

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE CO. LTD.
Petitioner

v.

MAXELL, LTD.,
Patent Owner

Case IPR2020-01600 (U.S. Pat. No. 10,327,029)
Case IPR2020-01598 (U.S. Pat. No. 9,578,369)

JOINT MOTION TO DISMISS PUSUANT TO 35 U.S.C. § 317(a)

Mail Stop: Patent Board
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72, 42.74, Petitioner HISENSE CO. LTD., (“Petitioner”) and Patent Owner MAXELL , LTD., (“Patent Owner”) jointly move to dismiss the *inter partes* review of related U.S. Patent Nos. 9,578,369, (“the ’369 patent”) and 10,327,029 (“the ’029 patent”) with the United States Patent and Trademark Office. This Joint Motion was authorized by the Board via email on December 14, 2020.

The parties have settled their dispute and have reached agreement to dismiss these *inter partes* reviews. A “Patent License Agreement” has been made in writing which provides for Petitioner to have a license to the ‘369 and ‘029 patents. A true copy of the “Patent License Agreement” in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b) is being submitted concurrently herewith as Exhibit 1100 in the *inter partes* review cases. Aside from the written agreement concurrently filed with the Board there are no other agreements, oral or written, between the parties and made in connection with, or in contemplation of, the termination of the proceedings.

Submitted concurrently herewith is a request by Petitioner and Patent Owner that the “Patent License Agreement” be treated as business confidential information, be kept separate from the file of the involved patents, and be made available only to Federal Government agencies on written request, or to any person

on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

No other petitioners remain in these *inter partes* reviews, and no final written decisions on the merits have been entered. For at least these reasons, dismissal of the *inter partes* reviews are proper under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a).

Respectfully submitted,

By: /Kevin P. Anderson/

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Dated: December 16, 2020

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on the 16th day of December, 2020, a complete copy of the foregoing Joint Motion to Terminate and supporting exhibit was served by filing this document with the PTAB's End to End System as well as via email to Patent Owner at the following address:

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