

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.
Petitioner

v.

THALES VISIONIX, INC.
Patent Owner

U.S. PATENT NO. 6,922,632

IPR2022-01304

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

Petitioner Meta Platforms, Inc. (“Petitioner”) and patent owner Thales Visionix, Inc. (“Patent Owner”) (collectively, the “Parties”) jointly request to terminate IPR2022-01304 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on January 16, 2024.

I. BACKGROUND

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 (P.T.A.B. July 28, 2014). Each of these background issues is discussed below in turn.

(1) Brief Explanation

Real party-in-interest Gentex Corporation (“Gentex”), which was the exclusive licensee of the patent at issue in this proceeding within certain relevant fields of use, and Petitioner have entered into a Patent License And Settlement Agreement (the “Meta-Gentex Agreement”).¹ The Meta-Gentex Agreement is a true

¹ The Parties are filing the Meta-Gentex Agreement concurrently with this joint motion as Exhibit 1042, along with a “Joint Request to File Document as Business Confidential Information.” *See* Exhibit 1042. Petitioner’s Updated

copy of any “agreement or understanding ... including any collateral agreements ... made in connection with, or in contemplation of, the termination of” this inter partes review. *See* 35 U.S.C. § 317(b).

Patent Owner is not a party to the Meta-Gentex Agreement. Patent Owner disputes the enforceability of a Term Sheet mentioned and referenced in the Meta-Gentex Agreement (Exhibit C to the Meta-Gentex Agreement, which is included in Exhibit 1042), while Petitioner contends that the Term Sheet is enforceable and binding on Patent Owner. However, this dispute is not pertinent to this IPR and should not affect its termination.

Patent Owner and Petitioner both believe that this proceeding should be terminated. No Final Written Decision is expected in this proceeding for approximately two more months.

(2) Related Litigation

Gentex and Indigo Technologies, LLC (collectively, the “Voluntary Plaintiffs”) asserted the patent at issue in this proceeding in *Gentex Corporation et al. v. Meta Platforms, Inc. et al.*, No. 6:21-cv-00755-ADA (W.D. Tex.), which was transferred to the Northern District of California, No. 4:22-cv-03892-YGR. Patent Owner was named as an involuntary plaintiff in that proceeding. On January 12,

Exhibit List, which includes this document, is appended as Appendix A to this document.

2024, the Voluntary Plaintiffs and Petitioner filed a joint motion to dismiss this district court litigation.

There are no other litigations pending related to the patent at issue in this proceeding.

(3) Related Proceedings Before the Office

The following IPRs between the same Parties have also been instituted and relate to patents that were also asserted in the same district court litigation referenced above: IPR2022-01294, IPR2022-01298, IPR2022-01301, IPR2022-01302, IPR2022-01303, IPR2022-01305, and IPR2022-01308.

(4) Status of Related Litigation and Proceedings Before the Office

As noted above, the Voluntary Plaintiffs and Petitioner have filed a joint motion to dismiss the district court litigation.

The Parties are jointly moving to terminate all of the IPRs referenced above.

II. STATEMENT OF RELIEF REQUESTED

Under § 317(a), an *inter partes* review “*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.” The Parties jointly request termination of this IPR2022-01304, and the Office has not decided the merits of this IPR proceeding. There are no other preconditions of § 317(a). Therefore, the Parties have met the statutory requirement

to terminate the proceeding before the Office has decided the merits of the proceeding, and good cause exists to terminate this proceeding. *See* 35 U.S.C. § 317(a).

III. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR.

Date: February 5, 2024

Respectfully submitted,

/Josh Glucoft/

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