

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WINPLUS NORTH AMERICA, INC.,
Petitioner,

v.

SHENZHEN CARKU TECHNOLOGY CO., LTD.
Patent Owner.

U.S. Patent No. 10,148,105 to Lei

Case No.: IPR2023-00368

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW BEFORE
INSTITUTION**

Updated List of Exhibits

Exhibit No.	Description	Identifier
1001	Asserted U.S. Patent No. 10,148,105	The '105 Patent
1002	Prosecution history of the '105 Patent	'105 File History
1003	Prosecution history of the '105 Patent's reissue application No. 17/112,920 updated until Sept 30, 2022	Reissue History
1004	Declaration of Alex Z. Kattamis, Ph.D.	
1005	U.S. Patent Application Pub. No. 2016/0268645	Koebler
1006	Chinese Utility Model No. CN204905522U	Liu
1007	German Utility Model No. 202015103173	Zonesking
1008	U.S. Patent No. 8,493,021	Richardson
1009	U.S. Patent No. 9,007,015	Nook
1010	U.S. Patent No. 3,267,452	The '452 Patent
1011	U.S. Patent No. 2,659,042	The '042 Patent
1012	U.S. Patent No. 4,163,134	The '134 Patent
1013	Balakrishnan Article	
1014	U.S. Patent Pub. No. 2014/0368155	The '115 Publication
1015	U.S. Patent No. 3,950,688	The '688 Patent
1016	U.S. Patent No. 4,871,957	The '957 Patent
1017	U.S. Patent No. 5,909,103	The '103 Patent
1018	U.S. Patent No. 7,446,508	The '508 Patent
1019	U.S. Patent No. 7,592,778	The '778 Patent
1020	U.S. Patent No. 4,366,430	The '430 Patent
1021	U.S. Patent No. 4,463,402	The '402 Patent
1022	U.S. Patent No. 4,769,586	The '586 Patent
1023	U.S. Patent No. 4,488,147	The '147 Patent
1024	CV of Alex Z. Kattamis, Ph.D.	
1025	Shenzhen Carku v. Winplus, Case No. 8:21-cv-02021, Complaint w-exhibits (DN1)	
1026	Shenzhen Carku v. Winplus, Case No. 8:21-cv-02021, Stay Order (DN40)	
1027 NEW	Settlement Agreement HIGHLY CONFIDENTIAL	

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Petitioner Winplus North America, Inc. (“Winplus”) and Patent Owner Shenzhen Carku Technology Co., Ltd. (“Carku”) jointly request the Board to terminate and dismiss the *inter partes* review of U.S. Patent No. 10,148,105 (“Patent-in-Suit”), Case IPR2022-00368.

The parties were authorized to file this Joint Motion by the Board (via email) on May 25, 2023. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a copy of the settlement agreement has been made in writing, and a true copy thereof is filed herewith as confidential Exhibit 1027.¹ There are no other collateral agreements between the parties made in connection with, or in contemplation of, the dismissal sought.

I. STATEMENT OF PRECISE RELIEF REQUESTED

The parties jointly request that the Board dismiss the *inter partes* review of the Patent-in-Suit, Case IPR2023-00368 for U.S. Patent No. 10,148,105.

¹ The Settlement Agreement between the parties is filed electronically via the PTAB E2E system as “Available to Parties and Board” pursuant to a Joint Request to Treat Settlement Agreement as Business Confidential Information Kept Separate from Files of Involved Patent under 35 U.S.C. § 317(b) and 37 CFR § 42.74(c) filed concurrently herewith.

II. DISMISSAL IS APPROPRIATE

Pursuant to 37 C.F.R. § 42.74, and the Board’s e-mail, Winplus requests that its petition be dismissed. See *Unified Patents, LLC v. Motion Offense, LLC*, IPR2020-00705, Paper 14 at 2, 7 (PTAB Sept. 23, 2020) (“We agree with Petitioner that dismissal is appropriate under the present circumstances. Our regulations expressly provide the Board with broad authority to dismiss a petition where appropriate.”). This *inter partes* review is still in its early stage. The Petition was filed on December 16, 2022, and the Board has not yet instituted, much less decided the merits of the proceeding. Accordingly, the Board should dismiss this proceeding. See *Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 at 4 (PTAB Dec. 9, 2015) (granting motion to dismiss before institution because the proceeding was at an “early juncture” and “to promote efficiency and minimize unnecessary costs”).

Carku and Winplus are also seeking dismissal of the lawsuit between the parties and the parties do not contemplate any litigation or proceeding involving the Patent-in-Suit in the foreseeable future. (Exhibit 1027).

III. CONCLUSION

Carku and Winplus have settled all disputes relating to the Patent-in-Suit. This *inter partes* review is in an early stage, and the Board has not instituted and not entered a final written decision on the merits in this proceeding. Accordingly, the parties respectfully request that the Board dismiss this proceeding.

Date: May 26, 2023

Respectfully submitted,

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Certificate of Service

The undersigned hereby certifies that on May 26, 2023, a complete and entire copy of JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW BEFORE INSTITUTION, was served via electronic mail to CARKU-Winplus-IPR@bayes.law which includes all of the following counsel:

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