UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCL Communication Technology Holdings Limited
TCT Mobile International Limited
TCT Mobile, Inc.
TCT Mobile (US) Inc.
TCT Mobile (US) Holdings Inc.,

Petitioner,

v.

Mitsubishi Electric Corporation

Patent Owner.

IPR2023-00997

Patent 10,200,976

PARTIES' JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 37 C.F.R. § 42.74

Pursuant to 37 C.F.R. § 42.74 and the Board's email authorization on July 24, 2024, Petitioners TCL Communication Technology Holdings Limited, TCT Mobile International Limited, TCT Mobile, Inc., TCT Mobile, (US) Inc., and TCT Mobile (US) Holdings Inc. (collectively, "TCL") and Patent Owner Mitsubishi Electric Corporation (collectively, "the Parties") jointly request termination of the proceedings in IPR2023-00997 in light of the parties' settlement agreement. The settlement agreement has resolved any claim by Patent Owner that Petitioner infringes claims of U.S. Patent No. 10,200,976 (the '976 Patent) that is the subject of these proceedings.

Patent Owner has entered into a confidential written settlement agreement with Petitioner, which settles all disputes between Petitioner and Patent Owner regarding the '976 Patent, including those relating to this proceeding. The agreement resolving the disputes between the Petitioner and Patent Owner ("Settlement Agreement") is being filed concurrently herewith as Exhibit 1037.

Termination is proper for at least the following reasons:

- The Board has not yet "decided the merits of the proceeding before the request for termination is filed." See 35 U.S.C. § 317(a); Consolidated Trial Practice Guide (Nov. 2019) ("Trial Practice Guide") at 86 ("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.”). And 35 U.S.C. § 317(a) provides that even “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Here, the Board has not yet issued a final decision.

- All Parties are jointly requesting termination. Trial Practice Guide at 86 (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”).
- The only other proceeding involving the ’976 Patent, *Mitsubishi Electric Corporation et al. v. TCL Communication Technology Holdings Limited et al.*, Case No. 8:22-cv-01073-GW-DFM (C.D. Cal.), will be dismissed with prejudice pursuant to the settlement.
- Aside from the proceedings identified above, the Parties are unaware of any other pending proceedings relating to the ’976 Patent before the Board, or any other matter before the USPTO that would be affected by the requested termination of this proceeding.
- IPR terminations pursuant to settlement have been granted even where argument had already taken place before the Board. *See, e.g., Callidus Software Inc. v. Versata Software Inc.*, CBM2013-00052, Paper 50 (PTAB

Nov. 24, 2014) (terminating proceeding after Oral Argument); *Clio USA, Inc. v. Procter & Gamble Co.*, IPR2013-00438, Paper 57 (PTAB Oct. 31, 2014) (same). In the instant action, arguments have not yet taken place before the Board.

As required by statute and as directed by the Board, the parties are filing concurrently herewith, as a separate submission, a Joint Request to Treat Settlement Agreement as Business Confidential and to Keep Separate, pursuant to 35 U.S.C. § 317(b), along with the true copy of the written settlement agreement. The Parties request that the settlement agreement, Exhibit 1037, be treated as business confidential information, be kept separate from the files of the involved patent and be made available only to the Federal Government agencies on written request, or to any person on showing of good cause under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b)-(c). The Parties certify that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

For the foregoing reasons, the Parties jointly and respectfully request that the Board terminate the instant proceeding.

Dated: July 26, 2024

Respectfully submitted,

/Jeremy D. Peterson/
Jeremy D. Peterson

/Marc Weinstein/
Marc Weinstein

Registration No. 52,115
Counsel for Petitioner

Registration No. 43,250
Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4), the undersigned certifies that on July 26, 2024, the foregoing document was served via electronic mail on the following attorneys of record at the indicated e-mail addresses:

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