

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN LIOWN ELECTRONICS CO., LTD.,

Petitioner,

v.

DISNEY ENTERPRISES, INC.,

Patent Owner.

CASE: IPR2016-01785
Patent No. 8,721,118 B2

**JOINT MOTION OF PETITIONER AND PATENT OWNER TO
TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. §317 AND 37
C.F.R. §42.74**

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. §317 and 37 C.F.R. § 42.74, and the Board's authorization provided on July 20, 2017, Petitioner Shenzhen Liown Electronics Co., Ltd. ("Petitioner") and Patent Owner Luminara Worldwide LLC¹ ("Patent Owner") (collectively, the "Parties") jointly request termination of *Inter Partes* Review No. IPR2016-01785 pursuant to settlement. As there are no other petitioners in this proceeding and the proceeding is still at an early stage, the Parties respectfully submit that termination of this proceeding is appropriate.

STATEMENT OF FACTS

Petitioner filed its petition in this proceeding for *Inter Partes* Review of U.S. Patent No. 8,721,118 (the "'118 Patent") on September 14, 2016. No other petitions related to the '118 Patent are pending.

The Board issued its institution decision on April 3, 2017. The Patent Owner has not yet filed its Response, which is due on July 26, 2017.

Petitioner and Patent Owner have reached a Settlement Agreement to end their disputes in this proceeding and the underlying litigation. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the agreement between the Parties is in

¹ Luminara was the exclusive licensee of U.S. Patent No. 8,721,118 and given authority by prior assignee Disney Enterprises, Inc. to defend the patent in this *inter partes* review proceeding. See Paper 6, App. 1. Recently, on July 10, 2017, Disney assigned the patent to Luminara (see Reel / Frame: 042991 /0508).

writing, constitutes the entire understanding and agreement between the Parties, and a copy of the Settlement Agreement is submitted herewith as Exhibit 1033.

In a separate motion, filed concurrently herewith, the Parties jointly request that the Settlement Agreement filed as Exhibit 1033 be treated as business confidential information and kept separate from the underlying patent file, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to maintain confidentiality of the Settlement Agreement.

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).

The Board should terminate this proceeding as the Parties jointly request, for the following reasons.

1. Brief Explanation as to Why Termination Is Appropriate

The Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35

U.S.C. § 317(a). The proceeding is still at an early stage. The Board entered an institution decision as to claims 1, 3, 8, and 10 on April 3, 2017. The Patent Owner has not yet filed its Response, which is due on July 26, 2017.

The Parties have reached a settlement as to the '118 Patent to end this dispute. A copy of the confidential Settlement Agreement pertaining to this case is filed concurrently herewith. *See* Ex. 1033. The Parties further jointly certify that there is no other agreement or understanding between them beyond Exhibit 1033 made in connection with, or in contemplation of, the termination of the instant proceeding as set forth in 35 U.S.C. §317(b).

The Parties respectfully submit that termination of this proceeding is appropriate because (a) this proceeding is at an early stage and no motions are outstanding; (b) the Parties have reached agreement to end their dispute concerning the '118 Patent; (c) the Parties have agreed to dismiss the related district court litigation between themselves with respect to the '118 Patent; (d) the Parties agree that this *Inter Partes* Review should be terminated; and (e) termination of this proceeding will preserve the Board's resources and obviate the need for any more Board involvement in the present proceeding.

2. Identity and Status of Parties in Related Litigation Involving the Patent

The '118 Patent was in dispute against Petitioner in *Luminara Worldwide, LLC v. Liown Electronics Co. Ltd. et al.*, Case 0:14-cv-03103-SRN-FLN (D. Minn.). This case has been dismissed pursuant to the Settlement Agreement between the Parties. There are no other current or contemplated pending litigation proceedings involving the '118 Patent.

3. Identity and Status of Any Related Proceedings Before the Office

No other petitions related to the '118 Patent are pending.

CONCLUSION

For at least the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this *Inter Partes* Review.

Dated: July 21, 2017

Respectfully submitted,

/Thomas N. Millikan/

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For Shenzhen Liown Electronics Co., Ltd.

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