

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SOLAS OLED, LTD.,
Patent Owner.

Case No. IPR2020-01546
U.S. Patent No. 7,573,068

**JOINT MOTION TO TERMINATE
IPR BEFORE INSTITUTION**

Patent Owner Solas OLED, Ltd. and Petitioner Apple Inc. have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request termination of the *inter partes* review of U.S. Patent No. 7,573,068 (“Patent-in-Suit”), Case IPR2020-01546. The parties were authorized to file this Joint Motion by the Board (via email) on February 1, 2021.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement (Agreement) that resolves the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit is filed herewith as a confidential exhibit. There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Solas and Apple are concurrently filing a Joint Request to Keep Separate, which asks the Board to treat the settlement agreement as business confidential information, and to keep it separate from the files of this proceeding and the files of the Patent-in-Suit.

I. Statement of Precise Relief Requested

The parties jointly request that the Board terminate this IPR, Case No. IPR2020-01546, in its entirety.

II. Reasons Why Termination Is Appropriate

Termination of this proceeding in its entirety is proper. This IPR is still in an early stage and has not been instituted. This Petition was filed on September 11, 2020 and the deadline for the institution decision is April 22, 2021.

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter 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.” Because all parties request termination and the Board has not yet decided the merits of the proceeding, the Board should terminate the proceeding.

When there are no petitioners remaining in an *inter partes* review, the Board may terminate the proceeding entirely. 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. Apple is the only petitioner in this *inter partes* review. All parties support termination of this proceeding. With no petitioners remaining in the proceeding and no final written decision on the merits, termination of this proceeding entirely is appropriate.

The lawsuit between Solas and Apple involving the Patent-in-Suit has been dismissed.

III. No Future Participation by Petitioner

Apple will not be participating further in this proceeding.

IV. Conclusion

The parties have settled the disputes in the above-captioned *inter partes* review relating to the Patent-in-Suit. This *inter partes* review is in an early stage, and the Board has not issued an institution decision or entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request the Board to terminate this proceeding in its entirety.

Respectfully submitted,

Date: March 2, 2021

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on March 2, 2021, by filing this document through the Patent Trial and Appeal Board End to End system as well as delivering a copy via electronic mail upon the following attorneys of record for the Petitioner:

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Date: March 2, 2021

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