

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NIKON CORPORATION, PANASONIC ENTERTAINMENT &
COMMUNICATION CO., LTD., OLYMPUS CORPORATION, OM DIGITAL
SOLUTIONS CORPORATION, FUJIFILM NORTH AMERICA
CORPORATION, FUJIFILM CORPORATION,

Petitioners

v.

OPTIMUM IMAGING TECHNOLOGIES LLC,

Patent Owner

Case IPR2024-01372

Patent No. 8,451,339

JOINT MOTION TO TERMINATE DUE TO SETTLEMENT¹

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ This Joint Motion was authorized by the Board in an e-mail dated 6/3/2025.

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<u>PATENT OWNER'S LIST OF EXHIBITS</u>	
EX. 2001	Claim Construction Memorandum Opinion and Order, <i>Optimum Imaging Technologies LLC v. Canon Inc.</i> , No. 2:19-cv-00246-JRG, Dkt. 88 (E.D. Tex. June 11, 2020)
EX. 2002	Institution Decision, IPR2020-01322, Paper 9 (PTAB Mar. 1, 2021)
EX. 2003	Patent Owner Preliminary Response, IPR2024-00925, Paper 8 (PTAB Sep. 20, 2024)
EX. 2004	Scheduling Order, <i>Optimum Imaging Technologies LLC v. Nikon Corp.</i> , No. 4:23-cv-00923, Dkt. 37 (E.D. Tex. Oct. 2, 2024)
EX. 2005	RESERVED
EX. 2006	Order, <i>Panasonic Entertainment & Communication Co., Ltd. v. Optimum Imaging Technologies LLC</i> , No. 3:24-cv-02466, Dkt. 47 (N.D. Cal. Sep. 23, 2024)
EX. 2007	Docket Report, <i>Optimum Imaging Technologies LLC v. Panasonic Corp. et al.</i> , No. 4:23-cv-00926, (E.D. Tex.) as of March 19, 2025
EX. 2008	Order granting Joint Motion to Modify Scheduling Order, <i>Optimum Imaging Technologies LLC v. Nikon Corp.</i> , No. 4:23-cv-00923, Dkt. 48 (E.D. Tex. Jan. 30, 2025)
EX. 2009	Order granting Joint Motion to Modify Scheduling Order, <i>Optimum Imaging Technologies LLC v. Nikon Corp.</i> , No. 4:23-cv-00923, Dkt. 54 (E.D. Tex. Feb. 14, 2025)
EX. 2010	Letter from Texas Secretary of State, <i>Optimum Imaging Technologies LLC v. Fujifilm Corp.</i> , No. 4-23-cv-00922-ALM, Dkt. 14 (E.D. Tex. Feb. 20, 2024)
EX. 2011	Mediator's Report, <i>Optimum Imaging Technologies LLC v. Olympus Corporation, et al.</i> , No. 4:23-cv-00924-ALM, Dkt. 71 (E.D. Tex. March 10, 2025)

EX. 2012	Joint Notice of Settlement, <i>Optimum Imaging Technologies LLC v. Fujifilm Corporation</i> , No. 4:23-cv-00922-ALM, Dkt. 70 (E.D. Tex. March 19, 2025)
EX. 2013	RESERVED
EX. 2014	Joint Motion to Stay All Deadlines for Two Weeks, <i>Optimum Imaging Technologies LLC v. Nikon Corporation</i> , No. 4:23-cv-00923-ALM, Dkt. 73 (E.D. Tex. April 1, 2025)
EX. 2015	RESERVED
EX. 2016	Joint Notice of Settlement, <i>Optimum Imaging Technologies LLC v. Nikon Corporation</i> , No. 4:23-cv-00923-ALM, Dkt. 79 (E.D. Tex. April 11, 2025)
EX. 2017	Joint Notice of Settlement, <i>Optimum Imaging Technologies LLC v. Olympus Corporation, et al.</i> , No. 4:23-cv-00924-ALM, Dkt. 72 (E.D. Tex. March 10, 2025)
EX. 2018	Joint Notice of Settlement, <i>Optimum Imaging Technologies LLC v. Panasonic Corporation, et al.</i> , No. 4:23-cv-00926-ALM, Dkt. 41 (E.D. Tex. April 11, 2025)
EX. 2019	Settlement Agreement - Olympus (Board Only)
EX. 2020	Settlement Agreement – Fujifilm (Board Only)
EX. 2021	Settlement Agreement – Nikon (Board Only)
EX. 2022	Settlement Agreement – Panasonic (Board Only)
EX. 2023	Collateral Agreement (Board Only)

I. INTRODUCTION

Patent Owner Optimum Imaging Technologies LLC and Petitioners Olympus Corporation, OM Digital Solutions Corporation, Fujifilm Corporation, Fujifilm North America Corporation, Nikon Corporation, Panasonic Entertainment & Communication Co., Ltd. (collectively, “the Parties”) have settled their disputes. Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, the Parties jointly request termination as to the petitioners and termination of this IPR in its entirety.

The Parties concurrently file another joint motion requesting that the Board treat EXS. 2019-2023 as business confidential information and keep EXS. 2019-2023 separate from the patent files.

II. THE PARTIES HAVE SETTLED THEIR DISPUTES

The Parties have resolved all disputes between them and with regard to the challenged patent. In compliance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), true and correct copies of the settlement and collateral agreements (EXS. 2019-2023) that resolve the disputes between the Parties are concurrently filed with this Joint Motion.² The Parties jointly certify that there are no other agreements, oral or written, between the Parties made in connection with, or in

² Due to the confidentiality terms of these agreements, Patent Owner is filing EXS. 2019-2023 as “Board Only.”

contemplation of, the termination sought.

Moreover, the Parties contemplate no new district court or administrative proceeding between them in the foreseeable future.

Furthermore, all pending district court proceedings involving the challenged patent have been settled and have been dismissed or are in the process of being dismissed. All pending administrative proceedings involving the challenged patent have been settled and the respective parties are in the process of seeking termination due to settlement.

III. THE PARTIES JOINTLY REQUEST TERMINATION AS TO THE PETITIONERS

Under 35 U.S.C. § 317(a), “[a]n 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.” The Parties jointly request termination as to Petitioners Olympus Corporation, OM Digital Solutions Corporation, Fujifilm Corporation, Fujifilm North America Corporation, Nikon Corporation, and Panasonic Entertainment & Communication Co., Ltd. The Board has not decided the merits of the proceeding. The Parties have not yet fully briefed their arguments following institution, oral argument has not yet occurred, and no final written decision has been entered.

IV. THE PARTIES JOINTLY REQUEST TERMINATION OF THIS IPR IN ITS ENTIRETY

“There are strong public policy reasons to favor settlement between the parties to a 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.” Consolidated Trial Practice Guide at 86 (November 2019). The Parties jointly request termination of this IPR in its entirety in support of the public policy considerations. Termination is appropriate at least because there are no other petitioners in this proceeding, there has been no decision on the merits, and termination will conserve the limited resources of the Board.

V. CONCLUSION

For at least the foregoing reasons, the Parties respectfully request termination as to the petitioners and termination of this IPR in its entirety.

Respectfully submitted,

Date: June 3, 2025

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CERTIFICATE OF COMPLIANCE

This Joint Motion complies with the type-volume and general format requirements under 37 C.F.R. §§ 42.24(a)(1)(v) and 42.6(a).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that this Joint Motion was served on the undersigned date via email, as authorized by Petitioners, at the following email addresses:

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