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: 2024-00141
U.S. PATENT NO. 7,515,981

JOINT MOTION TO TERMINATE PURSUANT TO 37 C.F.R. § 42.74

List of Exhibits

Petitioner Exhibit No.	DESCRIPTION
1001	U.S. Patent No. 7,515,981 (cited as "'981 patent")
1002	File History of U.S. Patent No. 7,515,981
1003	Declaration of Dr. William Singhose
1004	*Curriculum Vitae* of Dr. William Singhose
1005	European Patent Application Publication No. 0,470,901
1006	English Translation of European Patent Application Publication No. 0,470,901A1 (cited as "Poggi")
1007	Declaration of Danelle Shaw (Translator of European Patent Application Publication No. 0,470,901)
1008	U.S. Patent No. 6,547,397 (cited as "Kaufman")
1009	Claudio Pinhanez et al., *Applications of Steerable Projector-Camera Systems, in* Proceedings of the IEEE International Workshop on Projector-Camera Systems at ICCV (2003) (cited as "Pinhanez")
1010	Siemens SIMATIC VS 72X / SIMATIC Spectation Manual (cited as "SIMATIC")
1011	U.S. Patent No. 2,682,117
1012	Scott Blake, *Improving Manual Manufacturing with a Computer Based Laser Projection System*, 102-5 SAE Transactions: J. Materials & Manufacturing (1993)
1013	Karen Mason, *Laser projection systems improve composite ply placement*, CompositeWorld (Mar. 1, 2004), https://www.compositesworld.com/articles/laser-projection-systems-improve-composite-ply-placement
1014	Hiroshi Ishii et al., *Tangible bits: towards seamless interfaces between people, bits and atoms*, *in* Proceedings of ACM SIGCHI Conference on Human factors in computing systems 234-241 (Mar. 1997)

1015	Rodney A. Brooks, *The Intelligent Room Project*, *in* Proceedings 2nd Int'l Conference on Cognitive Technology Humanizing the Information Age 271-278 (Aug. 1997)
1016	Ramesh Raskar et al., *The Office of the Future: A Unified Approach to Image-Based Modeling and Spatially Immersive Displays*, *in* Proceedings of SIGGRAPH Annual Conference on Graphics 179-188 (1998)
1017	John Underkoffler et al., *Emancipated pixels: real-world graphics in the luminous room*, *in* Proceedings of the 26th Conference on Computer Graphics and Interactive Techniques 385-392 (Jul. 1999)
1018	Excerpt entitled "Chapter 10, Manual, light-guided, semiautomatic and robotic assembly" from P.J.W. Noble, Printed Circuit Board Assembly 117-126 (1989)
1019	U.S. Patent No. 5,506,641
1020	Michael Robertson & William Singhose, *Evaluation of Analytic Deflection-Limiting Commands*, *in* Proceedings of 16th IFAC World Congress 598-603 (Jul. 2005)
1021	Khalid Sorensen, William Singhose, & Stephen Dickerson, *A Controller Enabling Precise Positioning and Sway Reduction in Cranes with On-off Actuation*, *in* Proceedings of 16th IFAC World Congress (Jul. 2005)
1022	Jason Lawrence & William Singhose, *Design of a Minicrane for Education and Research*, *in* Proceedings of 6th International Workshop on Research and Education in Mechatronics (2005)
1023	Khalid Lief Sorensen, *A Combined Feedback and Command Shaping Controller for Improving Positioning and Reducing Cable Sway in Cranes*, Master Thesis in Dept. Mechanical Eng'g, Georgia Inst. of Tech. (Feb. 2005)
1024	U.S. Patent Application Publication No. 2007/0236354 (cited as "Green")
1025	Declaration of Rick Kjeldsen (former IBM researcher)
1026	Declaration of James L. Mullins (library practices and public availability expert)

1027	USPTO Record of patents assigned to Laser Projection Technologies
1028	Short Form Settlement Agreement
1029	Long Form Settlement Agreement

Pursuant to 37 C.F.R. §§ 42.74, 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 move to terminate the present *inter partes* review proceeding with respect to Petitioner in light of Patent Owner's and Petitioner's settlement of their dispute regarding U.S. Patent No. 7,515,981 ("the ' 981 Patent").

Petitioner and Patent Owner are concurrently filing a true copy of their written short form and long form Settlement Agreements (Confidential Exhibits 1028 and 1029) in connection with this matter as required by regulation. Petitioner and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding with respect to Petitioner. A joint request to treat the Settlement Agreements as business confidential information kept separate from the file of the involved patent pursuant to 37 C.F.R. § 42.74(c) is being filed concurrently.

LEGAL STANDARD

"The parties may agree to settle any issue in a proceeding, but the Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice." § 42.74(a). 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 No. 26, at 2 (P.T.A.B. July 28, 2014).

The Board has consistently granted a request to terminate a proceeding for both the Petitioner and Patent Owner when the request is filed before briefing has completed, which is the case here. *See, e.g., Itron, Inc. v. Certified Measurement, LLC*, IPR2015-00570, Paper 28, at 2-3 (P.T.A.B. February 16, 2016) (terminating the proceedings for both Patent Owner and Petitioner while noting that since "Petitioner has not yet filed a Reply in any of the cases, … if we do not terminate these proceedings with respect to Patent Owner, … [the Board] will be required to determine patentability on less than a full record"); *CB Distributors, Inc. and DR Distributors, LLC v. Fontem Holdings 1 B.V.*, IPR2014-01529, Paper 41, at 4 (P.T.A.B. December 7, 2015) (terminating the proceedings for both Patent Owner and Petitioner where a reply to the Patent Owner Response had yet to be filed).

ARGUMENT

Termination of the present *inter partes* review proceeding is appropriate because (1) Petitioner and Patent Owner have resolved their dispute regarding the

’981 Patent and have agreed to terminate this proceeding, (2) the Office has not yet decided the merits of the proceeding, and (3) public policy favors the termination.

The Board has not yet instituted trial and a decision is not expected for some time. The early stage of the proceeding strongly favors termination. *See, e.g.*, *Itron, Inc.*, IPR2015-00570, Paper 28, at 2-3; *CB Distributors*, IPR2014-01529, Paper 41, at 4.

Public policy also favors the termination. As recognized by the rules of practice before the Board:

> There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. 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.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012); Consolidated Trial Practice Guide (Nov. 2019), 86. Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements regarding the identification and status of related proceedings, Petitioner and Patent Owner

represent that there are not any other proceedings before the Board on the '981 Patent. There is one related district court litigation, in which Petitioner and Patent Owner are both parties, as identified in the Mandatory Notices. The parties to this related litigation have filed a joint motion to dismiss the action in its entirety, including all claims regarding the '981 Patent. The motion is currently pending. As such, there are no parties that would obtain any benefit by the continuance of this proceeding.

Additionally, Petitioner and Patent Owner are parties to IPR proceedings in IPR2023-01423 and IPR2024-00130, which concern patents which were also at issue in the district court litigation. Contemporaneously with this motion, Petitioner and Patent Owner are also filing Joint Motions to Terminate those IPR proceedings as well.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

Dated: February 12, 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 12, 2024, a true correct copy of the foregoing **JOINT MOTION TO TERMINATE** was served via electronic mail on the following counsel of record for Patent Owner:

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