

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC. AND LG ELECTRONICS USA, INC.,
Petitioners,

v.

MAXELL, LTD,
Patent Owner.

Case No. IPR2025-00444
Patent No. 8,736,729

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

- LG-1001 U.S. Patent No. 8,736,729 to Takahiro Nakano, et al. (“the ’729 Patent”)
- LG-1002 Excerpts from the Prosecution History of the ’729 Patent (“the Prosecution History”)
- LG-1003 Declaration and Curriculum Vitae of W. Leo Hoarty
- LG-1004 Complaint, *Maxell, Ltd. v. LG Electronics Inc. et al*, 5-23-cv-00152, E.D. Tex., filed December 29, 2023
- LG-1005 U.S. Patent No. 5,444,482 (Misawa)
- LG-1006 U.S. Patent No. 6,292,218 (Parulski)
- LG-1007 U.S. Patent No. 6,963,361 (Kawahara)
- LG-1008 U.S. Patent No. 6,690,881 (Tomita)
- LG-1009 RESERVED
- LG-1010 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)
- LG-1011 Federal Court Management Statistics - Profiles (June 30, 2024)
- LG-1012 Prosecution History of Reexamination Control No. 90/014,628
- LG-1013 Confidential Settlement Agreement

Petitioners LG Electronics Inc. and LG Electronics U.S.A., Inc. (“LG” or “Petitioners”) and Patent Owner Maxell, Ltd. (“Maxell” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, LG and Maxell move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

LG and Maxell (collectively, the “Settling Parties”) have reached an agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1013. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “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.” *Id.* (citing 35 U.S.C. §§ 317(a)).

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

First, LG and Maxell 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). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, LG and Maxell have reached a settlement as to all the disputes in this proceeding and as to the ’729 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1013. LG and Maxell request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

Third, termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient

and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, LG and Maxell respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: July 1, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on July 1, 2025, a complete and entire copy of this Joint Motion to Terminate and Exhibit 1013 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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