

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG INNOTEK CO. LTD.,
Petitioner,

v.

SEOUL VIOSYS CO., LTD.,
Patent Owner.

Case IPR2019-01154
U.S. Patent No. 9,293,664

UNOPPOSED MOTION TO WITHDRAW PETITION

I. INTRODUCTION

Pursuant to the Board's authorization of October 28, 2019, Petitioner ("LG" or "Petitioner") files this motion to terminate the IPR2019-01154 IPR proceeding regarding U.S. Patent No. 9,293,664. This motion is being filed prior to a decision on the merits of the petition.

The Parties have conferred, and Patent Owner does not oppose this motion.

The Board has discretion to "take up petitions or motions for decisions in any order" and to "grant, deny, or dismiss any petition or motion" or enter any appropriate order. 37 C.F.R. § 42.71(a). Petitioner respectfully requests that the Board exercise its discretion to dismiss the present petition for the good cause shown herein. Specifically, Petitioner requests that the Board dismiss this IPR petition and terminate IPR2019-01154 to preserve the Board's and parties' resources at this early stage and to achieve a just, speedy, and inexpensive resolution to this dispute. This proceeding is in its preliminary phase, Patent Owner does not oppose this motion, and the Board has yet to reach the merits and issue a decision on institution, so preservation of resources would be real and substantial. Dismissal is also in the interest of justice, as the parties have no other dispute, other than the below-identified co-pending IPR proceedings for which Petitioner is concurrently requesting withdrawal of the petitions and termination of

the proceedings, and dismissal allows the parties to move forward unburdened by the present proceeding.

II. RELATED MATTERS AND PROCEDURAL HISTORY

The '664 Patent was the subject of a civil action styled *Seoul Semiconductor Co. et al v. Fry's Electronics, Inc*, No. 2:18-cv-00386-JRG (E.D. Tex.). LG was not involved with the aforementioned district court proceeding. Nor is LG a Real Party in Interest to any parties in the district court proceeding. Furthermore, the district court proceeding has concluded, per the Consent Judgment and Permanent Injunction order submitted along with this motion as Exhibit LGI1016.

LG also filed IPR petitions with respect to the following patents at issue in the aforementioned district court proceeding:

U.S. Patent Number	IPR Case Number(s)
9,664,356	IPR2019-01155
9,793,448	IPR2019-01157, IPR2019-01158
9,530,939	IPR2019-01159, IPR2019-01160

LG is concurrently filing an unopposed motion to withdraw the petition for each of the above-identified IPR proceedings.

III. SETTLEMENT AGREEMENT

LG certifies that no agreement or understanding (or any collateral agreements referred to in any such agreement) between the parties has been made in connection with or in contemplation of the termination of this proceeding.

IV. GOOD CAUSE EXISTS TO GRANT THIS MOTION TO WITHDRAW THE PETITION

LG filed the present petition on June 11, 2019. The present petition is the only IPR petition for U.S. Patent No. 9,293,664 that LG filed.

Good cause exists to dismiss LG's IPR petition and terminate IPR2019-01154. Dismissal would preserve the Board's and the parties' resources and would expeditiously resolve LG's request, furthering the purpose of IPR challenges. *See* 37 C.F.R. § 42.1(b) (a "just, speedy, and inexpensive resolution of every proceeding."). IPR2019-01154 is in its preliminary stage, as the Board has not yet reached the merits or issued a decision on institution. Furthermore, Seoul Viosys just recently filed its Patent Owner Preliminary Response on September 19, 2019. Seoul Viosys would not be prejudiced by termination.

The Board has precedent for allowing petitioners to withdraw IPR petitions pre-institution. For instance, the Board granted a Petitioner's request to dismiss a petition after a preliminary response had been filed and before institution in IPR2015-01270. *See* IPR2015-01270, Paper 11 at 3-4 (Dec. 9, 2015). The Board dismissed the petition over the Patent Owner's opposition "to promote efficiency

and minimize unnecessary costs.” *Id.* The facts of the present case weigh even more in favor of dismissal because, here, Patent Owner does not oppose.

In another case with much different facts, the Board refused a Petitioner’s opposed request to withdraw a petition and motion for joinder. *See* IPR2017-00670, Paper 11 at 5 (May 22, 2017). In IPR2017-00670, the proceeding to be joined had already been instituted and the potential reduction of costs was therefore “speculative.” *Id.* No such concerns exist with the present petition, because it has not been instituted nor is there any instituted proceeding to which the present petition is to be joined. Therefore, the reduction of costs and preservation of resources here is assured, not speculative.

In addition, dismissal of the petition here would further the purpose of the rules by justly and expeditiously resolving this dispute without subjecting the Board and the parties to the unnecessary expense and investment of resources involved in trial. The parties would otherwise incur substantial expense in preparing and presenting expert declarants for deposition, submitting substantive briefs and motions, and presenting at an oral hearing. The Board would also have to expend substantial resources if it were to decline to dismiss the present petition. All of these resources can be spared by dismissing the petition.

Dismissal is also in the interest of justice, as dismissal of this case (along with the above-identified IPR cases, for which termination is being requested)

would formally end the only current dispute between the parties. Seoul Viosys will not be prejudiced by the Board dismissing the petition, but rather will benefit by moving forward without the burden or expense of the present petition.

For the foregoing reasons, Petitioner respectfully requests termination of IPR2019-01154.

Respectfully submitted,

Date: October 30, 2019

/Timothy W. Riffe/
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on **XXX**, a complete and entire copy of this Unopposed Motion to Withdraw Petition and its exhibit were provided via email to the Patent Owner by serving the email correspondence address of record as follows:

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