in its entirety. IPR2018-00066, Pap. 10. That motion is still pending.

Other IPRs. As discussed in Patent Owner's Mandatory Disclosures, all other IPR proceedings involving the '631 patent were denied institution or were terminated following a settlement. Pap. 6, at 1 (citing IPR2017-00551 and IPR2017-2000).

* * * *

The parties advise the Board that no other litigation or IPR proceeding involving the '631 patent is contemplated in the foreseeable future. The parties further advise the Board that the '631 patent has expired.

CONCLUSION

Wherefore, Patent Owner and Petitioner respectfully request that the Board grant the parties' Joint Motion to Dismiss Case Number IPR2018-01100 in its entirety. Petitioner and Patent Owner are available at the Board's convenience to discuss these related matters in more detail or answer any additional questions raised by this joint motion.

Dated: June 29, 2018

Respectfully submitted

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