

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC.,
Petitioner,

v.

SONRAI MEMORY LIMITED,
Patent Owner.

Case IPR2023-00904
Patent 6,920,527

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R §§ 42.72, 42.74**

LIST OF EXHIBITS

- MTI-1001 U.S. Patent No. 6,920,527 to Cloutier et al. (“the ’527 patent”)
- MTI-1002 Excerpts from the Prosecution History of the ’527 patent
- MTI-1003 Declaration of David Kuan-Yu Liu, Ph.D.
- MTI-1004 U.S. Patent Application Publication No. 2003/0028733 to Tsunoda et al. (“Tsunoda”)
- MTI-1005 U.S. Patent No. 7,069,370 to Sukegawa et al. (“Sukegawa”)
- MTI-1006 Certified translation and original document of Japanese Published Patent Application No. 2001-005723 to Tomio Suzuki (“Tomio”)
- MTI-1007 Certified translation and original document of Japanese Published Patent Application No. 2000-112836 to Shigeo Suzuki (“Shigeo”)
- MTI-1008 U.S. Patent No. 6,353,870 to Mills et al.
- MTI-1009 U.S. Patent No. 6,539,623 to Chen
- MTI-1010 U.S. Patent No. 6,376,283 to Chen
- MTI-1011 Acrylonitrile Butadiene Styrene (ABS), Dynalabcorp.com, https://web.archive.org/web/20031118100126/http://dynalabcorp.com/technical_info_abs.asp
- MTI-1012 U.S. Patent Publication No. 2002/0010827 to Cheng
- MTI-1013 U.S. Patent Publication No. 2002/0147882 to Pua et al.
- MTI-1014 Plastic Products for UL-94 Flame Class, Polymershapes.com, <https://www.polymershapes.com/regulatory/ul-94-flame-class/>
- MTI-1015 UL 94 Classification and Flame-Retardant Thermoplastics, Protolabs.com, <https://www.protolabs.com/resources/blog/flame-retardant-thermoplastics-and-ul-classifications/>

- MTI-1016 Common DIMM Memory Form Factors, Simmtester.com,
<https://www.simmtester.com/News/PublicationArticle/168>
- MTI-1017 U.S. Patent No. 6,567,273 to Liu et al.
- MTI-1018 U.S. Patent Application Publication No. 2004/0017634 to Chin-Lung et al.
- MTI-1019 U.S. Patent No. 6,490,163 to Pua et al.
- MTI-1020 U.S. Patent Application Publication No. 2004/0017637 to Chang et al.
- MTI-1021 Complaint For Patent Infringement Against Micron Technology, Inc. in *Sonrai Memory Ltd. v. Micron Technology, Inc.*, Case No. 6:22-cv-00855 (W.D. Tex. Aug. 2022)
- MTI-1022 U.S. Patent No. 5,887,145 to Harari et al.
- MTI-1023 Excerpt of Callister, “Materials Science and Engineering, An Introduction,” Fifth Edition, John Wiley & Sons, Inc. (2000)
- MTI-1024 M.2 SSD, TechTarget.com,
<https://www.techtarget.com/searchstorage/definition/M2-SSD>
- MTI-1025 Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, Katherin K. Vidal (USPTO June 21, 2022)
- MTI-1026 Stipulation
- MTI-1027 Crucial: Computer Memory, Storage, and Tech Advice, *Part 3 of 4 – Installing a Crucial® 2.5” SSD: Install*, January 4, 2019, available at <https://www.youtube.com/watch?v=dy7An1DkieQ>
- MTI-1028 Advanced NAND, Impressive QoS, and High Capacities for Data Center Environments, A Micron® Whitepaper, 2022 Micron Technology, Inc.

- MTI-1029 Supplemental Declaration of David Kuan-Yu Liu, Ph.D.
- MTI-1030 Samsung MultiMedia Card Product Datasheet Version 3.0, Samsung Electronics (September 22, 2005)
- MTI-1031 MMC Card Specification Version 1.3, Kingmax Digital Inc. (July 8, 2004)
- MTI-1032 How do I safely remove a USB device from my computer?, Tech-Ease, Florida Center for Instructional Technology, College of Education, University of South Florida (2018), available at <https://etc.usf.edu/techease/win/hardware/how-do-i-safely-remove-a-usb-device-from-my-computer/>
- MTI-1033 Safely remove hardware in Windows, Microsoft (2024), available at <https://support.microsoft.com/en-us/windows/safely-remove-hardware-in-windows-1ee6677d-4e6c-4359-efca-fd44b9cec369>
- MTI-1034 Excerpts of New Technology Batteries Guide by William J. Ingram, National Institute of Justice (October 1998)
- MTI-1035 NAND Flash 101: An Introduction to NAND Flash and How to Design it in to Your Next Product, Micron Technology Inc. (2006)
- MTI-1036 32-Mbit 3.0 V Flash Memory S25FL032P Datasheet, Cypress Semiconductor Corporation (May 19, 2017)
- MTI-1037 64 Mb (8 MB) FL-L flash S25FL064L Datasheet, Infineon Technologies AG (April 17, 2023)
- MTI-1038 Excerpt of Infringement Expert Report of Dr. Michael C. Brogioli Exhibit D in *Sonrai Memory Ltd. v. Micron Technology, Inc.*, Case No. 1:23-cv-01407 (W.D. Tex. May 1, 2024)
- MTI-1039 Sonrai Memory Limited's Objections and Responses to Micron Technology, Inc.'s Second Set of Requests for Admission (Nos. 37-43) in *Sonrai Memory Ltd. v. Micron Technology, Inc.*, Case No. 1:23-cv-01407 (W.D. Tex. April 17, 2024)

- MTI-1040 U.S. Patent No. 6,438,638 to Jones et al.
- MTI-1041 Transcript of Deposition of Dr. Michael Brogioli
- MTI-1042 Why You Should Always Safely Remove Your USB Devices.
Especially USB Storage Devices., available at
[https://www.downloadsource.net/why-you-should-always-safely-
remove-your-usb-devices-especially-usb-storage-devices/n/9924/](https://www.downloadsource.net/why-you-should-always-safely-remove-your-usb-devices-especially-usb-storage-devices/n/9924/)
- MTI-1043 Confidential Settlement Agreement

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74 and the Board’s authorization (Paper No. 30), Micron Technology, Inc. (“Petitioner”) and Sonrai Memory Limited and Nera Innovations Limited (“Patent Owner”) jointly move to terminate the present *inter partes* review proceeding as a result of a settlement agreement between Petitioner and Patent Owner. The settlement agreement completely resolves all pending controversies between Petitioner and Patent Owner concerning U.S. Patent No. 6,920,527 (“the ’527 patent”).

The parties are concurrently filing a true copy of their settlement agreement (MICRON-1043) in connection with this matter as required by statute. The parties further jointly certify that there are no other agreements or understandings, oral or written, between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of this proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the settlement agreement be treated as business confidential information and kept separate from the file of the ’527 patent. A joint request for such treatment pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently herewith.

II. STATEMENT OF FACTS

Patent Owner asserted the '527 patent against Petitioner in the action entitled *Sonrai Memory Limited v. Micron Technology, Inc.*, Case No. 23-CV-01407-ADA (W.D. Tex.) (the "Litigation").

Petitioner filed a petition for *inter partes* review of claims 1-7, 9-18, and 20 of the '527 patent on May 8, 2023. The Board instituted *inter partes* review on November 28, 2023. Petitioner is the only named Petitioner in this Proceeding.

On August 21, 2024, Petitioner and Patent Owner entered into a settlement agreement pursuant to which they agreed, among other things, to mutually cooperate to request the termination of this IPR proceeding. On August 16, 2024, Petitioner and Patent Owner filed a Joint Motion to Stay All Deadlines and Notice of Settlement in the Litigation. The Court cancelled the jury trial and stayed all deadlines via an order dated August 19, 2024.

Petitioner filed the following petitions to institute *inter partes* proceedings concerning patents owned by Patent Owner:

IPR	Patent	Filed Date
IPR2023-00904	6,920,527	May 8, 2023
IPR2023-00909	6,724,241	May 8, 2023

The parties are filing motions to terminate each of the remaining proceedings in light of the settlement between the parties. Thus, once the Board

grants those motions, there will be no other proceedings before the Patent Office involving Petitioner and Patent Owner.

III. LEGAL STANDARD

35 U.S.C. § 317(a) provides that “[a]n *inter partes* review instituted under this chapter 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.” 37 C.F.R. § 42.72 similarly provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate . . . pursuant to a joint request under 35 U.S.C. 317(a).” The Trial Practice Guide also observes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding” and that the Board “expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

IV. GOOD CAUSE EXISTS TO TERMINATE THE ABOVE-CAPTIONED IPR

Termination of the instant IPR is appropriate because all parties have settled all pending disputes concerning the ’527 patent and the Board has not yet decided the merits of this proceeding. Thus, under 35 U.S.C. § 317(a), the Board should terminate this proceeding. “Generally, the Board expects that a proceeding will

terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (P.T.A.B. July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012)).

Further, termination of the proceeding is a just and fair resolution. The parties agree that neither Petitioner nor Patent Owner will be prejudiced by the termination. Finally, the parties will benefit from preserving resources that would otherwise be expended if this motion is denied.

V. CONCLUSION

For at least these reasons, Petitioner and Patent Owner respectfully request that the Board grant this Joint Motion to Terminate the above-captioned IPR proceeding.

Dated: August 22, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4) and 42.205(b), the undersigned certifies that on August 22, 2024, a complete and entire copy of this Joint Motion to Terminate Proceeding and Exhibit 1043 were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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