

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DJI EUROPE B.V.
Petitioner,

v.

TEXTRON INNOVATIONS INC.
Patent Owner

IPR2023-01227

U.S. Patent 11,288,972

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

EXHIBIT LIST

Exhibit	Description
DJI-1001	U.S. Patent 11,288,972 to Bristow et al. (“’972 patent”)
DJI-1002	’972 patent file history
DJI-1003	Declaration of Charles F. Reinholtz, Ph.D. in support of Petition for <i>Inter Partes</i> Review
DJI-1004	Curriculum Vitae of Charles F. Reinholtz, Ph.D.
DJI-1005	Homola et al., “UTM and D-NET: NASA and JAXA’s Collaborative Research on Integrating Small UAS with Disaster Response Efforts” (“UTM-DNET”), <i>available at</i> https://ntrs.nasa.gov/api/citations/20180004805/downloads/20180004805.pdf
DJI-1006	U.S. Patent 9,852,642 to Butler et al. (“Butler”)
DJI-1007	U.S. Patent 9,658,619 to Bethke et al. (“Bethke”)
DJI-1008	Declaration of Trenton J. Roche regarding UTM-DNET
DJI-1009	NASA Technical Reports Server Record Details for UTM-DNET, <i>available at</i> https://ntrs.nasa.gov/citations/20180004805
DJI-1010	2018 Aviation Technology, Integration, and Operations Conference Table of Contents, <i>available at</i> https://arc.aiaa.org/doi/book/10.2514/MATIO18
DJI-1011	AIAA details for UTM-DNET (AIAA 2018-3987), <i>available at</i> https://doi.org/10.2514/6.2018-3987
DJI-1012	U.S. Patent App. Pub. 2015/0234387 to Mullan et al.
DJI-1013	Exhibit D to Plaintiff Textron Innovations Inc.’s P.R. 3-1 and 3-2 Disclosure of Asserted Claims, Infringement Contentions, and Document Production, <i>Textron Innovations Inc. v. SZ DJI Tech. Co., Ltd.</i> , Civil Action No. 2:22-cv-00351 (E.D. Tex. Sept. 9, 2022)
DJI-1014	Kopardekar et al., “Unmanned Aerial System (UAS) Traffic Management (UTM): Enabling Low-Altitude Airspace and UAS Operations,” <i>available at</i> https://ntrs.nasa.gov/api/citations/20140013436/downloads/20140013436.pdf

Exhibit	Description
DJI-1015	NASA Facts. “UTM: Air Traffic Management for Low-Altitude Drones” (2015), <i>available at</i> https://www.nasa.gov/sites/default/files/atoms/files/utm-factsheet-02-23-16.pdf
DJI-1016	Rios et al., “UTM Data Working Group Demonstration 1 Final Report” (April 2017), <i>available at</i> https://ntrs.nasa.gov/api/citations/20170010270/downloads/20170010270.pdf
DJI-1017	Rios et al., “Unmanned Aircraft Systems Traffic Management (UTM) Concepts and Architecture Overview” (March 2018), <i>available at</i> https://ntrs.nasa.gov/api/citations/20180001929/downloads/20180001929.pdf
DJI-1018	Kopardekar et al., “Unmanned Aircraft System Traffic Management (UTM) Concept of Operations” (June 2016), <i>available at</i> https://ntrs.nasa.gov/api/citations/20190000370/downloads/20190000370.pdf
DJI-1019	RESERVED
DJI-1020	RESERVED
DJI-1021	RESERVED
DJI-1022	RESERVED
DJI-1023	RESERVED
DJI-1024	RESERVED
DJI-1025	Jiang et al., <i>Unmanned Aircraft System traffic management: Concept of operation and system architecture</i> , International Journal of Transportation Science and Technology, 5.3, pp. 123-35 (2016)
DJI-1026	RESERVED
DJI-1027	“Unmanned Aircraft System Traffic Management (UTM) Research Transition Team Concept Working Group, Concept & Use Cases Package #2: Technical Capability Level 3, Version 1.0” (March 2018), <i>available at</i> https://ntrs.nasa.gov/api/citations/20190004908/downloads/20190004908.pdf .
DJI-1028	“Enabling Civilian Low-Altitude Airspace and Unmanned Aerial System (UAS) Operations by UTM” (March 23, 2015), <i>available</i>

Exhibit	Description
	<i>at</i> https://ntrs.nasa.gov/api/citations/20160000434/downloads/20160000434.pdf .
DJI-1029	“Safely Enabling Low-Altitude Airspace Operations” (June 23, 2015), <i>available at</i> https://ntrs.nasa.gov/api/citations/20150018862/downloads/20150018862.pdf .
DJI-1030	U.S. Patent App. Pub. 2016/0275801 to Kopardekar
DJI-1031	Webster’s New World Dictionary of Computer Terms (8 th edition) (excerpt)
DJI-1032	Chinese Patent App. Pub. CN 105334863 to Yang
DJI-1033	Notice of Sotera <i>Stipulation, Textron Innovations Inc. v. SZ DJI Technology Co. Ltd.</i> , No. 22-cv-0351-RWS-RSP (E.D. Tex.)
DJI-1034	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-1034). 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-1034 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. 11,288,972 (the “’972 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 81. 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 '972 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 '972 Patent and reached agreement to terminate this proceeding as well as *inter partes* review proceedings IPR2023-01104 (concerning U.S. Patent No. 8,682,505) and IPR2023-01105 (concerning U.S. Patent No. 8,332,082).¹ The parties are also jointly moving to terminate IPR2023-01104 and IPR2023-01105. 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/

/Lori A. Gordon/

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

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

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

PERKINS COIE LLP
700 Thirteenth Street, NW, Suite 800
Washington, DC 20005

Date: February 29, 2024

CERTIFICATE OF SERVICE

The undersigned certifies that true copies of the **JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72** and **DJI-1034** 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
Harrison Rich
harrison.rich@bakerbotts.com
Ellyar Y. Barazesh
ellyar.barazesh@bakerbotts.com

Respectfully submitted,

/Lori A. Gordon/

Lori A. Gordon
Attorney for Petitioner

Date: February 29, 2024