

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANASONIC CORPORATION
Petitioner

v.

NEODRON LTD.
Patent Owner

Case IPR2021-01115
Patent No. 8,946,574

**JOINT MOTION BY PETITIONER AND PATENT OWNER TO
TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37
C.F.R. § 42.74**

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

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Panasonic Corporation (“Panasonic”) and Patent Owner Neodron Ltd. (“Neodron”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,946,574, Case No. IPR2021-01115, without prejudice, and request that the settlement agreement be treated as confidential information pursuant to 35 U.S.C. § 317(b). The Board authorized the parties to file this Joint Request on October 4, 2021-via e-mail.

Termination of this *inter partes* review is appropriate at this time. Pursuant to 35 U.S.C. § 317(a), this *inter partes* review “shall be terminated with respect to petitioner upon this request, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Petitioner notes that Patent Owner has not filed a Preliminary Response in this case and the Board has not yet rendered an institution decision. Moreover, no motions or petitions are outstanding at this time.

The parties have entered into a confidential Settlement and License Agreement (“Agreement”), which is submitted herewith as Exhibit 1020 and requires both parties to terminate all disputes, including (i) *Inter Partes* Review Proceeding No. IPR2021-01115, and (ii) *Neodron Ltd. v. Panasonic Corporation, et al.*, in the Eastern District of Texas, Civil Action No. 2:20-cv-00241-JRP-RSP (“the related litigation”). There are no other collateral agreements between the parties made in connection with, or in contemplation of, the termination sought.

Aside from these proceedings Petitioner is not aware of any other related litigation or related proceeding currently before the Office. The lawsuit between Neodron and Panasonic, involving the Patent-in-Suit has already been dismissed. The parties do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future.

Therefore, termination of this *inter partes* review is appropriate because (i) the proceeding is at a sufficiently early stage; (ii) the parties have settled their disputes; (iii) the parties have agreed to dismiss, and already have dismissed the related litigation; and (iv) the parties to this *inter partes* review agree that it should be terminated.

As set forth in 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the confidential Agreement between the parties has been made in writing, and a true and correct copy is being filed with the Patent Office with this Motion as Panasonic Exhibit 1020. As stated in 35 U.S.C. § 317(a), because Panasonic and Neodron hereby requests this termination, no estoppel under 35 U.S.C. § 315(e) shall attach as to Patent Owner. Further, a request to treat the confidential Agreement as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is filed concurrently herewith.

Therefore, Panasonic Corporation respectfully requests termination of the *Inter Partes* Review of U.S. Patent No. 8,946,574, Case No. IPR2021-01115.

Respectfully Submitted,

Dated: October 5, 2021

/ Christopher TL Douglas /
Christopher TL Douglas, Reg. No. 56,950

Dated: October 5, 2021

/ Reza Mirzaie /
Reza Mirzaie, Reg. No. 69,138

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the above-captioned “JOINT MOTION BY PETITIONERS AND PATENT OWNER TO TERMINATE PROCEEDING” was served in its entirety on 5th day of October 2021 pursuant to agreement via email to counsel for Patent Owner Neodron Ltd. at:

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