

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT AND TRIAL AND APPEAL BOARD

Innolux Corporation,

Petitioner

v.

Vista Peak Ventures, LLC,

Patent Owner

CASE: IPR2019-00633

Patent No. 7,009,673

**JOINT MOTION TO TERMINATE
PROCEEDINGS UNDER 35 U.S.C. § 317(a)**

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. §§ 42.5, 42.71(a), 42.72, and 42.74, Petitioner Innolux Corporation and Patent Owner Vista Peak Ventures, LLC jointly request termination of this proceeding seeking *inter partes* review of U.S. Patent No. 7,009,673, *Inter Partes* Review Case No. IPR2019-00633. Under 37 C.F.R. § 42.20, authorization for this motion was provided by the Board on April 4, 2019.

The parties have resolved their dispute with respect to U.S. Patent No. 7,009,673 (the “Patent”). As required by 35 U.S.C. §§ 317(b) & 327(b), the parties are filing, concurrently herewith, a true copy of their Settlement Agreement as an exhibit in this proceeding. As outlined in the Settlement Agreement, the parties jointly agreed to terminate this proceeding.¹ Other than as indicated in the Agreement, there are no written or oral agreements or understandings, including any collateral agreements, between the parties, including but not limited to licenses, covenants not to sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of this proceeding. *See, e.g., General Growth Properties, Inc. et al. v. Peschke*, IPR 2013-00400, Paper 35 at 2-3 (Apr. 9, 2014). The parties have stipulated to dismiss all related litigation involving the Patent and no litigation or proceeding between the

¹ The Settlement Agreement has been filed electronically via E2E for “Parties and Board Only” to preserve confidentiality.

parties involving the Patent is contemplated in the foreseeable future. The parties are also filing concurrently herewith a joint request to treat the Agreement as business confidential information and to keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Board has discretion to dismiss “petitions under 37 C.F.R. §§ 42.5, 42.71(a) . . . to promote efficiency and minimize unnecessary costs.” *Samsung Elecs. Co., Ltd. v. Nvidia Corp.*, IPR2015-01270, Paper 11 at *4 (PTAB Dec. 9, 2015). In particular, the Board “may determine a proper course of conduct in a proceeding for any situation not specifically covered” and “take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.” 37 C.F.R. §§ 42.5, 42.71(a); *see also, e.g., FLIR Sys., Inc. v. Garmin Corp.*, IPR2018-1490, 2018 WL 5276319 (PTAB 2018) (dismissing petition based on petitioner’s unopposed motion). Termination of this proceeding is proper because this proceeding is still in its early stages, Vista Peak Ventures has not yet filed a Preliminary Response to the Petition (said preliminary response not being due until April 28, 2019), and the Board has not made a decision whether to institute an IPR trial in this proceeding. Dismissing the Petition will “promote efficiency and minimize unnecessary costs” by avoiding the expenditure of resources required to address the Petition on its merits. Further, the parties are unaware of any other matter before the USPTO that would be affected

by the outcome of this proceeding. Accordingly, the parties respectfully request termination of this proceeding.

Respectfully submitted,

/Jeffrey L. Johnson/

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDINGS UNDER 35 U.S.C. § 317(a)** has been served via electronic mail on April 16, 2019, upon the following:

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Dated: April 16, 2019

/Karen Johnson/

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