

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTERN DIGITAL TECHNOLOGIES, INC.,

Petitioner,

v.

SHAMROCK INNOVATIONS, INC.,

Patent Owner.

Case No. IPR2023-00842

U.S. Patent No. 9,535,454

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317(a)**

Petitioner Western Digital Technologies, Inc. (“Petitioner”) and Patent Owner Shamrock Innovation, LLC. (“Patent Owner”) (collectively, “the Parties”) have resolved their dispute and jointly request termination of IPR2023-00842 under 35 U.S.C. § 317(a). The Board authorized the filing of this motion on October 03, 2024.

I. STATEMENT OF FACTS

The Parties have reached an agreement to resolve this *inter partes* review (IPR) proceeding. The Parties are filing the pertinent document resolving the proceeding concurrently with this joint motion, along with a “Joint Request That the Resolution Document Be Treated as Business Confidential and Be Kept Separate Under 35 U.S.C. § 317(b).”

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 26 at 2 (P.T.A.B. July 28, 2014).

(1) Brief Explanation

Termination is appropriate in this case because the Parties have resolved their dispute relating to U.S. Patent No 9,535,454 (“the ‘454 Patent”). A “Joint Request That the Resolution Document Be Treated as Business Confidential and Kept Separate Under 35 U.S.C. § 317(b)” is being filed concurrently with this motion. Additional details are provided below.

(2) Related Litigation

The ‘454 Patent is subject to the following pending lawsuit (the “Lawsuit”), where Petitioner is an intervenor:

- *Shamrock Innovations, LLC v. Lenovo (United States), Inc.*, Case No. 5:22-CV-102 (E.D. N.C.).

(3) Related Proceedings Before the Office

There are no other proceedings related to the ‘454 patent.

(4) Status of Related Litigation and Proceedings Before the Office

The Lawsuit is currently pending. As a result of the Parties’ resolution of the dispute, the Parties are filing a motion to dismiss the Lawsuit.

II. STATEMENT OF RELIEF REQUESTED

Due to the resolution of the disputes relating to the patent that is the subject of this IPR proceeding, the ‘454 Patent, the Parties jointly request termination of IPR2023-00842 under 35 U.S.C. § 317(a).

First, the Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under § 317(a), an *inter partes* review “shall” be terminated upon a joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of § 317(a).

Second, as noted, the Parties have resolved the disputes in this proceeding relating to the ‘454 Patent. A true copy of the document resolving the disputes related to the ‘454 Patent is filed concurrently herewith. *See* Exhibits 2017, 2018, 2019; 37 CFR § 42.74(b). The parties have requested that the resolution document be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c).

Finally, a termination of this proceeding will conserve the Board’s resources and obviate the need for any more Board involvement in this matter.

Termination is appropriate at this stage and in view of the resolution of this dispute between Petitioner 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). Accordingly, good cause exists to terminate this proceeding because Petitioner and Patent Owner have

resolved their disputes regarding the '454 Patent and terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties.

III. CONCLUSION

For these reasons, the Parties respectfully request termination of this IPR of the '454 Patent.

Respectfully submitted,

Dated: October 03, 2024

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Dated: October 03, 2024

By: / Jon R. Trembath /
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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317(a)** was served via email (as consented to by counsel) on October 03, 2024 to lead and backup counsel of record for Petitioner as follows:

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Dated: October 03, 2024

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IPR2023-00842
Joint Motion to Terminate

Shamrock Innovation, LLC.