

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Avigilon USA Corporation and Avigilon Corporation,

Petitioners,

v.

Canon Inc.,

Patent Owner.

Case IPR2020-00866

U.S. Patent No. 10,135,952

**JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C § 317 AND
37 C.F.R. §§ 42.72 AND 42.74**

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74, and the Board's authorization on July 13, 2020, Petitioners Avigilon USA Corporation and Avigilon Corporation ("Avigilon") and Patent Owner Canon Inc. ("Canon") (collectively, the "Parties") jointly move to terminate the present proceeding in light of the Parties' agreement to terminate this proceeding.

The Parties have reached an agreement to file a motion to terminate this proceeding. The Parties are concurrently filing a true and correct copy of their written Settlement Agreement in connection with this matter as required by statute as Confidential Exhibit 1108. The parties jointly certify that, aside from the Settlement Agreement, there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements or understandings, 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.

I. Legal Standard

An AIA trial 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); § 327(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 No. 26, at *2 (P.T.A.B. July 28, 2014).

II. Dismissal of District Court Matter and Issuance of Settlement Agreement Warrants Termination

Termination of the present proceeding is appropriate as the Board has not yet decided the merits of the proceeding, the subject patent has been dismissed, with prejudice, from the litigation between the Parties, and the parties have agreed that it is appropriate to terminate this proceeding. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *DTN LLC v. Farms Technology, LLC*, IPR2018-01412, Paper No. 21 (June 14, 2019) (precedential). Terminating this proceeding promotes the Congressional goal to

establish a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. *See* Patent Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). In view of the dismissal, with prejudice, of the subject patent from the litigation between the Parties, the absence of any other pending litigation involving this patent, or any public interest or other factors militating against termination, termination of this proceeding is justified.

III. Related Proceedings

With respect to the second, third, and fourth *Heartland Tanning* requirements, the Parties identify the following litigation and proceedings currently before the Office involving the Parties. There are no parties in these related litigations and proceedings besides the Parties to this proceeding.

Case Name	Case No.	Court	Filed
<i>Canon Inc. v. Avigilon USA Corp.</i>	2:17-cv-04011-BMC	E.D.N.Y.	7/6/2017
<i>Avigilon USA Corp. v. Canon Inc.</i>	1:17-cv-11922-IT	D. Mass.	10/5/2017
<i>Canon Inc. v. Avigilon USA Corp.</i>	3:17-cv-02733-N	N.D. Tex.	10/5/2017
<i>Avigilon USA Corp. v. Canon Inc.</i>	3:18-CV-1317-N	N.D. Tex.	8/16/2018

Case Name	Case No.	Court	Filed
<i>Canon Inc. v. Avigilon USA Corp.</i>	1:19-cv-10931-NMG	D. Mass.	4/23/2019

The '952 patent is asserted in the district court matter, 1:17-cv-10931-NMG (D. Mass.), where the Parties filed a Joint Stipulation of Dismissal on July 9, 2020, following a resolution of all claims and counterclaims subsequent to a signed written settlement agreement. The '952 patent is not at issue in the other actions listed above, nor in any other currently pending action.

The Parties also provide the following list of other PTAB proceedings between the Parties:

Case	Patent at Issue	Filing Date	Status
IPR2018-01626	7,034,864	8/29/2018	Institution Denied
IPR2018-01627	9,191,630	8/29/2018	Institution Denied
IPR2020-00656	10,135,952	2/25/2020	Pending
IPR2020-00866	10,135,952	4/24/2020	Pending

The '952 patent is only at issue in the present matter and IPR2020-00656.

The other proceedings listed above are on unrelated patents.

Dated: July 14, 2020

Respectfully submitted,

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Dated: July 14, 2020

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that “**JOINT MOTION TO
TERMINATE PURSUANT TO 35 U.S.C § 317 AND 37 C.F.R. §§ 42.72
AND 42.74**” was served in its entirety on **July 14, 2020**, upon the following
parties via FedEx Overnight delivery directed to the assignee for the patent at
the following address:

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