

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZHUHAI COSMX BATTERY CO., LTD.
Petitioner,

v.

MAXELL, LTD.,
Patent Owner.

IPR2023-00226
Patent 9,166,251

**UNOPPOSED MOTION TO DISMISS PETITION FOR
INTER PARTES REVIEW**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.71(a), Petitioner Zhuhai CosMX Battery Co., Ltd. moves, unopposed, to dismiss its petition for *inter partes* review (“IPR”). The Board authorized the filing of this unopposed motion in an email dated March 3, 2023.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The parties settled their underlying dispute and reached agreement to end this IPR in a written agreement. A true copy of that agreement is submitted as Exhibit 1022 in accordance with 37 C.F.R. § 42.74(b). The parties executed two other related agreements that fall within the scope of 37 C.F.R. § 42.74(b), and true copies of those are submitted as Exhibits 1023 and 1024, respectively.

There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the proceeding.

By a separate paper, authorized by the Board, the parties jointly request that each of these agreements be treated as business confidential information, to be kept separate from the file of the involved patent, and to be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 37 C.F.R. § 42.74(c).

The parties are jointly requesting dismissal of *Maxell, Ltd. v. Zhuhai CosMX Battery Co., Ltd.*, No. 6:21-cv-00845-ADA (W.D. Tex. Aug. 13, 2021) (the “Court Action”), which is currently stayed and in which U.S. Patent No. 9,166,251 (the

“’251 Patent”) is asserted. Other than the Court Action, there are no litigation matters or proceedings between the parties involving the ’251 Patent. There are other disputes still pending involving the ’251 Patent and Patent Owner, as set forth in Paper 5 (Patent Owner’s Mandatory Notices).

This IPR is in its preliminary stage as Patent Owner has not filed a preliminary response and the Board has not yet reached the merits or issued a decision on institution. Accordingly, dismissing the petition at this time would preserve both the Board’s and the parties’ resources in accordance with the intent of 37 C.F.R. § 42.1(b) “to secure the just, speedy, and inexpensive resolution [of] every proceeding.” Good cause therefore exists to dismiss the petition.

Furthermore, dismissal of the petition will be a just resolution because Patent Owner will not be prejudiced by such dismissal and the subsequent termination of this IPR, as evidenced by the underlying settlement and Patent Owner’s agreement not to oppose this motion.

Thus, Petitioner respectfully submits that dismissal of the petition is appropriate under 37 C.F.R. § 42.71(a).

Dated: March 7, 2023

/Eagle H. Robinson/

Eagle H. Robinson (Reg. No. 61,361)

Lead Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), true copies of this UNOPPOSED MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW and Exhibits 1022-1024 are being served electronically on March 7, 2023 to the following lead and back-up counsel for Patent Owner at the following email addresses:

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