

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL INDUSTRIES HOLDINGS CO., HISENSE CO., LTD.,
and LG ELECTRONICS INC.

Petitioners

v.

PARKERVISION, INC.

Patent Owner

IPR2021-00985¹
Patent No. 7,292,835 B2

JOINT MOTION TO TERMINATE HISENSE AS PETITIONER

¹ LG Electronics Inc. who filed a petition in IPR2022-00246, is joined as petitioner in this proceeding.

Petitioner Hisense Co., Ltd. (“Hisense”) and Patent Owner ParkerVision, Inc. (“ParkerVision”) (collectively, the “Parties”) have reached a settlement as to all the disputes in this proceeding. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Hisense and ParkerVision jointly move to terminate the present *inter partes* review proceeding as to Hisense. This motion does not pertain to any other Petitioner.

I. STATEMENT OF FACTS

Hisense and ParkerVision have reached an agreement to resolve these Parties’ disputes at issue in this proceeding. The Patent License and Settlement Agreement settles this proceeding. Pursuant to 37 C.F.R. § 42.74(b), the Parties’ Patent License and Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1023. The Patent License and Settlement Agreement is being filed electronically with access to “Board Only.” A “Joint Request to Treat Exhibit 1023 as Business Confidential Information” is being filed concurrently with this Joint Motion to Terminate to treat the Patent License and Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review as to Hisense is respectfully requested, and the Parties submit that such termination is justified. “There are

strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019).

The Board should terminate this proceeding, as these Parties jointly request, for the following reasons:

First, Hisense and ParkerVision have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a). At the time of this paper, the Board has not “decided the merits of the proceeding.”

Second, Hisense and ParkerVision have reached a settlement as to all the disputes between these Parties in this proceeding. A true copy of the Patent License and Settlement Agreement is filed concurrently herewith. *See Confidential Exhibit 1023.* Hisense and ParkerVision request that the Patent License and Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among these Parties relating to this proceeding. The Patent License and Settlement Agreement thus satisfies the requirements of 35 U.S.C. § 317(b).

Third, termination of Hisense as Petitioner would save significant further expenditure of resources by these Parties. Termination as requested would also further the purpose of *inter partes* review proceedings to provide an efficient and less costly alternative forum for patent disputes. Further, denying the motion would discourage future settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that a petitioner could continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, Hisense and ParkerVision respectfully request termination of this *inter partes* review as to Hisense.

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Respectfully submitted,

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