

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HISENSE INTERNATIONAL CO. LTD.; HISENSE INTERNATIONAL (HONG
KONG) AMERICA INVESTMENTS CO. LTD.,

Petitioners,

v.

VISTA PEAK VENTURES, LLC,
Patent Owner.

Inter Partes Review No. IPR2023-00651
U.S. Patent No. 6,513,943

**JOINT MOTION TO DISMISS
PETITION FOR *INTER PARTES* REVIEW**

PETITIONERS' UPDATED EXHIBIT LIST

Ex. No.	Brief Description
1001	U.S. Patent No. 6,513,943
1002	U.S. Patent No. 6,513,943 File History
1003	Flasck Declaration
1004	Certified English translation: Japan Patent No. JPH10105074A (Yamamoto)
1005	[Intentionally Omitted]
1006	Flasck CV
1007	“How Are Acrylic Sheets Made?”, ACME Plastic.com, available at: https://www.pmma-online.eu/pmma-science/
1008	“Glass Transition Temperature”, Omnexus: The Material Selection Platform, available at: https://omnexus.specialchem.com/polymer-properties/properties/glass-transition-temperature
1009	Fred W. Billmeyer, Jr. (1962). Textbook of Polymer Science; see also Comprehensive Guide on Polyethylene Terephthalate (PET), Omnexus: The Material Selection Platform, available at: https://omnexus.specialchem.com/selection-guide/polyethylene-terephthalate-pet-plastic?src=prop-cnx
1010	U.S. Patent No. 5,499,120
1011	U.S. Patent No. 4,193,287
1012	Untranslated: Japan Patent No. JPH10105074A (Yamamoto)
1013	Settlement and License Agreement BUSINESS CONFIDENTIAL INFORMATION

I. INTRODUCTION

The Board authorized the parties to file a motion to dismiss the present petition for *inter partes* review and thereby terminate IPR2023-00651 directed to U.S. Patent No. 6,513,943 (“the ’943 Patent”). (Board email dated June 13, 2023). Petitioners and Exclusive Licensee Vista Peak Ventures, LLC (“Vista Peak”) have conferred via email, and Vista Peak does not oppose the relief requested in this motion. Petitioners now so moves and respectfully requests that the Board dismiss the present petition and terminate IPR2023-00651 consistent with Board’s precedent allowing petitioners to withdraw IPR petitions pre-institution. This proceeding is in its preliminary phase, Vista Peak has not yet filed a Preliminary Response, and the Board has not yet reached the merits by issuing a decision on institution.

I. BACKGROUND AND RELATED IPR PROCEEDINGS

The present petition is one of three petitions that Petitioners filed on August 15, 2022, and March 17, 2023. The parties in this proceeding and the related district court litigations in which the ’943 Patent was asserted,¹ have entered into

¹ The settling parties are 1) Petitioners Hisense International Co. Ltd.; Hisense International (Hong Kong) America Investments Co. Ltd.; and Patent Owner Vista Peak Ventures, LLC in this proceeding; and 2) Plaintiff Visa Peak Ventures, LLC and

a confidential settlement agreement (“Settlement Agreement”) that will resolve the parties’ dispute regarding the challenged patents. This Settlement Agreement has been made in writing, and a true and correct copy shall be filed as Exhibit 1013 with this Office as business confidential pursuant to 35 U.S.C. § 317(b). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. Pursuant to the terms of the Settlement Agreement, the parties filed Stipulations of Dismissal in the aforementioned cases, and the parties’ disputes have been dismissed by the court. Moreover, Petitioners are preparing identical Unopposed Motions to Dismiss Petition for *Inter Partes* Review in each of the two proceedings currently pending before the Board:

1. IPR2022-01425 and
2. IPR2023-00725.

Defendants Hisense Co., Ltd.; Hisense Electronica Mexico SA de CV; Hisense Import & Export Co. Ltd, Hisense International Co., Ltd; Hisense International (HK) Co., Ltd; Hisense International (Hong Kong) America Investment Co. Ltd; Hisense Visual Technology Co., Ltd.; and Xianyang Caihong Optoelectronic Technology Co., Ltd. in cases 2:21-cv-00260 (E.D. Tex.), 2:21-cv-00262 (E.D. Tex.), and 2:21-cv-00263 (E.D. Tex.).

II. ARGUMENT

Good cause exists to dismiss the present petition and terminate IPR2023-00651. The proceeding is in its preliminary stage and Exclusive Licensee Vista Peak has not yet filed a Preliminary Response. “The Board may . . . dismiss any petition.” 37 C.F.R. 42.71(a); *see also* 37 C.F.R. § 42.72 (The Board “may terminate a trial without rendering a final written decision, where appropriate.”). Further, the rules governing IPR proceedings “shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Id.* § 42.1(b). In determining whether a termination request is “appropriate,” the Board primarily examines the stage and nature of the proceedings. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015- 01270, Paper 12 at 3 (Dec. 9, 2015). Here, dismissal will preserve both Board and party resources, particularly in view of the early stage of the proceeding.

The Board has precedent for allowing petitioners to withdraw IPR petitions pre-institution when proceedings are in a similar posture. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01221, Paper 21 (Jan. 13, 2020); *Huawei Technologies Co. Ltd v. Harris Global Communications, Inc.*, IPR2019-01512, Paper 8 (Jan. 10, 2020); *Pfizer, Inc., v. Biogen, Inc.*, IPR2018-00231, Paper No. 11 (June 6, 2018); *Darfon Electronics Corp. v. Lite-On Technology Corp.*, IPR2018- 01797, Paper No. 8 (January 9, 2019); *Turner Sports Interactive, Inc.*

v. Tagi Ventures, LLC, IPR2017-01010, Paper No. 7 (July 31, 2017). Moreover, withdrawal of the present petition does not prejudice the Patent Owner or its Exclusive Licensee, who do not oppose the filing of this motion.

III. CONCLUSION

For the reasons set forth herein, Petitioners respectfully requests that the Board grant the Unopposed Motion to Dismiss Petition for *Inter Partes* Review in Case Number IPR2023-00651 and terminate the proceeding in its entirety.

Dated: June 16, 2023

Respectfully submitted,

/ Ya-Chiao Chang /

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CERTIFICATE OF SERVICE

I certify that on June 16, 2023, I caused a copy of the foregoing document to be served via electronic mail, as previously consented to by Patent Owner and Exclusive Licensee Vista Peak Ventures, LLC, upon the following:

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