

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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 REQUEST TO KEEP SEPARATE PURSUANT TO  
35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)**

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

Patent Owner Maxell, Ltd., (“Maxell”) and Petitioner Hisense Co. Ltd. (“Hisense”) (collectively, “the Parties”) have reached a settlement. The settlement agreement resolves the disputes in the above-captioned inter partes reviews relating to U.S. Patent. Nos. 10,327,029 and 9,578,369 (“Patents-in-suit”). The Parties jointly request that the Board treat the settlement agreement as business confidential information and keep it separate from the files of these proceedings and the files of the Patents-in-suit.

The Parties were authorized to file this Joint Motion by the Board (via email) on December 14, 2020.

### **I. Statement of Precise Relief Requested**

The Parties jointly request that the Board (i) treat the settlement agreement as business confidential information; (ii) keep the settlement agreement separate from the files of this proceeding and the files of the Patents-in-suit; (iii) keep the settlement agreement confidential from any third party; and (iv) make the settlement agreement “available only to Federal Government agencies on written request, or to any person on a showing of good cause” in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

### **II. Reasons Why Relief Is Appropriate**

The terms of the settlement agreement require the Parties to treat the settlement agreement as confidential information and limit their ability to share the

settlement agreement publicly or disclose its contents with third parties. The Parties have filed a copy of the settlement agreement with the Board, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. The confidential settlement agreement was filed in the PTAB E2E system to provide availability only to Parties and Board.

Respectfully submitted,  
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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 16<sup>th</sup> day of December, 2020, a complete copy of the foregoing Joint Request to Keep Separate 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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