

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

QUANTUM IMAGING LLC,
Patent Owner.

Case IPR2023-00959
Patent 10,255,724 B2

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

UPDATED LIST OF EXHIBITS

<i>Exhibit #</i>	<i>Description</i>
Ex-1001	U.S. Patent No. 10,255,724 (“the ’724 Patent”)
Ex-1002	U.S. Pat. Pub. No. US2011/0292167A1
Ex-1003	Prosecution File History of the ’724 Patent
Ex-1004	Declaration of David Crane
Ex-1005	Curriculum Vitae for David Crane
Ex-1006	Complaint for Patent Infringement, dated June 3, 2022, in the matter of <i>Quantum Imaging LLC v. Sony Group Corporation, et al.</i> , W.D. Texas, Case No. 6:22-cv-00573-ADA-DTG
Ex-1007	U.S. Patent No. 5,933,811 (“Angles”)
Ex-1008	U.S. Patent No. 7,168,051 (“Robinson”)
Ex-1009	Amended Scheduling Order, dated February 17, 2023, in the matter of Quantum Imaging LLC v. Sony Group Corporation, et al
Ex-1010	Order Construing Claims, in <i>Barbaro Technologies, LLC v. Niantic, Inc.</i> , No. 3:18-cv-02955 (N.D. Cal.)
Ex-1011	Joint Stipulation, Proposed Order, and Covenant Not to Sue filed April 10, 2024 in of <i>Quantum Imaging LLC v. Sony Group Corporation, et al.</i> , W.D. Texas, Case No 1:23-CV-01212-ADA-DTG

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner Sony Interactive Entertainment LLC and Patent Owner Quantum Imaging LLC jointly move to terminate the *inter partes* review of U.S. Patent No. 10,255,724 (“the ’724 Patent”), Case No. IPR2023-00959, with the United States Patent and Trademark Office. This Joint Motion was authorized by the Board via email on April 12, 2024.

The Parties entered into a Covenant Not to Sue (“CNS”) on February 26, 2024 with respect to the ’724 Patent and agreed to terminate this *inter partes* review. In the related litigation before the United States District Court for the Western District of Texas, Austin Division, under the case number 1:23-CV-01212-ADA-DTG, the Parties filed a Joint Stipulation of Partial Dismissal with Prejudice (“Joint Stipulation”) requesting the Court to enter a proposed Order Granting Partial Dismissal with Prejudice (“Proposed Order”) to dismiss with prejudice all claims for direct or indirect infringement asserted with respect to the ’724 Patent. A true copy of the Joint Stipulation, Proposed Order, and CNS is filed as Exhibit 1011, and the CNS is Exhibit A to the Joint Stipulation. There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

No other petitioners remain in this *inter partes* review, and no Final Written Decision on the merits has been entered. 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).

Respectfully submitted,

/Philip W. Woo/

Philip W. Woo, Reg. No. 39,880
PWWoo@duanemorris.com
DUANE MORRIS LLP
2475 Hanover Street
Palo Alto, CA 94304

*Attorney for Petitioner Sony Interactive
Entertainment LLC*

/Kevin S. Tuttle/

Kevin S. Tuttle, Reg. No. 52,307
Spencer Fane LLP
1000 Walnut Street, Suite 1400
Kansas City, Missouri 64106-2140
Telephone: (816) 474-8100

*Attorney for Patent Owner
Quantum Imaging LLC*

Date: April 12, 2024

CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), that service was made on Patent Owner as detailed below.

Date of service April 12, 2024

Manner of service Electronic Service: ktuttle@spencerfane.com;
pdunn@spencerfane.com;
hrafatijo@spencerfane.com;
dsorocco@dunlapcoddling.com;
erobinson@spencerfane.com;
keliott@spencerfane.com;
mbrockhaus@dunlapcoddling.com

Documents served **Joint Motion to Terminate Pursuant to 35 U.S.C.
§ 317(a)**

Persons served SPENCER FANE LLP
Kevin S. Tuttle
Homayoon Rafatijo
Kyle L. Elliott
1000 Walnut Street, Suite 1400
Kansas City, MO 64106

Erick S. Robinson
Patrick M. Dunn
3040 Post Oak Boulevard, Suite 1300
Houston, TX 77056

DUNLAP CODDING
Marc Brockhaus
Douglas J. Sorocco
609 W. Sheridan Avenue
Oklahoma City, OK 73102

Respectfully submitted,

/Philip W. Woo/
Philip W. Woo, Reg. No. 39,880
PWWoo@duanemorris.com
DUANE MORRIS LLP
2475 Hanover Street
Palo Alto, CA 94304

Lead Counsel for Petitioner