

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DISH NETWORK LLC and DISH TECHNOLOGIES LLC,
Petitioner,

v.

SAFECAST LIMITED LLC,
Patent Owner.

Case IPR2023-01116
Patent 9,392,302 B2

PETITIONER'S MOTION TO TERMINATE PROCEEDING

I. INTRODUCTION

DISH Network L.L.C. and DISH Technologies L.L.C., (“Petitioner”), hereby move to withdraw their petition for *inter partes* review and thereby terminate IPR2023-01116 directed to U.S. Patent No. 9,392,302 (“the ’302 Patent”) because all claims subject to the petition have now been cancelled in connection with another proceeding.

There is no written settlement agreement or any other collateral written agreement between the parties made in connection with, or in contemplation of, the withdrawal of the petition. To preserve the Board’s and parties’ resources and to achieve a just, speedy, and inexpensive resolution to this dispute, Petitioner requests that the Board withdraw the petition for *inter partes* review and thereby terminate IPR2023-01116.

II. ARGUMENT

The Board has already determined the Challenged Claims are unpatentable in a parallel proceeding involving the same patent and claims. *See Google LLC v. SafeCast Limited LLC*, IPR2023-00652, Paper 16 (Final Written Decision) at 50 (P.T.A.B. Oct. 3, 2024) (“ORDERED that Petitioner establishes by a preponderance of evidence that challenged claims 1–4, 6–9, and 12–15 are unpatentable”). Patent Owner did not file a notice of appeal in that proceeding and

all appeal rights are exhausted. The certificate of cancellation has already published. Petitioner will not petition for institution of another *inter partes* review for the same Challenged Claims for the subject patent. Thus, good cause exists to withdraw Petitioner's petition for *inter partes* review and thereby terminate IPR2023-01116 pursuant to 37 C.F.R. § 42.71(a) and § 42.72. Withdrawal at this time would preserve both the Board's and the parties' resources in accordance with the intent of 37 C.F.R. § 42.1(b) "to secure the just, speedy, and inexpensive resolution [of] every proceeding."

Withdrawal of the petition also promotes efficiency and minimizes unnecessary costs. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257, Paper 16 at 3 (PTAB Jan. 2, 2020). Patent Owner will not be prejudiced by such withdrawal and subsequent termination of IPR2023-01116 as evidenced by Patent Owner's agreement that it does not object to the filing of this motion to terminate.

III. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board grant its motion to withdraw the instant Petition for *inter partes* review and that the Board terminate IPR2023-01116.

Respectfully submitted,

Dated: March 6, 2025

/Adam R. Shartzter/
Adam R. Shartzter, Reg. No. 57,264
Ruffin B. Cordell, Reg. No. 33,487
Timothy Riffe, Reg. No. 43,881
Jack R. Wilson, Reg. No. 75,011
Daniel Y. Lee, Reg. No. 72,848
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
T: 202-783-5070
F: 877-769-7945

Attorneys for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that March 6, 2025, a complete and entire copy of this Petitioner's Motion to Terminate Proceeding were provided by email to the Patent Owner by serving the correspondence address of record as follows:

Allen J. Oh
Registration No. 42,047
ALLEN J. OH LAW OFFICE
23505 Birch Road
Rogers, Minnesota 55374
Telephone: (763) 242-4401
Email: allen.oh@icloud.com

/Crena Pacheco/
Crena Pacheco
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
pacheco@fr.com