

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HP INC.,
Petitioner,

v.

LARGAN PRECISION CO., LTD.,
Patent Owner.

U.S. Patent No. 8,988,796

Case No.: IPR2021-00641

JOINT MOTION TO TERMINATE INTER PARTES REVIEW

Mail Stop *Inter Partes* Review
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, Petitioner HP Inc. and Patent Owner Largan Precision Co., Ltd. jointly request termination of this *Inter Partes* Review proceeding, No. IPR2021-00641.

On April 7, 2021, during a mediation conference before Chief Magistrate Judge Spero in the United States District Court for the Northern District of California, the parties agreed to resolve their disputes relating to United States Patent No. 8,988,796, dismissing with prejudice the co-pending litigation (*Largan Precision Co., Ltd. v. Ability Opto-Electronics Technology Co., Ltd, et al.*, No. 3:20-cv-06607-JD) and requesting termination of this proceeding.

The parties have executed a Stipulation of Dismissal, which was granted by the Court on April 15, 2021. Both the Stipulation and the Court's Order dismissing the co-pending litigation are submitted concurrently herewith. In accordance with the Stipulation, the co-pending litigation has been dismissed with prejudice. There are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding.

In view of the resolution between the parties, no dispute remains between the parties as to United States Patent No. 8,988,796, and thus termination of this proceeding is appropriate as Patent Owner has not filed a preliminary response nor has the Board rendered an institution decision in this proceeding. Termination of this proceeding is also consistent with the "strong public policy reasons favoring

settlement between the parties to a proceeding.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Further, consistent with 37 C.F.R. § 42.71(a), termination of this proceeding will promote efficiency and minimize unnecessary costs.

For these reasons, the Parties respectfully request that the Board grant this joint motion for termination.

Date: April 16, 2021

By: /Sasha G. Rao/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned hereby certifies that on this date, a true and correct copy of the foregoing was served via electronic mail on all counsel of record.

Date: April 16, 2021

/Sasha G. Rao/

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