

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICRON TECHNOLOGY, INC.,
Petitioner,

v.

SONRAI MEMORY LIMITED,
Patent Owner.

Case IPR2023-00909
Patent 6,724,241

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

LIST OF EXHIBITS

- EX-1001 U.S. Patent No. 6,724,241 to Bedarida et al. (“’241 Patent”)
- EX-1002 Excerpts from the Prosecution History of the ’241 Patent
- EX-1003 Declaration of Dr. James Dickens
- EX-1004 Curriculum vitae of Dr. James Dickens
- EX-1005 U.S. Patent No. 5,872,733 to Buti et al. (“Buti”)
- EX-1006 U.S. Patent No. 4,769,784 to Doluca et al. (“Doluca”)
- EX-1007 U.S. Patent No. 6,404,274 to Hosono et al. (“Hosono”)
- EX-1008 U.S. Patent No. 6,424,570 to Le et al. (“Le”)
- EX-1009 Japanese Patent Application No. S61-024094 to Ujiie et al. (“Ujiie”)
- EX-1010 U.S. Patent No. 6,091,613 to Yang et al. (“Yang”)
- EX-1011 U.S. Patent No. 6,373,325 to Kuriyama et al. (“Kuriyama”)
- EX-1012 U.S. Patent No. 4,506,350 to Asano et al. (“Asano”)
- EX-1013 District Court’s Claim Construction Order in *Sonrai Memory Limited v. Kioxia et al.*, Dkt. 55, W.D. Tex. 6:21-cv-00400-ADA
- EX-1014 Webster’s Unabridged Dictionary, 2d ed. 2001 (excerpts)
- EX-1015 McGraw-Hill Electronics Dictionary, 6th ed. 1997 (excerpts)
- EX-1016 U.S. District Courts–Combined Civil and Criminal Federal Court Management Statistics (September 30, 2022), available at:
https://www.uscourts.gov/sites/default/files/data_tables/cms_na_distprofile0930.2022.pdf
- EX-1017 Geiger *et al.*, VLSI Design Techniques for Analog And Digital Circuits (1990), ISBN 0070232539 (excerpts)

- EX-1018 Plaintiff's Sur-Reply Claim Construction Brief in *Sonrai Memory Limited v. Micron Technology, Inc.*, Dkt. 48, W.D. Tex. 6:22-cv-00787-ADA
- EX-1019 Texas Instruments, *SNx4LS24x, SNx4S24x Octal Buffers and Line Drivers With 3-State Outputs* (Apr. 1985, rev. Oct. 2016)
- EX-1020 District Court's Claim Construction Order in *Sonrai Memory Limited v. Micron Technology, Inc.*, Dkt. 53, W.D. Tex. 6:22-cv-00787-ADA
- EX-1021 Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, Katherin K. Vidal (USPTO June 21, 2022) ("Interim Guidance")
- EX-1022 Stipulation
- EX-1023 Supplemental Declaration of Dr. James Dickens
- EX-1024 Deposition Transcript of Dr. Michael Brogioli
- EX-1025 Declaration of Daniel H. Wade in support of Motion for *Pro Hac Vice* Admission
- EX-1026 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. 6,724,241 ("the '241 patent").

The parties are concurrently filing a true copy of their settlement agreement (EX-1026) 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 '241 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 '241 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 1-25 of the '241 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 both 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 ’241 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 1026 were provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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