

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS, INC. AND LG ELECTRONICS USA, INC.,
Petitioners,

v.

MAXELL, LTD,
Patent Owner.

Case No. IPR2025-00394
Patent No. 10,199,072

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

- LG-1001 U.S. Patent No. 10,199,072 to Susumu Yoshida, et al. (“the ’072 Patent”)
- LG-1002 Excerpts from the Prosecution History of the ’072 Patent (“the Prosecution History”)
- LG-1003 Declaration and Curriculum Vitae of Dr. Andrew Cockburn
- LG-1004 U.S. Patent Application Publication No. 2001/0056434 to Kaplan et al. (“Kaplan”)
- LG-1005 U.S. Patent Application Publication No. 2004/0201691 to Bryant et al. (“Bryant”)
- LG-1006 U.S. Patent Application Publication No. 2006/0107289 to DeYonker et al. (“DeYonker”)
- LG-1007 U.S. Patent Application Publication No. 2004/0078383 to Mercer et al. (“Mercer”)
- LG-1008 U.S. Reissue Patent No. RE32,632 to Atkinson (“Atkinson”)
- LG-1009 U.S. Patent No. 6,493,006 to Gourdol et al. (“Gourdol”)
- LG-1010 Brent Ethington, *Introducing Microsoft Windows 95*, Microsoft Press (1995), with authenticating declaration of Carmen Debord
- LG-1011 George W. Furnas and Jeff Zacks, 1994, *Multitrees: Enriching and Reusing Hierarchical Structure*, In Proceedings of the SIGCHI Conference on Human Factors in Computer Systems (CHI 1994), Beth Adelson, Susan Dumais, and Judith Olson (Eds.), ACM, New York, NY, USA, 330-336. DOI <http://dx.doi.org/10.1145/191666.191778>, with authenticating declaration of Scott Delman
- LG-1012 Benjamin B. Bederson, 2001, *PhotoMesa: A Zoomable Image Browser Using Quantum Treemaps and Bubblemaps*, In Proceedings of the 14th annual ACM symposium on User Interface Software and

Technology (UIST 2001), ACM, New York, NY, USA, 71-80. DOI
<http://dx.doi.org/10.1145/502348.502359>

- LG-1013 U.S. Patent No. 6,609,253 to Swix et al. (“Swix”)
- LG-1014 U.S. Patent No. 5,442,744 to Piech et al. (“Piech”)
- LG-1015 U.S. Patent No. 5,884,056 to Steele (“Steele”)
- LG-1016 U.S. Patent No. 6,166,735 to Dom et al. (“Dom”)
- LG-1017 U.S. Patent Application Publication No. 2002/0082730 to Capps et al. (“Capps”)
- LG-1018 U.S. Patent Application Publication No. 2004/0064476 to Rounds (“Rounds”)
- LG-1019 Microsoft Computer Dictionary, 4th Ed., Microsoft Press (1999)
- LG-1020 James Cohoon & Jack Davidson, *C++ Program Design: An Introduction to Programming and Object-Oriented Design*, 3rd Ed., McGraw Hill (2002)
- LG-1021 U.S. Patent Application Publication No. 2004/0177319 to Horn (“Horn”)
- LG-1022 U.S. Patent No. 9,384,783 to Susumu Yoshida, et al. (“the ’783 Patent”)
- LG-1023 U.S. Patent No. 6,903,897 to Wang et al. (“Wang”)
- LG-1024 U.S. Patent No. 7,009,803 to Sharma et al. (“Sharma”)
- LG-1025 Jeppesen et al., “Hard Disk Controller: the Disk Drive’s Brain and Body,” 2001, IEEE.
- LG-1026 Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) (“Director’s Guidance”)
- LG-1027 Federal Court Management Statistics–Profiles (June 30, 2024)

- LG-1028 Complaint, *Maxell, Ltd. v. LG Electronics Inc. et al*, 5-23-cv-00152, E.D. Tex., filed December 29, 2023
- LG-1029 U.S. Patent No. 6,091,778 to Sporer et al. (“Sporer”)
- LG-1030 U.S. Patent No. 5,838,317 to Bolnick et al. (“Bolnick”)
- LG-1031 U.S. Patent Application Publication No. 2003/0235396 to Boston et al. (“Boston”)
- LG-1032 U.S. Patent No. 6,487,069 to Onodera (“Onodera”)
- LG-1033 U.S. Patent No. 6,654,050 to Karube et al. (“Karube”)
- LG-1034 MPEG-7 Requirements, INTERNATIONAL ORGANISATION FOR STANDARDISATION ORGANISATION INTERNATIONALE DE NORMALISATION ISO/IEC JTC1/SC29/WG11 CODING OF MOVING PICTURES AND AUDIO, October 1998, *available at* <https://sound.media.mit.edu/resources/mpeg4/audio/public/mpeg7/w2461.html>
- LG-1035 “Change BMP Icon to Thumbnail View,” *available at* <https://www.tiplord.com/customizing/bmpicons.html>, with Wayback capture
- LG-1036 Declaration of June Ann Munford
- LG-1037 Excerpts from the Prosecution History of U.S. Patent No. 9,818,449 (“the ’449 Prosecution History”)
- LG-1038 Patent Owner’s Infringement Contentions in *Maxell, Ltd. v. LG Electronics Inc. et al.*
- LG-1039 U.S. Patent No. 9,818,449 to Susumu Yoshida, et al. (“the ’449 Patent”)
- LG-1040 *Fandango Media, LLC v. Maxell, Ltd.*, IPR2018-01432, Paper 32 (PTAB February 10, 2020) (“IPR2018-01432”)

LG-1041 Confidential Settlement Agreement

Petitioners LG Electronics Inc. and LG Electronics U.S.A., Inc. (“LG” or “Petitioners”) and Patent Owner Maxell, Ltd. (“Maxell” or “Patent Owner”) have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, LG and Maxell move to terminate the present *inter partes* review proceeding.

I. STATEMENT OF FACTS

LG and Maxell (collectively, the “Settling Parties”) have reached an agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Exhibit 1041. The Settlement Agreement is being filed electronically with access to “Board and Parties Only.” A “*Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74*” is being filed concurrently with this Joint Motion to Terminate, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

II. RELIEF REQUESTED

Termination of this *inter partes* review is requested, and the Settling Parties respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “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.” *Id.* (citing 35 U.S.C. §§ 317(a)).

The Board should terminate this proceeding, as the Settling Parties jointly request, for the following reasons.

First, LG and Maxell have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, LG and Maxell have reached a settlement as to all the disputes in this proceeding and as to the ’072 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1041. LG and Maxell request that the settlement agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). No other such agreements, written or oral, exist between or among the Settling Parties.

Third, termination would save significant further expenditure of resources by the Settling Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient

and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of a settlement.

III. CONCLUSION

For the foregoing reasons, LG and Maxell respectfully request termination of this *inter partes* review.

Respectfully submitted,

Date: July 1, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on July 1, 2025, a complete and entire copy of this Joint Motion to Terminate and Exhibit 1041 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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