

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEC DISPLAY SOLUTIONS OF AMERICA, INC.,
Petitioner,

v.

ULTRAVISION TECHNOLOGIES, LLC,
Patent Owner.

IPR2019-01123
Patent 9,349,306 B2

Before HUBERT C. LORIN, SCOTT A. DANIELS, and
JAMES A. WORTH, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

I. INTRODUCTION

A. Background

On June 6, 2019, NEC Display Solutions Of America, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 3–4, 6–8, 10, 12–14, 16–19, 21, 23, and 25–26 (the “challenged claims”) of U.S. Patent No. 9,349,306 B2 (Ex. 1003, “the ’306 patent”). On September 6, 2019, Ultravision Technologies, LLC (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

On December 2, 2019, we issued a decision instituting a trial in this proceeding. Paper 7 (hereinafter, “the Decision”). On the same day, we issued a decision denying institution in related co-pending Case IPR2019-01117 (Paper 7).

On December 6, 2019, the parties filed a joint motion to terminate the above-captioned proceeding (Paper 9, “Joint Motion to Terminate”) and a joint request to file the settlement agreement as confidential business information and to maintain said agreement separate from the public file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 10, “Joint Motion to Keep Separate”).

The parties indicate that the parties have settled their disputes, the parties have concurrently filed a written Settlement Agreement (Ex. 1023), which is true and complete, and that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioner, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding. Paper 9, 1. The parties further indicate that the ITC Case and the District Court Case are

concluded and Patent Owner does not have any litigations pending against Petitioner or any entities related to Petitioner. *Id.* at 3.

Thus, we understand that the filed agreement settles all disputes between the parties with respect to this proceeding. We observe that the time has not yet elapsed for the parties to seek rehearing under 37 C.F.R. § 42.71 of our Decision. Under these circumstances, we determine that good cause exists to grant the motion to terminate.

ORDER

Accordingly, it is

ORDERED that the Joint Motion to Terminate is *granted*;

FURTHER ORDERED that Joint Motion to Keep Separate is *granted*;

FURTHER ORDERED that the Termination Agreement included in Ex. 1023 shall be treated as business confidential information, to be kept separate from the patent file; and

FURTHER ORDERED that the case is *terminated*.

IPR2019-01123
Patent 9,349,306 B2

For PETITIONER:

Stuart W. Yothers
Matthew Johnson
JONES DAY
syothers@jonesday.com
mwjohnson@jonesday.com

For PATENT OWNER:

Peter Lambrianakos
Vincent J. Rubino, III
Joseph M. Mercadante
Timothy J. Rousseau
Enrique W. Iturralde
John A Rubino
BROWN RUDNICK LLP
plambrianakos@brownrudnick.com
vrubino@brownrudnick.com
jmercadante@brownrudnick.com
trousseau@brownrudnick.com
eiturralde@brownrudnick.com
jrubino@brownrudnick.com