UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DJI EUROPE B.V.,

Petitioner

v.

TEXTRON INNOVATIONS INC.,

Patent Owner.

IPR2023-01104

U.S. Patent 8,682,505

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

EXHIBIT LIST

Exhibit	Reference
1001	U.S. Patent 8,682,505 to Christensen et al. (“the ’505 patent”)
1002	File History of U.S. Patent 8,682,505
1003	Declaration of Dr. William Singhose in Support of Petition for *Inter Partes* Review of U.S. Patent 8,682,505
1004	CV of Dr. William Singhose
1005	U.S. Patent 5,553,812 to Gold, et al. (“Gold”)
1006	U.S. Patent 5,238,203 to Skonieczny, et al. (“Skonieczny”)
1007	U.S. Patent 5,065,962 to Adams, et al. (“Adams”)
1008	Reserved
1009	Reserved
1010	Reserved
1011	EP 2673681 B1 to Christensen, et al (“Companion EP Patent”)
1012	Prosecution History of EP 2673681
1013	U.S. Patent Publication 2010/0324758 to Piasecki, et al (“Piasecki”)
1014	U.S. Patent 5,001,646 to Caldwell, et al (“Caldwell”)
1015	U.S. Department of Transportation, Federal Aviation Administration, “Rotorcraft Flying Handbook”, FAA-H-8083-21 (2000)
1016	U.S. Department of Transportation, Federal Aviation Administration, “Helicopter Flying Handbook”, FAA-H-8083-21B (2019) (“Helicopter Flying Handbook”)
1017	Excerpts from “Aircraft Dynamics and Automatic Control” by McRuer, et al (Princeton Legacy Library 1973) (“McRuer”)
1018	“Flight Stability and Automatic Control”, Second Edition, by Nelson (WCB/McGraw-Hill 1998) (“Nelson”)
1019	“Mechanics of Flight” by Phillips (John Wiley & Sons 2004) (“Mechanics of Flight”)

Exhibit	Reference
1020	"Advanced Flight Control Research and Development at Boeing Helicopters" by Landis, et al in "Advances in Aircraft Flight Control" (1996)
1021	"The Characteristics of Model-Following Systems as Synthesized by Optimal Control" by Tyler, IEEE Transactions on Automatic Control, October 1964 ("Tyler")
1022	"Input-Shaping and Model-Following Control of a Helicopter Carrying a Suspended Load" by Adams, et al, Journal of Guidance, Control, and Dynamics, Vol. 38, No. 1, January 2015 ("Adams")
1023	Excerpt from "Dynamics of Helicopter Flight" by Saunders (1975)
1024	"Helicopter Aerodynamics-Aircraft Theory of Flight"
1025	Notice of Sotera *Stipulation, Textron Innovations Inc. v. SZ DJI Technology Co. Ltd.*, No. 22-cv-0351-RWS-RSP (E.D. Tex.)
1026	Settlement Agreement

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, and the Board's authorization via email on February 22, 2024, Petitioner DJI Europe B.V. ("Petitioner" or "DJI") and Patent Owner Textron Innovations Inc. ("Patent Owner" or "Textron"), jointly move that the Board terminate the above-captioned proceeding as a result of a settlement between Petitioner and Patent Owner.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit concurrently herewith a true and correct copy of the Confidential Settlement Agreement governing the resolution of this *inter partes* review and the underlying litigation. (*See* Confidential DJI-1026). There are no other collateral agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

The parties are concurrently filing a joint request that the Confidential Settlement Agreement be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 42.74(c). In view of that request, DJI-1026 has been filed as available to "Parties and Board Only."

II. ARGUMENT

A joint motion to terminate generally must "(1) include a brief explanation as

to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding." *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB July 28, 2014).

A. Brief Explanation as to Why Termination Is Appropriate

Good cause exists to terminate this proceeding. "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." Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 86; *see also id.* ("There are strong public policy reasons to favor settlement between the parties to a proceeding."); 35 U.S.C. § 317(a) ("An *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 parties respectfully submit that termination is appropriate because they have reached an agreement that resolves all disputes between the parties involving U.S. Patent No. 8,682,505 (the "'505 Patent") at issue in the above-captioned *inter partes* review and the Board has not issued a final written decision or decided the merits of the proceeding. Moreover, the parties

filed a Joint Stipulation for Dismissal in the United States District Court for the Eastern District of Texas on February 27, 2024 in the underlying lawsuit styled *Textron Innovations Inc. v. SZI DJI Technology Co., Ltd., et al.*, Case No. 2-22-cv-00351 (E.D. Tex.). The parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

B. Identification of Parties and Status of Litigation

As noted above, a Joint Stipulation of Dismissal with Prejudice has been filed in the underlying district court litigation between the parties, captioned *Textron Innovations Inc. v. SZI DJI Technology Co., Ltd., et al.*, Case No. 2-22-cv-00351 (E.D. Tex.). Patent Owner is the plaintiff in the district court litigation. Petitioner is a named defendant in the district court litigation, along with SZ DJI Technology Co., Ltd., SZ DJI Baiwang Technology Co. Ltd., and iFlight Technology Company Ltd. SZ DJI Technology Co., Ltd., SZ DJI Baiwang Technology Co. Ltd., and iFlight Technology Company Ltd. were identified as real parties-in-interest by Petitioner (along with DJI Technology, Inc. and DJI Research LLC). Paper 2 at 92. DJI Europe B.V. is the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion. Further, the '505 Patent is not involved in any other pending litigation.

C. Identification and Status of Proceedings Before the USPTO

The Board has not issued an institution decision in this proceeding. The parties have now resolved their dispute related to the '505 Patent and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-01105 (concerning related U.S. Patent No. 8,332,082) and IPR2023-01227 (concerning U.S. Patent No. 11,288,972).[1] The parties are also jointly moving to terminate IPR2023-01105 and IPR2023-01227. The USPTO can conserve its resources by terminating now, removing the need for the Board to further consider the arguments.

III. CONCLUSION

For the reasons set forth above, Petitioner and Patent Owner have complied with the requirements of 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, and it is appropriate for the Board to terminate the above-captioned *inter partes* review proceeding. Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to terminate the above-captioned proceeding.

---

[1] Petitioner also filed two petitions for *inter partes* review of another of Patent Owner's patents involved in the district court litigation in IPR2023-01106 and IPR2023-01107 (both concerning U.S. Patent No. 10,275,950). On February 13, 2024, the Board denied institution in both IPR2023-01106 and IPR2023-01107.

Respectfully submitted,

/Brian W. Oaks/

Brian W. Oaks
Reg. No. 44,981
Attorney for Patent Owner

MCDERMOTT WILL & EMERY
303 Colorado Street, Suite 2200
Austin, TX 78701

/Lori A. Gordon/

Lori A. Gordon
Reg. No. 50,633
Attorney for Petitioner

PERKINS COIE LLP
700 Thirteenth Street, NW, Suite 800
Washington, DC 2005

Date: February 29, 2024

CERTIFICATE OF SERVICE

The undersigned certifies that a true copy of the **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72** and DJI-1026 were served electronically on February 29, 2024, in its entirety on the following counsel of record for Patent Owner:

Brian W. Oaks
boaks@mwe.com
Morgan Mayne
morgan.mayne@bakerbotts.com
Jeffery S. Becker
jeff.becker@bakerbotts.com
Clarke Stavinoha
clarke.stavinoha@bakerbotts.com

Respectfully submitted,

/Lori A. Gordon/

Lori A. Gordon
Attorney for Petitioner

Date: February 29, 2024