

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUAWEI TECHNOLOGIES CO., LTD.,  
Petitioner

v.

MAXELL, LTD.,  
Patent Owner

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Case IPR2019-00576  
Patent 6,973,334

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**JOINT MOTION TO TERMINATE**

**UPDATED EXHIBIT LIST**

- EX1001 U.S. Pat. No. 6,973,334 to Katagishi et al. (“the ’334 patent”)
- EX1002 Prosecution History of the ’334 patent (Serial No. 10/142,051)
- EX1003 Declaration of Mark R. Lanning
- EX1004 U.S. Pat. No. 5,452,473 to Weiland et al. (“Weiland”)
- EX1005 U.S. Pat. No. 5,430,760 to Dent (“Dent”)
- EX1006 U.S. Pat. No. 5,752,172 to Matero (“Matero”)
- EX1007 U.S. Pat. No. 5,392,460 to Mattila (“Mattila”)
- EX1008 U.S. Pat. No. 5,841,768 to Ozluturk et al. (“Ozluturk”)
- EX1009 U.S. Pat. No. 5,799,010 to Lomp et al. (“Lomp”)
- EX1010 U.S. Pat. No. 5,589,796 to Alberth, Jr. et al. (“Alberth”)
- EX1011 Plaintiff Maxell, Ltd.’s Patent Rule 3-1 and 3-2 Disclosure of  
Asserted Claims and Infringement Contentions Against the Huawei  
Defendants in *Maxell, Ltd., v. Huawei Device USA Inc. and Huawei  
Device Co., Ltd.* (Case No. 5:18-cv-00033) (E.D.Texas)
- EX1012 Defendants’ Invalidity Contentions in *Maxell, Ltd., v. Huawei Device  
USA Inc. and Huawei Device Co., Ltd.* (Case No. 5:18-cv-00033)  
(E.D.Texas)
- EX1013 Confidential Settlement Agreement

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, and the Board's order of March 1, 2019 (Paper No. 6), the parties to this case, Petitioner Huawei Technologies Co., Ltd ("Huawei" or "Petitioner") and Patent Owner Maxell, Ltd. ("Maxell" or "Patent Owner") (collectively "the Parties"), jointly request termination of *inter partes* review ("IPR") of the following nine pending cases between the Parties in light of Parties' settlement of their dispute. For the Board's convenience, it is noted that a Joint Motion substantially identical to this one is being filed today in each of these nine cases:

- IPR2019-00622 (Patent 6,347,068)
- IPR2019-00462 (Patent 7,324,487)
- IPR2019-00640 (Patent 6,928,306)
- IPR2019-00192 (Patent 7,515,810)
- IPR2019-00576 (Patent 6,973,334)
- IPR2019-00464 (Patent 7,995,897)
- IPR2019-00661 (Patent 6,983,140)
- IPR2019-00575 (Patent 7,068,503)
- IPR2019-00656 (Patent 9,544,517)

The Parties are concurrently filing a true and complete copy of their written Settlement Agreement (Confidential Exhibit 1013) in connection with this matter pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b)-(c). The Parties certify that there are no other agreements or understandings, oral or written, between the

parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

### **LEGAL STANDARD**

An IPR proceeding “shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, 2 (PTAB July 28, 2014).

### **ARGUMENT**

Termination of the present IPR proceeding is appropriate because (1) the Parties have settled their dispute regarding the '334 patent and have agreed to

terminate the proceeding, (2) the proceeding is in a preliminary stage prior to institution of a trial, so the Office has not made any decision on the merits of the proceeding, (3) any other proceedings involving the '334 patent were initiated by other parties and are not currently instituted, and (4) public policy favors the termination.

First, the Settlement Agreement completely resolves the controversy between the Parties relating to the '334 patent. Huawei Device USA, Inc. and Huawei Device Co., Ltd. , which are real parties-in-interest in the present IPR proceeding, were named defendants in U.S. district court litigation captioned *Maxell, Ltd. v. Huawei Device USA Inc., et al.*, No. 5:18-cv-00033 (E.D. Tex). The parties have notified the district court of this Settlement Agreement.

The Board has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a) (emphasis added); *see* 77 Fed. Reg. at 48,768 (“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.”). Because all of these nine IPR cases are still in the preliminary stage, the Board has not reached a final written decision or otherwise decided the merits in any of these nine cases at the time of this joint motion for termination. As such, the timing of terminating this proceeding is proper. *See* 77 Fed. Reg. 48,680, 48,686 (Aug. 14, 2012). And 35 U.S.C. § 317(a) provides that “[a]n *inter partes*

review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Accordingly, good cause exists to terminate these nine proceedings based on the settlement as the Board has not yet decided the merits of any of these proceedings; indeed, none of these nine cases are “instituted under this chapter” as explained in § 317(a).

Third, Huawei Technologies Co., Ltd. was the Petitioner in this proceeding (with the other Huawei entities being named as real parties-in-interest), and the other petitions for IPR of the ’334 patent were filed by unrelated parties and are at the pre-institution phase.

Fourth, public policy favors the termination. As recognized by the rules of practice before the Board:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. 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.

*See* Patent Office Trial Practice Guide, Fed. Reg., Vol. 77, No. 157 at 48768 (Aug. 14, 2012). Moreover, no public interest or other factors militate against termination

of this proceeding, especially where the Board seeks to favor settlement between parties in an IPR proceeding.

As to the *Heartland Tanning* requirements (2) and (4), in the district court litigation with Huawei referenced above, the plaintiff is Maxell, Ltd., the defendants are Huawei Device USA Inc. and Huawei Device Co., Ltd., and the parties have settled the dispute. As to requirement (3), the two other IPR petitions against the '334 patent were filed in IPR2019-00070 (pre-institution) and IPR2019-00088 (pre-institution).

### **CONCLUSION**

For the foregoing reasons, the Parties jointly and respectfully request that the instant proceeding be terminated.

Respectfully submitted,

Dated: April 10, 2019

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Dated: April 10, 2019

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### **CERTIFICATE OF SERVICE**

Pursuant to 37 CFR §§ 42.6(e)(1) and 42.6(e)(4)(iii), the undersigned certifies that on April 10, 2019, a complete and entire copy of this Joint Motion to Terminate was provided via email to the Patent Owner by serving the email correspondence addresses of record as follows:

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