

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SONY INTERACTIVE ENTERTAINMENT LLC,
Petitioner,

v.

QUANTUM IMAGING LLC,
Patent Owner.

IPR2023-00959
Patent 10,255,724 B2

Before SCOTT A. DANIELS, KEVIN W. CHERRY, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

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

Petitioner (Sony Interactive Entertainment LLC) and Patent Owner (Quantum Imaging LLC) have indicated that they have reached an agreement to settle the above-identified *inter partes* review proceeding. The Board authorized Petitioner and Patent Owner (collectively “the Parties”) to file a joint motion to terminate the proceeding on April 12, 2024.

On April 12, 2024, pursuant to 37 C.F.R. § 42.74 and 35 U.S.C. § 317(a), the Parties filed a Joint Motion to Terminate the above-identified proceeding. Paper 23 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy (Ex. 1011) of (i) a covenant not to sue (“Covenant”) the Parties entered with respect to US 10,255,724, (ii) a Joint Stipulation of Partial Dismissal with Prejudice (“Joint Stipulation”) filed in a related District Court case¹ requesting the District Court to enter a proposed Order granting partial dismissal with prejudice (“Order”) to dismiss all claims for direct or indirect infringement asserted with respect to US 10,255,724, and (iii) the unsigned Order. *See* Ex. 1011; 37 C.F.R. § 42.74(b) (any agreement between the parties made in connections the termination of a proceeding shall be in writing and filed with the Board).

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified proceeding, and that the filed copy of the Covenant, Joint Stipulation, and Order is a “true copy.” Joint Motion 3. The Parties further represent that “[t]here are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under

¹ *Quantum Imaging LLC v. Sony Group Corporation et al.*, Case No. 1:23-cv-01212-ADA-DTG (W.D. Tex.).

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 proceeding is at an intermediate stage. We have not yet decided the merits of this proceeding, and a final written decision has not been entered in this proceeding. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral argument and issuing a final written decision to decide the patentability issues raised in the Petition. 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’ settlement and representations, we determine that good cause exists to terminate this proceeding. Accordingly, we *grant* the Joint Motion.

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

Accordingly, it is:

ORDERED that the Joint Motion (Paper 23) to terminate the above-identified proceeding is *granted*, and IPR2023-00959 is *terminated* as to all parties.

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