

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CANON INC., CANON U.S.A., INC.,
CANON FINANCIAL SERVICES, INC., FUJIFILM CORPORATION,
FUJIFILM HOLDINGS AMERICA CORPORATION,
FUJIFILM NORTH AMERICA CORPORATION, JVC KENWOOD
CORPORATION, JVC KENWOOD USA CORPORATION,
NIKON CORPORATION, NIKON INC., OLYMPUS CORPORATION,
OLYMPUS AMERICA INC., PANASONIC CORPORATION,
PANASONIC CORPORATION OF NORTH AMERICA,
SAMSUNG ELECTRONICS CO., LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and
LG ELECTRONICS INC.,
Petitioner,

v.

PAPST LICENSING GMBH & CO. KG,
Patent Owner.

Case IPR2016-01225¹
Patent 8,966,144 B2

Before JONI Y. CHANG, JENNIFER S. BISK, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate as to LG Electronics, Inc.
37 C.F.R. § 42.74

¹ Case IPR2017-00672, filed by LG Electronics, Inc., was joined with this proceeding on May 24, 2017. IPR2017-00672, Paper 9.

Joint Petitioner, LG Electronics, Inc. (“LG”), and Patent Owner, Papst Licensing GmbH & Co. KG (“Papst”), jointly move to terminate the instant *inter partes* review with respect to LG in light of the settlement between Papst and LG that resolves their dispute regarding U.S. Patent No. 8,966,144 B2 (“the ’144 patent”). Paper 32 (“Mot.”). LG and Papst also filed a true copy of their written settlement agreement in connection with the termination as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Ex. 2012. Pursuant to 37 C.F.R. § 42.74(c), the parties further filed a joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent. Paper 33.

For the reasons set forth below, the Joint Motion to Terminate with respect to LG, and the Joint Request to File Settlement Agreement as Business Confidential Information are *granted*.

Under the Leahy-Smith America Invents Act Pub. L. No. 112-29, 125 Stat. 284 (September 16, 2011), settlement between the parties to a proceeding is encouraged. Notably, 35 U.S.C. § 317(a), in part, provides the following (emphasis added):

(a) IN GENERAL.—An *inter partes* review instituted under this chapter 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. If the *inter partes* review is terminated with respect to a petitioner under this section, *no estoppel under section 315(e) shall attach to the petitioner*, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that *inter partes* review.

Here, although the instant *inter partes* review has been instituted, we have not entered a final written decision in this proceeding. Upon review of the procedural posture of this proceeding and the facts before us, we

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determine that the parties' contentions have merit, and that it is appropriate to terminate this proceeding with respect to LG. The proceeding, however, will not be terminated with respect to Papst and as to other Petitioners remaining in the proceeding.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate, with respect to LG, is *granted*;

FURTHER ORDERED that this review is terminated with respect to LG only; but this review continues to proceed with Papst and the remaining Petitioners;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information and to keep such settlement agreement separate from the patent file, and to make it 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), is *granted*; and

FURTHER ORDERED that any subsequent papers filed in this *inter partes* review should not include LG as a Petitioner.

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PETITIONER:

David M. Maiorana
F. Drexel Feeling
Matthew W. Johnson
David L. Witcoff
Marc S. Blackman
JONES DAY
dmaiorana@jonesday.com
f.dfeeling@jonesday.com
mwjohanson@jonesday.com
dlwitcoff@jonesday.com
msblackman@jonesday.com

Gregory S. Cordrey
JEFFER MANGELS BUTLER & MITCHELL, LLP
gcordrey@jmbm.com

T. Vann Pearce, Jr.
Christopher J. Higgins
ORRICK, HERRINGTON & SUTCLIFFE LLP
TVPPTABDocket@orrick.com
chiggins@orrick.com

Dion Bregman
Ahren Hsu-Hoffman
Chris Mizumoto
MORGAN, LEWIS & BOCKIUS LLP
dion.bregman@morganlewis.com
Ahren.hsu-hoffman@morganlewis.com
chris.mizumoto@morganlewis.com

Brian C. Rupp
Carrie A. Beyer
Nikola Colic
DRINKER BIDDLE & REATH LLP
Brian.Rupp@dbr.com
Carrie.Beyer@dbr.com
Nick.Colic@dbr.com

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David Garr
Greg Discher
COVINGTON & BURLING LLP
dgarr@cov.com
gdischer@cov.com

PATENT OWNER:

Nicholas T. Peters
Paul Henkelmann
FITCH, EVEN, TABIN & FLANNERY LLP
ntpete@fitcheven.com
phenkelmann@fitcheven.com

Anthony L. Meola
THE MEOLA FIRM, PLLC
ameola@themeolafirm.com