

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,

Petitioner,

v.

SURGETECH LLC,

Patent Owner.

Case IPR2023-00736
Patent No. 11,334,598

JOINT MOTION TO TERMINATE

I. STATEMENT OF RELIEF REQUESTED

As authorized by the Board's order dated May 25, 2023, Petitioner submits this joint motion of the parties to terminate this *inter partes* review pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, as well as 35 U.S.C. § 314. On May 15, 2023, the parties filed a joint proposed stipulation that the Board grant Petitioner's Motion to Waive Word Count (Paper 5) in IPR2023-00735, and on May 25, 2023, the Board granted that motion and authorized this Motion to Terminate (Paper 10).

II. STATEMENT OF FACTS

In support of the Motion to Terminate, the parties state as follows:

Petitioner filed its petition for *inter partes* review of U.S. Patent No. 11,334,598 ("598") on March 28, 2023 ("IPR2023-00736"). IPR2023-00736 addressed only claims 6-7, 14-15, and 19-20. On the same day, Petitioner filed another petition in IPR2023-00735 for *inter partes* review of the same patent, '598 ("IPR2023-00735"). The long version of IPR2023-00735, which was subject to the motion to waive word count, covered claims 1-20. The short version of IPR2023-00735, which was provided in the event the motion to waive word count was denied, addressed claims 1-5, 8-13, and 16-18. Petitioner simultaneously filed a Motion to Waive Word Count (Paper 5) in IPR2023-00735. Petitioner also filed an Explanation of Parallel Petitions in both cases. *Uber Techs., Inc. v. SurgeTech LLC*, IPR2023-00735, Pap.4 (Mar. 28, 2023); *Uber Techs., Inc. v. SurgeTech LLC*,

IPR2023-00736, Pap.3 (Mar. 28, 2023). In those papers, Petitioner explained that IPR2023-00736 would be moot in the event the motion to waive word count in IPR2023-00735 was granted because the substance of IPR2023-00736 would be entirely subsumed in IPR2023-00735. *See id.* at 6.

On April 27, 2023, Patent Owner requested via email permission to respond to Petitioner's Motion to Waive Word Count. On April 28, 2023, the Board instructed the parties to "meet-and-confer to determine whether agreement may be reached on a proposed approach that enables consideration of institution of review of all challenged claims in a single proceeding, including, for example, waiver of the word count as to the Petition filed in IPR2023-00735, as sought by Petitioner, with a corresponding increase in the word count for briefing filed by Patent Owner."

Ultimately, on May 15, 2023 (Paper 5), the parties filed a stipulation, which, *inter alia*, noted that if the Panel entered the parties' stipulations regarding the motion to waive word count and related issues, Petitioner (joined by Patent Owner) would seek authorization to terminate IPR2023-00736 (without the Panel reaching any decision on the merits or any adverse judgment). The Board has now entered the terms of the stipulation, granted Petitioner's unopposed motion to waive word count, and authorized Petitioner to file the current Motion to Terminate.

III. STATEMENT OF RELATED LITIGATION

Patent Owner asserted '598 (and two related patents) against Uber Technologies, Inc. in *SurgeTech, LLC v. Uber Technologies, Inc. d/b/a Uber*, Case No. 1:22-cv-00882-GBW (D. Del.). That litigation is ongoing.

The only other *inter partes* review involving the '598 patent is IPR2023-00735, which, as a result of the Board's order in that case (Paper 10) already covers the claims and grounds addressed in IPR2023-00736.

IV. ARGUMENT

The statutory provision on joint termination of *inter partes* reviews provides that 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.” 35 U.S.C. § 317. 37 C.F.R. § 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).” 37 C.F.R. § 42.72.

Because the Board has not decided the merits of this *inter partes* review proceeding, and because the parties here are jointly requesting termination pursuant to the instruction of the Board, and because the entirety of the substance of IPR2023-00736 is encompassed in IPR2023-00735 (in light of the Board's

granting the motion to waive word count), the Board should terminate IPR2023-00736 under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, as well as 35 U.S.C. § 314.

V. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate IPR2023-00736.

Date: May 30, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on May 30, 2023 the foregoing document was served via email on the following counsel of record for the Patent Owner:

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Respectfully submitted,

/s/ Sayem Osman
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