

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.,
Petitioner,

v.

SURGETECH LLC,
Patent Owner.

IPR2023-00736
Patent 11,334,598 B2

Before JAMES A. TARTAL, MICHAEL L. WOODS, and
RYAN H. FLAX, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
37 U.S.C. § 314

I. INTRODUCTION

Uber Technologies, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 requesting an *inter partes* review of claims 6, 7, 14, 15, 19, and 20 of U.S. Patent No. 11,334,598 B2 (Ex. 1001, “the ’598 patent”). Paper 2 (“Pet.”). Petitioner also filed at the same time a separate petition under another proceeding challenging claims 1–20 of the ’598 patent. *Uber Technologies, Inc. v. Surgetech LLC*, IPR2023-00735, Paper 2. The grounds of unpatentability Petitioner asserts against claims 6, 7, 14, 15, 19, and 20 of the ’598 patent are the same in both the Petition (filed in this proceeding) and in the petition filed in IPR2023-00735. *Compare* Pet. 13–14, *with* IPR2023-00735, Paper 2 at 13–14.

In IPR2023-00735, the petition exceeded the default word count and Petitioner filed a motion to waive the word count in that proceeding. IPR2023-00735, Paper 5. In short, Petitioner filed the Petition in this proceeding as an alternative means of seeking *inter partes* review of claims 6, 7, 14, 15, 19, and 20 of the ’598 patent in the event the Board denied Petitioner’s motion to exceed the word limit for the petition filed in IPR2023-00735. *See, e.g.*, IPR2023-00735, Paper 4 at 1 (Petitioner’s Explanation of Parallel Petitions, stating that the petition filed in IPR2023-00736 “need only be considered in the event the Board denies Petitioner’s Motion to Waive Word Count in IPR2023-00735”).

Subsequently, in IPR2023-00735, we granted Petitioner’s motion to waive the word count and adopted the word limit adjustments for further briefing stipulated to by Petitioner and Patent Owner, Surgetech LLC, (collectively, the “Parties”) in that proceeding. IPR2023-00735, Paper 10. At the same time, in this proceeding we authorized the Parties to jointly file a motion to terminate the Petition. Paper 10. Thereafter, the Parties filed a

Joint Motion to Terminate (Paper 11 (“Motion” or “Mot.”)), which we grant for the following reasons.

II. DISCUSSION

We determine that it is appropriate to dismiss the Petition and terminate the proceeding as to both Petitioner and Patent Owner without rendering either a decision to institute or a final written decision. *See* 37 C.F.R. §§ 42.5(a); 42.71(a) (“The Board . . . may grant, deny, or dismiss any petition or motion.”). This case is in the preliminary proceeding stage. *See id.* § 42.2 (preliminary proceeding begins with the filing of a petition for instituting a trial and ends with a written decision as to whether trial will be instituted). No decision whether to institute a trial has been made. Patent Owner has not yet filed a preliminary response. As explained in the Motion, “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).” Mot. 3–4. Under the circumstances, we agree that dismissal of the Petition and termination of the proceeding at this stage will promote efficiency and avoid incurring unnecessary costs, while also enabling the Board to consider the arguments of the Parties in a single proceeding addressing claims 1–20 of the ’598 patent in IPR2023-00735. Accordingly, we grant the Motion, dismiss the Petition, and terminate all further proceedings in IPR2023-00736.

III. ORDER

Upon consideration of the record before us, it is:

ORDERED that the Joint Motion to Terminate (Paper 11) is granted;
FURTHER ORDERED that the Petition (Paper 2) is dismissed; and
FURTHER ORDERED that IPR2023-00736 is terminated.

IPR2023-00736
Patent 11,334,598 B2

FOR PETITIONER:

Megan Raymond
J. Steven Baughman
Michael Milea
GROOMBRIDGE, WU, BAUGHMAN & STONE LLP
megan.raymond@groombridgewu.com
steve.baughman@groombridgewu.com
mike.milea@groombridgewu.com

FOR PATENT OWNER:

James M. Glass
Quincy Lu
Eric Huang
QUINN EMANUEL URQUHART & SULLIVAN LLP
jimglass@quinnemanuel.com
quincylu@quinnemanuel.com
erichuang@quinnemanuel.com