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Paper 51
Entered: February 15, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

THALES VISIONIX, INC.,
Patent Owner.

IPR2022-01294 (Patent 8,224,024 B2)
IPR2022-01304 (Patent 6,922,632 B2)
IPR2022-01305 (Patent 6,922,632 B2)
IPR2022-01308 (Patent 7,725,253 B2)

Before WILLIAM V. SAINDON, HYUN J. JUNG, and JASON W. MELVIN, *Administrative Patent Judges*.

PER CURIAM.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

Petitioner (Meta Platforms, Inc.) and Patent Owner (Thales Visionix, Inc.) have indicated that they have reached an agreement to settle each of the above-identified *inter partes* review proceedings. The Board authorized Petitioner and Patent Owner (collectively referred to as "the parties") to file joint motions to terminate the proceedings on January 16, 2024.

On January 17, 2024, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the parties filed joint motions to terminate each of the above-identified proceedings (Paper 44[1]) and joint requests (Paper 43[2]) to treat a confidential Patent License and Settlement Agreement as business confidential information and to keep the Patent License and Settlement Agreement separate from the files of the involved patents, along with a copy of the confidential Patent License and Settlement Agreement (Ex. 1042[3] (the "Meta-Gentex[4] Agreement")). Because the parties' joint motions and joint requests did not appear to discharge the parties' obligations under 35 U.S.C. § 317(b),[5] the Board requested the parties, on January 26, 2024, to

[1] For purposes of expediency, we cite to Papers filed in IPR2022-01294. The parties submitted similar Joint Motions in IPR2022-01304 (Paper 49), IPR2022-01305 (Paper 50), and IPR2022-01308 (Paper 48).

[2] The parties submitted similar Joint Requests regarding the Patent License and Settlement Agreement in IPR2022-01304 (Paper 48), IPR2022-01305 (Paper 49), and IPR2022-01308 (Paper 47).

[3] We cite to Exhibits filed in IPR2022-01294. The parties also submitted copies of confidential Patent License and Settlement Agreement in IPR2022-01304 (Ex. 1042), IPR2022-01305 (Exhibit 1042), and IPR2022-01308 (Exhibit 1042).

[4] Gentex Corporation ("Gentex") is Patent Owner's licensee and real party-in-interest. *See* Paper 44, 1.

[5] In particular, the joint motions and joint requests (Papers 43 and 44) did

re-file the motions and requests in order to make clear that the parties' submissions discharge their obligations under 35 U.S.C. § 317(b). *See generally DTN, LLC v. Farms Technology, LLC*, IPR2018-01412, Paper 21 (PTAB June 14, 2019) (precedential) (explaining the requirements of 35 U.S.C. § 317(b)).

On February 5, 2024, the parties re-filed updated joint motions to terminate each of the above-identified proceedings (collectively "Joint Motions") (Paper 46[6]) and joint requests (collectively "Joint Requests") (Paper 45[7]) to treat the previously-filed Meta-Gentex Agreement (Ex. 1042) as business confidential information and to keep the Meta-Gentex Agreement separate from the files of the involved patents. The parties describe the filed copy of the confidential Meta-Gentex Agreement as comprising "a true copy of any 'agreement or understanding … including any collateral agreements … made in connection with, or in contemplation of, the termination of' th[ese] inter partes review[s]." Paper 46, 1–2; *see also* Paper 45, 1. The parties represent that the Meta-Gentex Agreement

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not certify that the filed Meta-Gentex Agreement is a "true copy" of the agreement, and also did not certify that there are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination sought. *See* 35 U.S.C. § 317(b).

[6] The parties submitted similar Joint Motions in IPR2022-01304 (Paper 51), IPR2022-01305 (Paper 52), and IPR2022-01308 (Paper 50).

[7] The parties submitted similar Joint Requests regarding the Patent License and Settlement Agreement in IPR2022-01304 (Paper 50), IPR2022-01305 (Paper 51), and IPR2022-01308 (Paper 49).

resolves each of the above-identified proceedings as well as the related district court litigation.[8] Paper 46, 2–4.

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." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review. The above-identified proceedings are at an intermediate stage. We have not yet decided the merits of these proceedings, and final written decisions have not been entered in these proceedings. Terminating these proceedings will save the Board administrative and judicial resources, e.g., in preparing and issuing a final written decision to decide the patentability issues raised in the respective Petitions. Furthermore, there are strong public policy reasons to favor settlement between the parties to a proceeding. *Patent Trial and Appeal Board Consolidated Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Under these circumstances, and in view of the parties'

[8] The parties identify the related district court litigation as *Gentex Corporation et al. v. Meta Platforms, Inc. et al.*, No. 6:21-cv-00755-ADA (W.D. Tex.) (transferred to the Northern District of California as Case No. 4:22-cv-03892-YGR). *See* Paper 46, 2–3. The parties note that Gentex and Indigo Technologies, LLC are "Voluntary Plaintiffs" in the district court litigation, with Patent Owner named as an involuntary plaintiff in the litigation, and submit that "the Voluntary Plaintiffs and Petitioner have filed a joint motion to dismiss the district court litigation." *Id.*

settlement and representations, we determine that good cause exists to terminate these proceedings. Accordingly, we *grant* the Joint Motions.

The parties also "jointly request to file and treat the Patent License And Settlement Agreement between Petitioner and real party-in-interest Gentex Corporation (the 'Meta-Gentex Agreement,' Exhibit 1042) as business confidential information" and "jointly request that the confidential Meta-Gentex Agreement be kept separate from the file[s] of the subject patent[s] in the above-captioned proceeding[s] and be made available only to federal government agencies on written request or to persons showing good cause." Paper 45, 1. We have reviewed the Meta-Gentex Agreement, which contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the Meta-Gentex Agreement as business confidential information and to keep it separate from the files of the respective patents involved in the above-identified proceedings pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we *grant* the Joint Requests.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

Accordingly, it is:

ORDERED that the Joint Motions (IPR2022-01294, Paper 46; IPR2022-01304, Paper 51; IPR2022-01305, Paper 52; and IPR2022-01308, Paper 50) to terminate the above-identified proceedings are *granted*, and that IPR2022-01294, IPR2022-01304, IPR2022-01305, and IPR2022-01308 are *terminated*;

FURTHER ORDERED that the Joint Requests (IPR2022-01294, Paper 45; IPR2022-01304, Paper 50; IPR2022-01305, Paper 51; and IPR2022-01308, Paper 49) are *granted*, and the Meta-Gentex Agreement (IPR2022-01294, Ex. 1042; IPR2022-01304, Ex. 1042; IPR2022-01305, Ex. 1042; and IPR2022-01308, Ex. 1042) shall be treated as business confidential information, shall be kept separate from the files of the involved patents (U.S. Patent 8,224,024, U.S. Patent 6,922,632, and U.S. Patent 7,725,253), and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that Exhibit 1042 in IPR2022-01294, Exhibit 1042 in IPR2022-01304, Exhibit 1042 in IPR2022-01305, and Exhibit 1042 in IPR2022-01308 shall remain designated as "Board Only" in the Board's P-TACTS system.

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IPR2022-01304 (Patent 6,922,632 B2)
IPR2022-01305 (Patent 6,922,632 B2)
IPR2022-01308 (Patent 7,725,253 B2)

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