

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORPORATION,

Petitioner,

v.

MAXELL LTD.,

Patent Owner.

Case IPR2019-00097

U.S. Patent No. 9,100,604

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Joint Motion to Terminate Proceeding
Case IPR2019-00097
U.S. Patent No. 9,100,604

Pursuant to 35 U.S.C. § 317(a) and authorization of the Board granted on April 22, 2019, Petitioner BlackBerry Corporation (“BlackBerry”) and Patent Owner Maxell Ltd., (“Maxell”) jointly request termination of IPR2019-00097, which is directed to U.S. Patent No. 9,100,604 (“the ’604 Patent”).

This *inter partes* review was filed October 16, 2018. A Preliminary Response was filed by the Patent Owner on March 12, 2019 and no decision regarding institution of the proceeding has issued. Further, no final written decision on the merits of this review proceeding has been entered. The parties have settled their dispute, and have reached agreement to terminate this *inter partes* review. As there are no other petitioners in this proceeding, and the proceeding is still at a very early stage, the parties respectfully submit that termination of this proceeding is appropriate.

The parties' Settlement Agreement has been made in writing, and a true copy of same is attached hereto as Exhibit 1021.¹ The parties further jointly certify that there is no other agreement or understanding between them, including any other collateral agreements, made in connection with, or in contemplation of, the termination of the instant proceeding as set forth in 35 U.S.C. § 317(b). The parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. § 42.74(c) and a separate joint request to that effect is being filed concurrently.

As stated in 35 U.S.C. § 317(a), because Petitioner and Patent Owner jointly request this termination as to Petitioner, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

I. Reasons Why Termination is Appropriate

Termination with respect to Petitioner is proper under 35 U.S.C. § 317(a) because the parties are jointly requesting termination and the Office has not yet "decided on the merits of the proceeding before the

¹ The Settlement Agreement is being filed electronically via the Patent Trial and Appeals Board's E2E as "Parties and Board Only."

request for termination is filed.” Here, no decision on the merits has been made. Accordingly, the parties are entitled to terminate this proceeding as to Petitioner under Section 317(a) upon their joint request.

Additionally, the parties respectfully submit that termination of this proceeding is appropriate because (a) this proceeding is at a very early stage and no motions are outstanding; (b) the parties have reached agreement to end their dispute concerning the ’604 Patent; (c) the parties have agreed to dismiss the related district court litigation with respect to the ’604 Patent; (d) the parties agree that this *In inter partes* review should be terminated; and (e) termination of this proceeding will preserve the Board’s resources and obviate the need for any more Board involvement in this matter.

II. Related District Court Litigation and Status

The ’604 Patent was asserted in *Maxell, Ltd. v. BlackBerry Corporation et al.* (Civil Action No. 1:17-cv-1446) (District of Delaware). The parties filed a stipulation of dismissal on April 18, 2019 as part of the parties’ Settlement Agreement, which was granted

on April 22, 2019. There are no other current litigation proceedings involving the subject patent.

III. Related Proceedings Before the Office

No other proceedings related to the '604 Patent are pending.

Dated: April 23, 2019

Respectfully submitted,

<u>/Robert G. Pluta/</u> Robert G. Pluta (Reg. No. 50,970) Mayer Brown LLP 71 S. Wacker Drive Chicago, IL 60606 (312) 701-8641 rpluta@mayerbrown.com <i>Counsel for Patent Owner Maxell Ltd.</i>	<u>/W. Todd Baker /</u> W. Todd Baker (Reg. No. 45,265) OBLON, MCCLELLAND, MAIER & NEUSTADT, LLP 1940 Duke Street Alexandria, Virginia 22314 (703) 413-3000 cpdocketbaker@oblon.com <i>Counsel for Petitioner BlackBerry Corporation</i>
---	--

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of JOINT MOTION TO TERMINATE PROCEEDING on the counsel of record for the Patent Owner by filing this document through the PTAB E2E System as well as delivering a copy via electronic mail to the following address:

Robert G. Pluta

rpluta@mayerbrown.com

Michael J. Word

mword@mayerbrown.com

Amanda S. Bonner

asbonner@mayerbrown.com

Luiz A. Miranda

lmiranda@mayerbrown.com

Saqib J. Siddiqui

ssiddiqui@mayerbrown.com

James B. Beaber

jbeaber@mayerbrown.com

Mayer Brown LLP

Dated: April 23, 2019

/W. Todd Baker/

W. Todd Baker (Reg. No. 45,265)