

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOE TECHNOLOGY GROUP CO., LTD, BEIJING BOE DISPLAY TECHNOLOGY CO., and MOTOROLA (WUHAN) MOBILITY TECHNOLOGIES COMMUNICATION CO., LTD.,
Petitioner,

v.

ELEMENT CAPITAL COMMERCIAL COMPANY PTE. LTD,
Patent Owner.

Case IPR2023-01178
Patent 7,259,736

JOINT MOTION TO DISMISS PETITION

EXHIBITS

EX-1001	U.S. Patent No. 7,259,736 to Hayato Nakanishi (“the ’736 patent”)
EX-1002	Excerpts from the Prosecution History of the ’736 Patent (“the Prosecution History”)
EX-1003	Declaration of Dr. David K. Liu
EX-1004	U.S. Patent No. 5,831,699 (“Wright”)
EX-1005	Prosecution History of JP2002-348622 (“the Foreign Counterpart Prosecution History”)
EX-1006	Certified Translation of Pages 1-10, 50-58 from the Foreign Counterpart Prosecution History
EX-1007	Certified Translation of Pages 63-79 from the Foreign Counterpart Prosecution History
EX-1008	JPH11185654A to Yukio Masuda et al (“Masuda”)
EX-1009	Certified Translation of Masuda
EX-1010	JP2002-278504A to Mitsuo Inoue et al (“Inoue”)
EX-1011	Certified Translation of Inoue
EX-1012	KR960012168A to Yang-Ho Kwon (“Kwon”)
EX-1013	Certified Translation of Kwon
EX-1014	Sarma et al., “Flat Panel Displays for Portable Systems,” 13 <i>Journal of VLSI Signal Processing Systems</i> 165-190 (1996)

- EX-1015 Complaint, *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.)
- EX-1016 Docket Control Order, *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.)
- EX-1017 Plaintiff's Infringement Contentions, served on January 5, 2023 in *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.)
- EX-1018 2023-05-31 Email from Patent Owner to Petitioner
- EX-1019 2023-06-29 Email Thread Between Patent Owner and Petitioner Memorializing Agreement re Second IPR Petition
- EX-1020 U.S. Published App. No 2003/0090447 to Hajime Kimura ("Kimura")
- EX-1021 Joint Motion to Dismiss in *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.) February 26, 2024
- EX-1022 Order Granting Joint Motion to Dismiss in *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.) February 26, 2024

The Parties in this case have resolved their dispute regarding the patent involved in this proceeding and have filed a joint motion to dismiss the related district court litigation styled *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.), where U.S. Patent No. 7,259,736 (“the ’736 patent”) was previously asserted by Patent Owner. The Parties therefore contacted the Board on February 26, 2024 to inform the Board and request instructions regarding dismissal of this proceeding. In accordance with the Board’s email instructions received on February 26, 2024, the Parties hereby jointly submit this motion to dismiss. The Parties respectfully request that the Board terminate IPR2023-01178 to preserve the Board’s and parties’ resources and to achieve a just, speedy, and inexpensive resolution to this dispute.

Pursuant to 35 U.S.C. § 317(b), 37 C.F.R. § 42.74, and the Board’s e-mail, the Parties are concurrently filing the Joint Motion to Dismiss and Order Granting Joint Motion to Dismiss as entered in the corresponding litigation *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.) both entered on February 26, 2024 (Exhibits 1021 and 1022, respectively). The Parties state that there are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the proceeding.

I. Background

On July 7, 2023, Petitioner filed a petition for *inter partes* review of the '736 patent. *See* IPR2023-01178, Paper 4. On December 7, 2023, Patent Owner filed a preliminary response. *See* IPR2023-01178, Paper 9. On December 21, 2023, Petitioner filed its pre-institution reply. *See* IPR2023-01178, Paper 10. On January 3, 2024, Patent Owner filed its pre-institution sur-reply. *See* IPR2023-01178, Paper 11. The Board has not issued an institution decision. On February 26, 2024, the parties filed a joint motion to dismiss all claims, including those related to the '736 patent, in the district court litigation styled *Element Capital Commercial Company PTE. Ltd. v. BOE Technology Group Co., Ltd. et al.*, Case No. 2:22-cv-0118-JRG (E.D. Tex.), where the '736 patent was asserted. Once the dismissal papers were finalized and submitted in the related district court litigation, the Parties emailed the Board to request termination of IPR2023-01178.

II. Termination of IPR2023-01178 is Appropriate

The Board “may terminate a trial without rendering a final written decision, where appropriate.” 37 C.F.R. § 42.72. Further, the rules governing IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Id.* § 42.1(b). Termination of this IPR is appropriate as the Board has not yet “decided the merits of the proceeding” on the record noted above. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768

(Aug. 14, 2012). No dispute remains between Patent Owner and Petitioner involving the '736 patent. Patent Owner has filed a motion to dismiss the related district court litigation with prejudice, and the parties jointly seek termination of IPR2023-01178. As such, the dispute at the center of the IPR no longer remains between the parties, and the Board's decision on the IPR is no longer necessary. Termination also further promotes the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012). Permitting termination as to all parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation.

III. Conclusion

For all the reasons stated above, Patent Owner and Petitioner respectfully request that the Board dismiss the underlying Petition and terminate IPR2023-01178.

Respectfully submitted,

Dated March 1, 2024

/Jeremy J. Monaldo/

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Respectfully submitted,

Dated March 1, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on March 1, 2024, a complete and entire copy of this Joint Motion to Dismiss and Exhibits 1021-1022 were provided by email, to the Patent Owner by serving the correspondence addresses of record as follows:

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