

Paper No. ___
Filed: January 26, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIANMA MICROELECTRONICS CO. LTD.,
Petitioner,

v.

JAPAN DISPLAY INC.,
Patent Owner.

Case No. IPR2021-01029
U.S. Patent No. 9,310,654

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner Tianma Microelectronics Co. Ltd., and Patent Owner Japan Display Inc. have entered into a settlement agreement that resolves all underlying disputes between the parties, including the related district court litigation and *inter partes* review proceeding IPR2021-01029, against U.S. Patent No. 9,310,654 (the “‘654 patent”), currently before the Board.

In an email dated January 25, 2022, the Board authorized the parties to file a joint motion to terminate and a joint request to treat the settlement agreement (including the license agreement) as business confidential information. In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the settlement agreement (including the license agreement) between the parties is being submitted concurrently herewith in this proceeding as Ex. 1018. There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety. The Board granted institution on December 14, 2021. *See* Paper 14. Patent Owner’s response to the petition is not due until March 9, 2022. *See* Paper 15. Termination is appropriate at this stage in view of the settlement agreement. *See* Patent Office Trial Practice Guide, 77 Fed. Reg. 48,768 (Aug. 14, 2012) (“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.”). The agreement ends all patent disputes between the parties, including the related district court proceeding and this IPR proceeding.

No other petitioners remain in this *inter partes* review, and no final written decision on the merits has been entered. Except for the instant proceeding, there are no other proceedings currently before the Board challenging the '654 patent and no other district court cases involving the '654 patent. For at least these reasons, termination of the *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74(a).

Respectfully submitted,

Dated: January 26, 2022

By: /Joshua L. Goldberg/
Joshua L. Goldberg, Reg. No. 59,369
Counsel for Petitioner

By: /Eric J. Klein/
Eric J. Klein, Reg. No. 51,888
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Joint Motion to Terminate Proceeding** was served on January 26, 2022, via email directed to counsel of record for Patent Owner at the following:

Eric J. Klein (Reg. No. 51,888) eklein@velaw.com VINSON & ELKINS L.L.P. 2001 Ross Avenue, Suite 3900 Dallas, TX 75201 Tel: (214) 220-7700 Fax: (214) 220-7716	Abigail Lubow (Reg. No. 75,839) alubow@velaw.com VINSON & ELKINS L.L.P. 555 Mission Street, Suite 2000 San Francisco, CA 94105 Tel: (415) 979-6963 Fax: (415) 358-5770 Jeffrey R. Swigart (Reg. No. 77,008) jswigart@velaw.com VINSON & ELKINS L.L.P. 2001 Ross Avenue, Suite 3900 Dallas, TX 75201-2975 Tel: (214) 220-7700 Fax: (214) 220-7716
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Dated: January 26, 2022

By: Valencia Daniel/
Valencia Daniel
Litigation Legal Assistant
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP