

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VUSIONGROUP SA,

Petitioner,

v.

HANSHOW TECHNOLOGY CO., LTD.,

Patent Owner.

Case No. IPR2024-00963
U.S. Patent No. 10,701,321

JOINT MOTION TO TERMINATE PROCEEDING

Petitioner VusionGroup SA (“Petitioner”) and Patent Owner Hanshow Technology Co., Ltd. (“Patent Owner”) (collectively, the “Settling Parties”) have reached a settlement. Under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, the Settling Parties jointly move to terminate the present *inter partes* review proceeding and request that their Memorandum of Understanding be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Board authorized the parties to file this Joint Motion on May 30, 2025 via email.

I. STATEMENT OF FACTS

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26, at *2 (July 28, 2014).

On December 19, 2023, Patent Owner (together with related party Shanghai Hanshi Information Technology Co., Ltd.) filed a lawsuit against Petitioner (and related parties Captana GmbH and VusionGroup GmbH) alleging infringement of U.S. Patent No. 10,701,321 (“’321 patent”) in the United States District Court for the Eastern District of Texas (*Hanshow Technology Co., Ltd. v. SES-Imagotag SA*, No.

2-23-cv-00617 (E.D. Tex.)). On May 27, 2025, the parties to that case jointly moved to stay all deadlines in anticipation of settlement. The District Court granted the joint motion on May 28, 2025. On May 29, 2025, the parties jointly moved to dismiss all claims and causes of action asserted by and between the parties with prejudice.

The Settling Parties have reached an agreement (the “Memorandum of Understanding”) to resolve their disputes.

Under 37 C.F.R. § 42.74(b), the Memorandum of Understanding is in writing, and a true and correct copy is being filed as Exhibit 1032. A “Joint Request to File Memorandum of Understanding as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate Proceeding to treat the Memorandum of Understanding as business confidential information and keep it separate from the files of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Memorandum of Understanding contains confidential information of the Settling Parties.

II. RELIEF REQUESTED

The Settling Parties request termination of this *inter partes* review and respectfully submit that such termination is justified. “There are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Trial Practice Guide 86 (Nov. 2019). “The Board expects that a proceeding will terminate

after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” *Id.* (citing 35 U.S.C. § 317(a)).

The Board should terminate this proceeding in view of the Settling Parties’ joint request for the following reasons.

First, the Board instituted this IPR on December 11, 2024, and Patent Owner filed its Patent Owner Response on March 26, 2025. Petitioner has not yet filed a Reply. Accordingly, the Settling Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a).

Second, the Settling Parties have reached a settlement as to all disputes in this proceeding and as to the ’321 patent. A true copy of the Memorandum of Understanding is being filed concurrently herewith. *See* Exhibit 1032. The Memorandum of Understanding contains business confidential information of the Settling Parties. The Settling Parties request that the Memorandum of Understanding be treated as business confidential information and be kept separate from the files of this proceeding pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c).

The Memorandum of Understanding also references a potential comprehensive final agreement. If such an agreement is entered, the Settling Parties will jointly seek authorization to file that agreement as business confidential information pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74(c).

The Settling Parties hereby represent that the document filed as Exhibit 1032 and the potential comprehensive final agreement represent all agreements made in connection with, or in contemplation of, the termination of this proceeding. All such agreements have been or will be filed with the Board as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

Third, termination would save the Settling Parties' from significant further expenditure of resources. Termination upon settlement would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of settlement.

III. CONCLUSION

For the foregoing reasons, the Settling Parties respectfully request termination of this *inter partes* review.

Respectfully submitted,

Dated: May 30, 2025

/ Jessica Kaiser /

Jessica Kaiser

Reg. No. 58,937

Kaiser-ptab@perkinscoie.com

PERKINS COIE LLP

1900 Sixteenth Street, Suite 1400

Denver, CO 80202

Tel: (303) 291-2300

Fax: (303) 291-2400

Counsel for Petitioner

/ Hao Tan /

Hao Tan (Reg. No. 73,711)

ARCH & LAKE LLP

203 North LaSalle Street

Suite 2100

Chicago, IL 60601

312-558-1369 (telephone)

312-614-1873 (facsimile)

haotan@archlakelaw.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 30, 2025 a true copy of the **JOINT MOTION TO TERMINATE PROCEEDING** was served upon the below listed counsel by electronic mail:

Hao Tan
haotan@archlakelaw.com

Shen Wang
shenwang@archlakelaw.com

Christopher Fahey
christopher@archlakelaw.com

Dated: May 30, 2025

By: / Jessica Kaiser /
Jessica C. Kaiser
Reg. No. 58,937
Lead Counsel for Petitioner