

UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT TRIAL AND APPEAL BOARD

AMAZON.COM, INC., AND AMAZON.COM SERVICES LLC,
PETITIONER,

V.

LIGHTGUIDE, INC.
PATENT OWNER.

CASE: 2023-01423
U.S. PATENT NO. 10,528,036

**JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS
CONFIDENTIAL INFORMATION AND TO MAINTAIN SAID
AGREEMENT SEPARATE FROM THE PUBLIC FILE PURSUANT AND
37 C.F.R. § 42.74(c)**

List of Exhibits

Exhibit No.	Description
1001	U.S. Patent No. 10,528,036 (cited as '036 patent)
1002	Prosecution history to '036 patent
1003	Declaration of William Singhose (technical expert) re: '036 patent (cited as "Singhose")
1004	Curriculum Vitae of Dr. William Singhose
1005	Rick Kjeldsen et al., Interacting with Steerable Projected Displays (in Proc. of 5th Int'l Conf. on Automatic Face and Gesture Recognition (May 20-21, 2002)) (downloaded from https://web.archive.org/web/20050410205612/http://www.research.ibm.com/ed/publications/fg02.pdf) (cited as "Kjeldsen")
1006	Claudio Pinhanez et al., Ubiquitous Interactive Graphics (dated May 17, 2002, downloaded from https://web.archive.org/web/20060208095408/http://www.research.ibm.com/ed/publications/rc22495.pdf) (cited as Pinhanez-I)
1007	Declaration of Nathaniel E. Frank-White of the Internet Archive
1008	Declaration of James Mullins (library practices and public availability expert) re: availability of prior art.
1009	Declaration of Rick Kjeldsen
1010	U.S. Patent No. 6,833,863
1011	RESERVED

Exhibit No.	Description
1012	Docket Control Order Granting Joint Motion for Entry of Proposed Docket Control Order, D.I. 62 in LightGuide, Inc. v. Amazon.com, Inc., et al., Case No. 2:22-CV-00433-RWS-RSP (E.D. Texas)
1013	Case Docket for Amazon.com, Inc., et al. v. LightGuide, Inc., Case No. 2:23-cv-00053-JHC (W.D. Wa.)
1014	Claudio Pinhanez et al., Applications of Steerable Projector-Camera Systems (in Proc. Of ICCV Workshop on Projector-Camera Systems (PROCAMS'03)) (cited as Pinhanez-II)
1015	Claudio Pinhanez and Gopal Pingali, Projector-camera Systems for Telepresence (in Proc. of the 2004 ACM SIGMM Workshop on Effective Telepresence) (cited as Pinhanez-III)
1016	Tamotsu Machino et al., Robot-Augmented Communication: A Remote-collaboration System based on a Shared Field of View in Real Space (in Proc. of 2005 IEEE Int'l Conference on Robotics & Automation) (cited as Machino-I)
1017	Tamotsu Machino et al., Remote-Collaboration System using Mobile Robot with Camera and Projector (in Proc. of the 2006 IEEE Int'l Conf. on Robotics and Automation) (cited as Machino-II)
1018	Tetsuo Iyoda et al., LightCollabo: Distant Collaboration Support System for Manufacturers (in Proc. of 14th Int'l Multimedia Modeling Conference (2008)) (cited as Iyoda)
1019	Short Form Settlement Agreement

Exhibit No.	Description
1020	Long Form Settlement Agreement

Pursuant to 37 C.F.R. § 42.74(c), and the Board’s authorization of January, 19 2024, Amazon.com, Inc. and Amazon.com Services LLC (collectively “Petitioner”) and Patent Owner LightGuide, Inc. (“Patent Owner”) jointly request to treat as business confidential information the true copy of the Short Form and Long Form Settlement Agreements (Confidential Exhibit 1019 and Confidential Exhibit 1020, respectively) between the parties, as referenced in the parties’ Joint Motion to Terminate Pursuant to 37 C.F.R. § 42.74, filed concurrently herewith.

37 C.F.R. § 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

- (1) To a Government agency on written request to the Board; or
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

The present request, which is being filed contemporaneously with the Settlement Agreements, is timely and in accordance with the foregoing authority.

Therefore, the parties request that the Settlement Agreement (Confidential Exhibits 1019 and 1020) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) shall be made available only to Federal Government agencies on written request, or to persons showing good cause on written request, pursuant to 37 C.F.R. § 42.74(c).

Dated: February 8, 2024

HUESTON HENNIGAN LLP

By: /s/ Thomas B. King

Thomas B. King

Reg. No. 69,721

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on February 8, 2024, a true and correct copy of the foregoing **JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION AND TO MAINTAIN SAID AGREEMENT SEPARATE FROM THE PUBLIC FILE PURSUANT TO 37 C.F.R. § 42.74(c)** was served via electronic mail on the following counsel of record for Patent Owner:

James T. Carmichael
Stephen T. Schreiner
Stephen McBride
Minghui Yang
CARMICHAEL IP, PLLC
8000 Towers Crescent Drive, 13th Floor
Tysons Corner, VA 22182
Email: jim@carmichaelip.com
Email: schreiner@carmichaelip.com
Email: stevemcbride@carmichaelip.com
Email: mitch@carmichaelip.com
Email: susan@carmichaelip.com

By: /s/ Thomas B. King
Thomas B. King
Reg. No. 69,721

Counsel for Petitioner