

From: [Trials](#)
To: [Gerald Hryczyn](#); [Trials](#); [Woo, Philip](#)
Cc: [SMcKeown-PTAB@WolfGreenfield.com](#); [GHryczyn-PTAB@WolfGreenfield.com](#); [VCheung-PTAB@WolfGreenfield.com](#); [Bartow, D. Stuart](#); [Belnap, Paul H.](#)
Subject: RE: IPR2024-01277, Apple Inc. v NL Giken Inc. - Termination Request
Date: Monday, October 28, 2024 11:39:10 AM
Attachments: [image001.png](#)

Counsel,

From the Board –

The parties are authorized to file a Joint Motion To Terminate (as a Paper), and a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (as a separate Paper).

The Joint Motion To Terminate should reference this authorization. The Joint Motion To Terminate also must update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint Motion To Terminate must include a true copy, without redactions, of any agreement or understanding (as an Exhibit to the Motion) and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the *inter partes* review. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b).

Any Joint Request to File the Settlement Agreement As Business Confidential Information must be filed with the Joint Motion To Terminate. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Gerald Hryczyn <Gerald.Hryczyn@WolfGreenfield.com>
Sent: Friday, October 25, 2024 8:25 AM
To: Trials <Trials@USPTO.GOV>; Woo, Philip <PWWoo@duanemorris.com>
Cc: SMcKeown-PTAB@WolfGreenfield.com; GHryczyn-PTAB@WolfGreenfield.com; VCheung-PTAB@WolfGreenfield.com; Bartow, D. Stuart <DSBartow@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>
Subject: RE: IPR2024-01277, Apple Inc. v NL Giken Inc. - Termination Request

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Dear Honorable Board:

Patent Owner NL Giken Inc. is following up on the joint request below seeking leave to file a joint motion to terminate IPR IPR2024-01277 (in light of settlement) and a joint motion to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317.

Should the Board wish to discuss this request, please let us know and we will provide availability of the parties.

Best regards,



Gerald Hrycyszyn

Shareholder

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From: Trials <Trials@USPTO.GOV>

Sent: Friday, October 11, 2024 1:56 PM

To: Woo, Philip <PWWoo@duanemorris.com>; Trials <Trials@USPTO.GOV>

Cc: PTAB Scott McKeown <SMcKeown-PTAB@WolfGreenfield.com>; PTAB Gerald Hrycyszyn <GHrycyszyn-PTAB@WolfGreenfield.com>; PTAB Victor Cheung <VCheung-PTAB@WolfGreenfield.com>; Bartow, D. Stuart <DSBartow@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>

Subject: RE: IPR2024-01277, Apple Inc. v NL Giken Inc. - Termination Request

Counsel,

No panel has been assigned to this case. Once a panel has been assigned, your request will be forwarded to the panel.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571)272-7822

From: Woo, Philip <PWWoo@duanemorris.com>

Sent: Friday, October 11, 2024 1:28 PM

To: Trials <Trials@USPTO.GOV>

Cc: SMcKeown-PTAB@WolfGreenfield.com; GHrycyszyn-PTAB@WolfGreenfield.com; VCheung-PTAB@WolfGreenfield.com; Bartow, D. Stuart <DSBartow@duanemorris.com>; Belnap, Paul H. <PHBelnap@duanemorris.com>; Woo, Philip <PWWoo@duanemorris.com>

Subject: IPR2024-01277, Apple Inc. v NL Giken Inc. - Termination Request

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Dear Honorable Board:

Petitioner Apple Inc. and Patent Owner NL Giken Inc. jointly provide notice that the parties have reached a settlement of their disputes, including IPR IPR2024-01277. As such, the parties request leave to file a joint motion to terminate IPR IPR2024-01277. Concurrently with such motion to terminate, the parties would file a joint motion to treat the settlement agreement as business confidential information pursuant to 35 U.S.C. § 317. The parties intend to file the documents expeditiously upon receiving authorization.

Should the Board wish to discuss this request, please let us know and we will provide availability of the parties.

Philip Woo
Counsel for Petitioner Apple Inc.

Scott McKeown
Counsel for Patent Owner NL Giken Inc.



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2021-2022

For more information about Duane Morris, please visit <http://www.DuaneMorris.com>

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