

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. IPR2025-00518
Patent No. 6,856,760

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

- LG-1001 U.S. Patent No. 6,856,760 to Masaru Takahashi, et al. (“the ’760 Patent”)
- LG-1002 Excerpts from the Prosecution History of the ’760 Patent (“the Prosecution History”)
- LG-1003 Declaration and Curriculum Vitae of Jim C. Williams
- LG-1004 Complaint, Maxell, Ltd. v. LG Electronics Inc. et al, 5-23-cv-00152, E.D. Tex., filed December 29, 2023
- LG-1005 U.S. Patent No. 6,005,621 to Linzer et al. (“Linzer”)
- LG-1006 U.S. Pat. App. Pub. No. 2002/0131760 to Hirai et al. (“Hirai”)
- LG-1007 U.S. Patent No. 6,288,743 to Lathrop (“Lathrop”)
- LG-1008 U.S. Patent No. 6,028,603 to Wang et al. (“Wang”)
- LG-1009 International Publication No. WO1998057294A1 to Anderson (“Anderson”)
- LG-1010 U.S. Patent No. 5,724,579 to Suzuki (“Suzuki”)
- LG-1011-1019 RESERVED
- LG-1020 “Generic coding of moving pictures and associated audio information: video,” ITU-T, Recommendation H.262, July 1995. (“H.262”)
- LG-1021 Bohoris, “Simulation and optimization of JPEG and motion JPEG.” MSc Telematics (Telecommunications and Computer Engineering), Project report, University of Surrey, UK (1998). (“Bohoris”)
- LG-1022 Czyszczonek, et al., K.W., 1998, June. “Real-time implementation of JPEG encoder/decoder.” In Input/Output and Imaging Technologies (Vol. 3422, pp. 281-292). SPIE. (“Czyszczonek”)
- LG-1023 Fokker, “Functional specification of JPEG decompression, and an implementation for free.” In Programming Paradigms in Graphics: Proceedings of the Eurographics Workshop in Maastricht, The

Netherlands, September 2–3, 1995, pp. 102-117. Vienna: Springer
Vienna, 1995. (“Fokker”)

LG-1024 Wallace, 1992. The JPEG still picture compression standard. IEEE
transactions on consumer electronics, 38(1), pp.xviii-xxxiv.
 (“Wallace”)

LG-1025 U.S. Patent No. 5,603,002 to Hashimoto (“Hashimoto”)

LG-1026 – LG-1027 RESERVED

LG-1028 McIntyre, et al., IETF RFC 2301, “File Format for Internet Fax,”
March 1998, downloaded from the internet
<https://datatracker.ietf.org/doc/html/rfc2301> on December 29, 2024

LG-1029 (Excerpts) Hansen, “The Dictionary of Computing & Digital Media:
Terms & Acronyms,” Franklin, Beedle & Associated, Incorporated,
1999. (“Hansen”)

LG-1030 (Excerpts) Botto, “Dictionary of Multimedia and Internet
Applications: A Guide for Developers and Users, Wiley & Sons,
1999. (“Botto”)

LG-1031 *Olympus Corp. v. Maxell, Ltd.*, IPR2018-00905, Paper 9 (PTAB Nov.
19, 2018).

LG-1032 U.S. Patent No. 5,606,379 to Williams (“Williams”)

LG-1033 U.S. Patent No. 6,512,548 to Anderson (“Anderson-548”)

LG-1034 Memorandum, Interim Procedure for Discretionary Denials in AIA
Post-Grant Proceedings with Parallel District Court Litigation
(USPTO June 21, 2022) (“Director’s Guidance”)

LG-1035 Federal Court Management Statistics–Profiles (September 30, 2024)

LG-1036 Patent Owner’s Infringement Contentions in *Maxell, Ltd. v. LG
Electronics Inc. et al.*

LG-1037 (Excerpts) Freedman, “The Computer Desktop Encyclopedia,” The
Computer Language Company Inc., 1996 (“Freedman”)

- LG-1038 (Excerpts) Margolis, “Computer & Internet Dictionary,” Third Edition, Random House, 1999 (“Margolis”)
- LG-1039 U.S. Patent No. 6,920,150 to Pauls, et al. (“Pauls”)
- LG-1040 U.S. Patent No. 7,359,439 to Conover (“Conover”)
- LG-1041 U.S. Patent No. 6,256,348 to Laczko, et al. (“Laczko”)
- LG-1042 (Excerpts) Downing, et al., “Dictionary of Computer and Internet Terms, Sixth Edition,” Barron’s Educational Series, Inc., 1998 (“Downing”)
- LG-1043 IETF RFC 2302, Tag Image File Format (TIFF) - image/tiff MIME Sub-type Registration, March 1998, <https://datatracker.ietf.org/doc/html/rfc2302>, accessed on January 10, 2024.
- LG-1044 IETF RFC 2306, Tag Image File Format (TIFF) - F Profile for Facsimile, March 1998, <https://datatracker.ietf.org/doc/html/rfc2306>, accessed on January 10, 2025.
- LG-1045 “Adobe Photoshop version 5.0,” Adobe Systems Incorporated, 1998.
- LG-1046 (Excerpts) Kylander, et al., “GIMP: The Official Handbook,” The Coriolis Group, 1999, ISBN 1-57610-520-2.
- LG-1047 U.S. Patent No. 8,972,867 to Pavley, et al. (“Pavley”)
- LG-1048 U.S. Patent No. 7,567,276 to Anderson, et al. (“Anderson ’276”)
- LG-1049 U.S. Patent No. 5,528,293 to Watanabe (“Watanbe”)
- LG-1050 CCITT T.81, “Information Technology – Digital Compression and Coding of Continuous-Tone Still Images – Requirements And Guidelines,” 1993 (“CCITT”)
- LG-1051 T.I.F.F. Revision 6.0, 1992, Aldus Developers Desk (“TIFF 6.0”)
- LG-1052 (Excerpts) Pennebaker, et al., 1992. “JPEG: Still image data compression standard.” Springer Science & Business Media. (“Pennebaker”)

- LG-1053 Inside Macintosh, “Imaging With QuickDraw,” 1994, available at <https://developer.apple.com/library/archive/documentation/mac/pdf/ImagingWithQuickDraw.pdf>.
- LG-1054 Dr. Dobb’s, “The BMP File Format, Part 1,” March 1, 1995.
- LG-1055 Rec. ITU-R BT.601-5 (1995), “Studio Encoding Parameters Of Digital Television For Standard 4:3 And Wide-screen 16:9 Aspect Ratios.”
- LG-1056 Rec. ITU-R BT.709-3 (1998), “Parameter Values For The HDTV Standards For Production and International Programme Exchange.”
- LG-1057 Declaration of June Ann Munford
- LG-1058 U.S. Patent No. 5,614,952 to Boyce, et al. (“Boyce”)
- LG-1059 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 1059. 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 ’760 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1059. 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

/Jennifer J. Huang/
Timothy Riffe, Reg. No. 43,881
Jennifer Huang, Reg. No. 64,297
R. Andrew Schwentker, Reg. No. 59,402
Jack R. Wilson, Reg. No. 75,011
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402

Attorneys for Petitioners

Respectfully submitted,

Date: July 1, 2025

/s/ Robert G. Pluta
Robert G. Pluta, Reg. No. 50,970
Nicholas H. Ciulla, Reg. No. 78,409
Mayer Brown LLP
71 S. Wacker Drive
Chicago, IL 60606

Attorneys for Patent Owner

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 1059 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

Robert G. Pluta
Nicholas H. Ciulla
Mayer Brown LLP
71 S. Wacker Drive
Chicago, IL 60606

Email:

rpluta@mayerbrown.com
nciulla@mayerbrown.com

/Hoi Cheung/

Hoi Cheung
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
hcheung@fr.com