

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXTRON SPECIALIZED VEHICLES INC.

Petitioner

v.

SZ DJI TECHNOLOGY CO. LTD.

Patent Owner

Case IPR 2023-01217
U.S. Patent No. 11,462,116

**JOINT MOTION TO TERMINATE *INTER PARTES REVIEW* OF
U.S. PATENT 11,462,116 UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.72**

Submitted Electronically

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner Textron Specialized Vehicles Inc. (“TSV”) and Patent Owner SZ DJI Technology Co. Ltd. (“DJI”) jointly request dismissal and termination of this *Inter Partes Review* of U.S. Patent 11,462,116.

On February 22, 2024, the Parties informed the Board of the resolution via email and indicated their intent to file a motion to terminate the petition with respect to both the Patent Owner and the Petitioner and file a copy of the agreement, subject to a motion to keep the agreement confidential and separate from the file of U.S. Patent 11,462,116. As set forth in an email dated February 23, 2024, the Board authorized the filing of the joint motion to terminate this proceeding. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

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

Petitioner and Patent Owner have entered into a written confidential agreement that fully resolves this matter. The Parties are concurrently filing a copy of the agreement as Exhibit 1011 along with a motion to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. In view of that request, Exhibit 1011 has been filed for access by “Parties and Board Only.”

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1011 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1011 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The parties “may terminate the proceeding ..., unless the Board has already decided the merits of the proceeding.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 4 (Nov. 2019). Patent Owner has yet to file its Response, and the Board has yet to decide the merits of this proceeding. The parties have now settled their dispute and have reached agreement to terminate the Petition.

Public policy favors terminating the present Petition for *Inter Partes Review*. Congress and federal courts have expressed a strong interest in encouraging

settlement in litigation. *See Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dep’t of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. United States*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to mitigate antagonism and hostility between parties). And the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

This *Inter Partes Review* is related to SZ DJI Technology Co. Ltd. v. Textron Specialized Vehicles Inc., C.A. No. 23-55 (JNR) (D. Del.), which the parties will concurrently dismiss with prejudice. The parties are not aware of any other litigation involving the patent-at-issue.

C. Identification and Status of Proceedings Before the USPTO

On July 19, 2023, TSV filed its Petition for *Inter Partes Review* in IPR2023-01217. On October 24, 2023, DJI filed Patent Owner’s Preliminary Response (Paper No. 7). On January 23, 2024, the Board issued a Decision to Institute (Paper No. 11). Patent Owner’s response is due on April 16, 2024. *See* Paper No. 12.

TSV and DJI have now resolved their dispute and reached agreement to terminate this proceeding. Additionally, the parties are not aware of any other pending USPTO proceedings regarding the patent-at-issue. The USPTO can conserve its resources by terminating now, removing the need for the Board to further consider the arguments and to render a Final Written Decision. Therefore, the Parties respectfully request termination of this *Inter Partes Review* of U.S. Patent 11,462,116.

Date: February 27, 2024

Respectfully submitted,

/Brian W. Oaks/

/ Matthew A. Argenti /

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*Counsel for Petitioner
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CERTIFICATE OF SERVICE

The undersigned hereby certifies on February 27, 2024, a true and correct copy of the foregoing **JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT 11,462,116 UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.72** was served to the following counsel for Patent Owner by email:

Matthew Argenti (margenti@wsgr.com)
Richard Torczon (rtorczon@wsgr.com)

Date: February 27, 2024

Respectfully submitted,

/Brian W. Oaks/

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