

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. IPR2025-00519
Patent No. 7,421,188

JOINT MOTION TO TERMINATE PROCEEDING

UPDATED EXHIBIT LIST

- LG-1001 U.S. Patent No. 7,421,188 to Yuichi Kanai, et al. (“the ‘188 Patent”)
- LG-1002 Excerpts from the Prosecution History of the ‘188 Patent (“the Prosecution History”)
- LG-1003 Declaration and Curriculum Vitae of Dr. Benjamin B. Bederson
- LG-1004 Complaint, Maxell, Ltd. v. LG Electronics Inc. et al, 5-23-cv-00152, E.D. Tex., filed December 29, 2023
- LG-1005 Certified English Translation of Japanese Patent Publication No. JP2001211421A to Masanori Yoshida (“Yoshida”)
- LG-1006 Certified English Translation of Japanese Patent Publication No. JP2000307994A to Yasuhiko Terashita et al. (“Terashita”)
- LG-1007 U.S. Patent No. 6,292,273 to James C. Dow et al. (“Dow”)
- LG-1008 Certified English Translation of Japanese Patent Publication No. JP2002033986A to Yuji Murakami et al. (“Murakami”)
- LG-1009 Certified English Translation of Japanese Patent Publication No. JPS61101850A to Hisao Tezuka (“Tezuka”)
- LG-1010 Certified English Translation of Japanese Patent Publication No. JP2001169231A to Junichi Miyasaka (“Miyasaka”)
- LG-1011 English Machine Translation of Japanese Patent Publication No.

JPH11275512A to Masahiro Shioji (“Shioji”)

- LG-1012 English Machine Translation of Japanese Patent Publication No.
JPH0983925A to Seishi Miyamoto (“Miyamoto”)
- LG-1013 English Machine Translation of Japanese Patent Publication No.
JPH0993527A to Setsuyuki Hongo et al. (“Hongo”)
- LG-1014 U.S. Patent Publication No. 2002/0067923 A1 to Tadashi Fujimura
 (“Fujimura”)
- LG-1015 U.S. Patent Publication No. 2003/0011683 A1 to Yamasaki et al.
 (“Yamasaki”)
- LG-1016 WIPO Publication number WO 01/57683 A1 to Flamini et al.
 (“Flamini”)
- LG-1017 English Machine Translation of Japanese Patent Publication No.
JPH08205014A to Oie Masahiro et al. (“Masahiro”)
- LG-1018 English Machine Translation of Japanese Patent Publication No.
JPH114405A to Doutsubo Nobuhide et al. (“Nobuhide”)
- LG-1019 Federal Court Management Statistics—Profiles (June 30, 2024)
- LG-1020 English Machine Translation of Japanese family member JP2003-
257161 of the ’188 patent (the ’161 family member)
- LG-1021 English Machine translation of the prosecution history of the Jap-

anese family member JP2003-257161 (Application number 2002-
107158)

LG-1022 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 1022. 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 ’188 patent. A true copy of the settlement agreement is filed concurrently herewith. *See* Confidential Ex. 1022. 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 1022 were provided by email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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