

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DAIFUKU CO., LTD. AND DAIFUKU AMERICA CORP.,
Petitioner,

v.

MURATA MACHINERY, LTD.,
Patent Owner

Case IPR2015-01538
Patent 6,113,341

**JOINT MOTION TO TERMINATE AND REQUEST TO TREAT
SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL
INFORMATION**

EXHIBIT LIST

Exhibit No.	Exhibit Name
1001	U.S. Patent No. 6,113,341 (the “341 patent”).
1002	Amended Complaint Filed February 19, 2015; <i>Murata Machinery USA, Inc. et al. v. Daifuku Co., Ltd. et al.</i> , No. 2:13-cv-00866 (D. Utah 2013).
1003	Japanese Patent Document 5-82913 (the “913 publication”).
1004	U.S. Patent No. 3,863,777 (the “777 patent”).
1005	Japanese Patent Document SHO 63[1988]-242809 (the “809 publication”).
1006	Declaration of Dr. Robert H. Sturges Regarding U.S. Patent No. 6,113,341.
1007	Prosecution History for U.S. Patent No. 6,113,341.
1008	(Corrected) Declaration of Michael J. Farley.
1009	PRPS Notification dated April 29, 2016, 11:49 PM.
1010	PRPS Notification dated April 29, 2016, 11:58 PM.
1011	Emails to and from counsel concluding May 2, 2016.
1012	Confidential Settlement Agreement.

I. Relief Requested

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Daifuku Co., Ltd. and Daifuku America Corp. (collectively, “Petitioner”) and Murata Machinery, Ltd. (“Patent Owner”) jointly move to terminate the *Inter Partes* Review of U.S. Patent 6,113,341 (the “’341 patent”), Case IPR2015-01538 (the “present IPR proceeding”). The Board authorized this Motion in an email message on September 21, 2016.

Petitioner and Patent Owner (the “Parties”) have settled all of their disputes involving the ’341 patent and have reached a confidential Settlement Agreement. Exhibit 1012 is a true and correct copy of the Settlement Agreement, which consists of: (1) a Patent Cross License Agreement, (2) a Memorandum Accompanying Patent Cross License Agreement Executed on September 8, 2016, and (3) a Letter dated September 27, 2016.

II. Reasons Why Termination is Appropriate

Termination is appropriate because the Parties are jointly requesting termination and because the Board has not yet “decided the merits of the proceeding.” 35 U.S.C. § 317(a). The Board has not held an Oral Hearing or issued a final written decision.

Termination is also appropriate because the Parties have settled all of their disputes involving the ’341 patent. *See Office Patent Trial Practice Guide*, 77 Fed.

Reg. 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a 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.”). The Parties have agreed to terminate the present IPR proceeding, and all parties to the related district court action (*Murata Machinery USA, Inc. et al. v. Daifuku Co., Ltd. et al.*, Case 2:13-cv-00866 (D. Utah)) have agreed to stipulate to dismissal of the related court action.

Further, termination is appropriate because Petitioner will not continue to participate in the present IPR proceeding even if it is not terminated. *See id.* (“If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).”).

III. Status of Related Proceedings

On February 19, 2015, in the related court action, Murata Machinery, Ltd. and Murata Machinery USA, Inc. filed an amended complaint (Ex. 1002) against Petitioner, alleging infringement of the ’341 patent. Pursuant to the Settlement Agreement, all of the parties to that litigation are filing a joint stipulation of dismissal.

There is no IPR proceeding that is related to the present IPR proceeding.

IV. The Parties Will Not Continue to Participate in This Proceeding

As mentioned above, Petitioner will not continue to participate in the present IPR proceeding even if this Joint Motion is not granted. Similarly, Patent Owner will not continue to participate in the present IPR proceeding.

V. Request to Treat Settlement Agreement as Business

Confidential Information

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), Petitioner and Patent Owner jointly request that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the '341 patent. In view of this request, the Settlement Agreement has been filed for access by the "Parties and Board Only."

VI. Conclusion

For the foregoing reasons, Petitioner and Patent Owner respectfully request the Board terminate the present IPR proceeding and treat the Settlement Agreement as business confidential information and keep the documents separate from the file of the '341 patent.

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