UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABILITY OPTO-ELECTRONICS TECHNOLOGY CO., LTD,
Petitioner

v.

LARGAN PRECISION CO., LTD.,
Patent Owner

IPR2020-01339
IPR2020-01345
IPR2020-01545

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.5, 42.71(a), 42.72, AND 42.74

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.5, 42.71(a), 42.72 and 42.74, and the Board's authorization received on March 5, 2021, Petitioner Ability Opto-Electronics Technology Co., Ltd. ("Petitioner" or "Ability") and Patent Owner Largan Precision Co., Ltd. ("Patent Owner" or "Largan") jointly move to terminate the present *inter partes* review proceedings in light of Patent Owner and Petitioner's settlement of all pending litigation (*i.e.*, district court, Patent Trial and Appeal Board, or otherwise) between the parties involving the patents at issue in these matters.

Petitioner and Patent Owner certify that they are concurrently filing a true and complete copy of their confidential written settlement materials (Confidential Exhibit 1050) in connection with this matter as required by statute. A joint request to treat the settlement materials (Confidential Exhibit 1050) as business confidential information kept separate from the file of the involved patents pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

LEGAL STANDARD

An *inter partes* review proceeding "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(a). A joint motion to terminate generally "must (1)

include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc*., IPR2014-00018, Paper 26 at 2 (PTAB July 28, 2014).

ARGUMENT

Termination of the present *inter partes* review proceedings is appropriate because (1) Petitioner and Patent Owner have settled their disputes and have agreed to terminate the proceedings, (2) the Office has not yet decided the merits of the proceedings, and (3) public policy favors the termination.

First, the parties' settlement completely resolves the controversy between Patent Owner and Petitioner relating to the U.S. patents before the Board and in the co-pending litigation.

Second, the Office has not decided the merits of the proceedings.

Third, public policy favors the termination. As recognized by the rules of practice before the Board:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where

> appropriate, may require a settlement discussion as part of the 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), 327.

Consolidated Trial Practice Guide (Nov. 2019) at 86. Moreover, no public interest or other factors militate against termination of this proceeding.

Following settlement, there will be no pending litigation or contested proceeding in any forum (*i.e.*, district court, Patent Trial and Appeal Board, or otherwise) involving the patents at issue in these matters.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceedings be terminated.

Date: March 8, 2021

Respectfully submitted,

/s/ Matthew W. Johnson

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