UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APUTURE IMAGING INDUSTRIES CO., LTD.,
Petitioner,

v.

ROTOLIGHT LIMITED,
Patent Owner.

Case IPR2024-01424
Patent No. 10,197,257 B2

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.5, 42.71(a), 42.72, AND 42.74

Pursuant to 35 U.S.C. § 317, 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74, and the Board's authorization of January 8, 2025, Petitioner Aputure Imaging Industries Co., Ltd. ("Petitioner") and Patent Rotolight Limited ("Patent Owner") jointly move to terminate the present *inter partes* review proceeding in light of Patent Owner and Petitioner's settlement of their disputes.

Petitioner and Patent Owner concurrently file a true and complete copy of their confidential written settlement materials, Confidential Exhibit 1012, in connection with this matter as required by statute. A joint request to treat the settlement materials (Confidential Exhibit 1012) as business confidential information kept separate from the file of the involved patents pursuant to 35 U.S.C. § 317(b) is being filed concurrently.

LEGAL STANDARD

An *inter partes* review 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). 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 (P.T.A.B. July 28, 2014).

ARGUMENT

Termination of the present *inter partes* review proceedings is appropriate because (1) Petitioner and Patent Owner have settled their disputes and have agreed to terminate the proceeding, (2) the Office has not yet decided the merits of the proceeding, and (3) public policy favors the termination. *DTN, LLC v. Farms Technology, LLC*, IPR2018-01412, Paper 21, at *10-11 (P.T.A.B. June 14, 2019) (precedential).

First, the parties' settlement completely resolves the controversy between Patent Owner and Petitioner relating to U.S. Patent No. 10,197,257 B2 ("the '257 Patent"). *See* Confidential Exhibit 1012.

Second, the Office has not decided the merits of the proceeding.

Third, public policy favors the termination. As recognized by the rules of practice before the Board:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug.

14, 2012). Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements, the parties confirm that all other litigation between the parties to this IPR involving the ’257 Patent has been resolved, including *Rotolight Limited v. Aputure Imaging Industries Co., Ltd.* pending in the United States District Court for the Eastern District of Texas, Civil Action No. 4-23-cv-00508. There are currently no other pending IPRs against the ’257 Patent.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

Dated: January 9, 2025

Respectfully submitted,

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Certificate of Service

I certify that on January 9, 2025, a copy of this Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74 were served on counsel for Patent Owner via electronic service at the following address:

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