

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZF FRIEDRICHSHAFEN AG, ZF ACTIVE SAFETY AND
ELECTRONICS US LLC, AND NISSAN MOTOR COMPANY, LTD.,
Petitioner,

v.

FORAS TECHNOLOGIES LTD.,
Patent Owner.

Case IPR2024-00969
Patent 7,502,958 B2

**JOINT MOTION TO WITHDRAW
PETITION FOR *INTER PARTES* REVIEW**

PETITIONER’S UPDATED EXHIBIT LIST

Previously Filed:

- Ex. 1001: U.S. Patent No. 7,502,958 to Michaelis et al. (“the ’958 Patent”)
- Ex. 1002: Declaration of Dr. Jacob Baker
- Ex. 1003: Curriculum Vitae of Dr. Jacob Baker
- Ex. 1004: Prosecution History of the ’958 Patent
- Ex. 1005: U.S. Patent Application Publication No. US 2003/0126498A1 to Bigbee et al., filed January 2, 2002, published July 3, 2003 (“Bigbee”)
- Ex. 1006: U.S. Patent Application Publication No. US 2004/0123201 A1 to Nguyen et al., filed December 19, 2002, published June 24, 2004 (“Nguyen”)
- Ex. 1007: U.S. Patent Application Publication No. US 2004/0006722 A1 to Safford, filed July 3, 2002, published Jan. 8, 2004 (“Safford”)
- Ex. 1008: U.S. Patent No. 7,085,959 B2 to Safford, filed July 3, 2002, published August 1, 2006 (“Safford-959”)
- Ex. 1009: U.S. Patent No. 7,296,181 B2 to Safford, filed April 6, 2004, published November 13, 2007 (“Safford-181”)
- Ex. 1010: U.S. Patent Application Publication No. US 2002/0144177 A1 to Kondo et al., filed January 31, 2002, published October 3, 2002 (“Kondo”)
- Ex. 1011: U.S. Patent No. 6,516,429 B1 to Bossen et al., filed November 4, 1999, published February 4, 2003 (“Bossen”)
- Ex. 1012: U.S. Patent No. 6,158,015 to Klein, filed March 30, 1998, published December 5, 2000 (“Klein”)
- Ex. 1013: U.S. Patent Application Publication No. US 2005/017216 A1 to Fox et al., filed January 21, 2004, published August 4, 2005 (“Fox”)

- Ex. 1014: U.S. Patent No. 7,404,105 B2 to Arai, filed August 16, 2004, published July 22, 2008 (“Arai”)
- Ex. 1015: U.S. Patent No. 6,675,324 B2 to Marisetty et al., filed September 27, 1999, published January 6, 2004 (“Marisetty”)
- Ex. 1016: U.S. Patent Application Publication No. US 2003/0074601 A1 to Schultz et al., filed September 28, 2001, published April 17, 2003 (“Schultz”)
- Ex. 1017: U.S. Patent Application Publication No. 2003/0126142 A1 to Tu et al., filed December 31, 2001, published July 3, 2003 (“Tu”)
- Ex. 1018: U.S. Patent No. 5,915,082 to Marshall et al., filed June 7, 1996, published June 22, 1999 (“Marshall”)
- Ex. 1019: Reserved
- Ex. 1020: PCT Patent Application WO 01/80007 A2 to Suffin, filed April 12, 2001, published Oct. 25, 2001 (“Suffin”)
- Ex. 1021: U.S. Patent No. 5,627,962 to Goodrum et al., filed Dec. 30, 1994, published May 6, 1997 (“Goodrum”)
- Ex. 1022: Advanced Configuration and Power Interface Specification, Revision 2.0, July 27, 2000 (“ACPI 2.0”)
- Ex. 1023: Reserved
- Ex. 1024: Reserved
- Ex. 1025: Prosecution History of U.S. Patent No. 7,356,733
- Ex. 1026: Request for Ex Parte Reexamination of the ’958 Patent, Control No. 90/019,245 (Sept. 1, 2023)
- Ex. 1027: Order granting stay in *Foras Technologies Ltd. v. Nissan Motor Company, Ltd. and ZF Friedrichshafen AG*, Case No. 1-23-cv-00640 (W.D. Tex)
- Ex. 1028: Infringement contention cover pleading for ZF in *Foras Technologies Ltd. v. Nissan Motor Company, Ltd. and ZF Friedrichshafen AG*, Case No. 1-23-cv-00640 (W.D. Tex)

Ex. 1029: Infringement contention cover pleading for Nissan in *Foras Technologies Ltd. v. Nissan Motor Company, Ltd. and ZF Friedrichshafen AG*, Case No. 1-23-cv-00640 (W.D. Tex)

Ex. 1030: U.S. Patent No. 5,790,850 to Natsu, filed September 30, 1996, published August 4, 1998 (“Natsu”)

Filed Herewith:

Ex. 1031: BUSINESS CONFIDENTIAL Settlement Agreement

Pursuant to 37 C.F.R § 42.74 and the authorization provided by the Board email of October 24, 2024, Petitioners ZF Friedrichshafen AG, ZF Active Safety and Electronics US LLC, and Nissan Motor Company, Ltd. (“Petitioners”) and Patent Owner Foras Technologies Ltd. (“Patent Owner”) jointly request withdrawal of the Petition filed in this proceeding, IPR2024-00969, directed to U.S. Patent No. 7,502,958 (the “’958 Patent”).

I. CERTIFICATION

Petitioners and Patent Owner submit a true copy of any agreement or understanding (Exhibit 1031) between Petitioners and Patent Owner made in connection with, or in contemplation of, the withdrawal of the Petition for the proceeding under 37 CFR § 42.74(b) with this joint motion. There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

II. STATUS OF RELATED PROCEEDINGS

Petitioners and Patent Owner have resolved their disputes regarding the ’958 Patent, including both in this proceeding and Patent Owner’s assertion of the ’958 Patent in the related district court litigation, 1:23-cv-00640-RP (W.D. Tex.). The parties do not anticipate further litigation between them concerning the ’958 Patent. The following related proceeding is currently before the Board: IPR2024-00727.

III. RELIEF REQUESTED

As authorized by the Board, the parties are jointly and contemporaneously filing: (i) this joint motion to withdraw the Petition; (ii) a true copy of any agreement or understanding (Exhibit 1031) between Petitioners and Patent Owner made in connection with, or in contemplation of, the requested withdrawal of the Petition; and (iii) a joint request to treat the agreement as business confidential information and keep the agreement (Exhibit 1031) separate from the file of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Petitioners and Patent Owner jointly request that the Board terminate this proceeding in its entirety. Termination is appropriate at this stage and in view of a settlement between Petitioners and Patent Owner. 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 proceedings before the request for termination is filed. 35 U.S.C. § 317(a). Good cause exists to terminate this proceeding because (1) Petitioners and Patent Owner have resolved their disputes regarding the '958 Patent; (2) this proceeding is still at an early stage because the Office has not yet decided whether to institute trial; and (3) terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

Dated: October 25, 2024

Respectfully submitted

/John R. Hutchins/

John R. Hutchins
Reg. No. 43,686
Banner & Witcoff, Ltd.
Attorney for Petitioners

Dated: October 25, 2024

Respectfully submitted

/Brett Cooper/

Brett Cooper
Reg. No. 55,085
BC Law Group, P.C.
Attorney for Patent Owner

CERTIFICATE OF COMPLIANCE

This paper complies with the type-volume limitation of 15 pages, excluding those parts exempted by 37 C.F.R. § 42.24. This motion complies with the general formatting requirements of 37 C.F.R. § 42.6 and has been prepared using Microsoft Word 2016 in 14-point Times New Roman font.

Dated: October 25, 2024

/John R. Hutchins/

John R. Hutchins
Reg. No. 43,686

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that I caused a true and correct copy of this JOINT MOTION TO WITHDRAW PETITION FOR *INTER PARTES* REVIEW in connection with IPR2024-00969 to be served via e-mail on October 25, 2024, in its entirety on the following counsel of record for Patent Owner:

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Dated: October 25, 2024

By: /Carlos Goldie/

Carlos Goldie