

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner

v.

MAXELL, LTD.,

Patent Owner

Case No. IPR2020-00200
U.S. Patent No. 10,084,991

**JOINT MOTION TO TERMINATE
INTER PARTES REVIEW OF U.S. PATENT NO. 10,084,991
UNDER 37 C.F.R. § 42.72**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(a), Petitioner Apple Inc. and Patent Owner Maxell, Ltd. jointly request termination of the petition for *Inter Partes* Review of U.S. Patent No. 10,084,991 (“the ’991 Patent”) in IPR2020-00200. On April 8, 2021, the Parties informed the Board of a settlement agreement between Petitioner and Patent Owner via e-mail and requested authorization to file a Joint Motion to Terminate the Petition with respect to both the Patent Owner and Petitioner. As set forth in an e-mail dated April 8, 2021, the Board authorized the filing of the requested Joint Motion to Terminate this Petition. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

II. ARGUMENT

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 at 2 (PTAB Jul. 28, 2014).

A. Brief Explanation as to Why Termination Is Appropriate

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The Parties are concurrently filing a copy of the settlement agreement as Exhibit 1055 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b). Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1055 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1055 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The parties “may terminate the proceeding...unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, 4 (November 2019). The parties have now settled their dispute and have reached agreement to terminate the Petition. The USPTO can conserve its resources through terminating now, removing the need for the Board to further consider the arguments and to issue a Final Written Decision.

Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts have expressed

a strong interest in encouraging settlement in litigation. *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Ending this petition for IPR promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012).

B. Identification of Parties and Status of Litigation

This petition for *Inter Partes* Review is related to the following lawsuit, which has been dismissed: *Apple Inc. in Maxell, Ltd. v. Apple Inc.*, No. 5:19-cv-00036 (*E.D. Tex. March 15, 2019*).

C. Identification and Status of Related Proceedings Before the USPTO

Petitioner has not filed any further Petition for *Inter Partes* Review related to the '991 Patent.

III. CONCLUSION

For the reasons set forth above, the parties respectfully request termination of the petition for *Inter Partes* Review of U.S. Patent No. 10,084,991 (IPR2020-00200).

Respectfully submitted,

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COUNSEL FOR PETITIONER

BY: /s/ Robert G. Pluta
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COUNSEL FOR PATENT OWNER

CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.6

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 13, 2021, the foregoing *JOINT MOTION TO TERMINATE THE PETITION FOR INTER PARTES REVIEW OF U.S. PATENT NO. 10,084,991 UNDER 37 C.F.R. § 42.71(a)* was served via electronic filing with the Board and via Electronic Mail on the following counsel of record for Patent Owner:

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