

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIZIO, INC.,
Petitioner,

v.

MAXELL, LTD.,
Patent Owner

IPR2022-01459
U.S. Patent 7,730,507

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF
U.S. PATENT 7,730,507 UNDER 37 C.F.R. 42.72**

I. INTRODUCTION

Pursuant to 37 C.F.R. 42.72, Petitioner VIZIO, Inc. (“VIZIO”) and Patent Owner Maxell, Ltd. (“Maxell”) jointly request dismissal and termination of the petition for Inter Partes Review (“IPR”) of U.S. Patent 7,730,507 in IPR2022-01459.

On September 6, 2023, the Parties informed the Board of the resolution via email and requested authorization to file a motion to terminate the petition with respect to both the Patent Owner and the Petitioner and a motion to keep the agreement confidential and separate from the file of U.S. Patent 7,730,507. As set forth in an email dated September 7, 2023, the Board authorized the filing of the requested motion to terminate this petition and motion to keep the agreement confidential and separate. 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 agreement that fully resolves this matter. The Parties are concurrently filing a copy of the agreement as Exhibit 1031 along with a motion to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74.

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 1031 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 1031 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). This proceeding is still in its early stages and Patent Owner has yet to file its Patent Owner Response. The parties have now settled their dispute and have reached agreement to terminate the Petition.

Public policy favors terminating the present petition for IPR. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., 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. *See 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). And 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 and Appeal Board Consolidated Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

This *Inter Partes* Review is related to *Maxell, Ltd. et al v. VIZIO, Inc.*, Case No. 2:21-cv-06758 (C.D. Cal.).

C. Identification and Status of Related Proceedings Before the USPTO

VIZIO filed its petition for Inter Partes Review (Paper No. 1) on August 29, 2022, the Board issued a Decision to Institute (Paper No. 7) on April 11, 2023, and Maxell filed its Objections to Evidence (Paper No. 9) on April 25, 2023. No other substantive papers have been filed since Institution. The Parties have now resolved their dispute and reached agreement to terminate this proceeding. Additionally, there are no other pending USPTO proceedings regarding the patent-at-issue. The USPTO can conserve its resources by terminating now, removing the need for the Board to

further consider the arguments and to render a Final Decision. Therefore, the Parties respectfully request termination of this *Inter Partes* Review of U.S. Patent 7,730,507.

Dated: September 7, 2023

Respectfully submitted,

/Cono A. Carrano/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this **JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF U.S. PATENT 7,730,507 UNDER 37 C.F.R. 42.72** in connection with IPR2022-01459 to be served via e-mail on September 7, 2023, in its entirety on counsel of record for Patent Owner as follows:

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Date: September 7, 2023

/Melanie Langford/

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