

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY GROUP CORPORATION,
Petitioner

v.

VISIONX TECHNOLOGIES, LLC,
Patent Owner

IPR2023-00389
U.S. Patent No. 8,035,143

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. 317(a)**

LIST OF NEWLY FILED EXHIBITS

The following exhibit is being filed with this Joint Motion to Terminate Proceeding and concurrent Joint Request to Treat the Parties' Settlement and Patent License Agreement as Business Confidential Information:

Exhibit	Brief Description
2010	Confidential Settlement and Patent License Agreement

LIST OF PREVIOUSLY FILED EXHIBITS

Exhibit	Brief Description
2001	Yanagida-1 and English Abstract Filed with IDS
2002	IDS
2003	IDS References Considered by Examiner
2004	Consent to Proceed Before Magistrate Judge Payne
2005	Amended Docket Control Order
2006	U.S. Dist. Courts - National Judicial Caseload Profile
2007	VisionX Notice of Compliance re Infringement Contentions
2008	Sony's Notice of Compliance re Invalidity Contentions
2009	Sony's Invalidity Contentions and ID of Doc Production

JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317(a), the Petitioner Sony Group Corporation and VisionX Technologies, LLC (collectively, the “Parties”) jointly request termination of this *inter partes* review proceeding IPR2023-00389 involving U.S. Patent No. 8,035,143. This Joint Motion was authorized by the Board via email on July 11, 2023.

Termination of this review is appropriate because the parties have settled their dispute and have reached an agreement to, among other things, file a motion to terminate this review, and to dismiss the related district court litigation, captioned *VisionX Technologies, LLC v. Sony Group Corporation et al.*, 2:22-cv-00178 (E.D. Tex.). *See* Ex. 2010 (Settlement and Patent License Agreement submitted as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)). Petitioner and Patent Owner further certify that, other than the Settlement and Patent License Agreement submitted as Exhibit 2010, there is no other agreement or understanding between Petitioner and Patent Owner, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present *inter partes* review proceeding.

“Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, No.

CBM2013–00015, slip op. at 2 (July 25, 2013) (Paper 13) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)).

Termination of this proceeding is appropriate because it “conserves the Board’s resources, promotes efficiency, and minimizes unnecessary costs.” *The Brinkman Corp. v. A&J Mfg., LLC*, No. IPR2015–00056, slip op. at 2 (PTAB Dec. 21, 2015) (Paper 26); *see also Asml Netherlands B.V. v. Energetiq Tech., Inc.*, No. IPR2015–01277 (PTAB June 13, 2016) (Paper 32) (terminating both parties in proceedings at advanced stage post-institution of trial).

Additionally, as part of the Settlement and Patent License Agreement, Petitioner has agreed that it will take no further action in furtherance of the IPR. (*See* Ex. 2010).

No other petitioners remain in this *inter partes* review, and a decision to Institute has not been taken. For at least these reasons, termination of the *inter partes* review is proper under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a).

Termination also serves the PTAB’s overarching goal of “secur[ing] the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1.

Dated: July 11, 2023

Respectfully submitted,

Attorney for Petitioner

/Michael N. Rader/

Michael N. Rader, Reg. No. 52,146
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210
Tel: (617) 646-8000
Fax: (617) 646-8646

Attorney for Patent Owner

/Michael Farjami/

Michael Farjami, Reg. No. 38,135
FARJAMI & FARJAMI LLP
26522 La Alameda Ave., Suite 360
Mission Viejo, CA 92691
Tel: (949) 282-1000
Fax: (949) 282-1002

CERTIFICATE OF SERVICE ON PETITIONER

Pursuant to 37 C.F.R. §§ 42.6(e), the undersigned certifies that on the 11th day of July, 2023, a complete copy of the foregoing Joint Motion to Terminate and was served by filing this document with the PTAB's Patent Trial and Appeal Case Tracking System ("P-TACTS") as well as via email to Petitioner at the following addresses:

Randy J. Pritzker: RPritzker-PTAB@wolfgreenfield.com
Michael N. Rader: MRader-PTAB@wolfgreenfield.com
Marc S. Johannes: MJohannes-PTAB@wolfgreenfield.com
Charles T. Steenburg: Charles.Steenburg@wolfgreenfield.com

Per agreement between Petitioner and Patent Owner, Exhibit 2010 was not served on Petitioner's counsel and is being filed as "Parties and Board Only."

Dated: July 11, 2023

/Michael Farjami/
Michael Farjami
Reg. No. 38,135
Counsel for Patent Owner,
VISIONX TECHNOLOGIES, LLC