

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.

IPR2023-01116
Patent 9,392,302 B2

Before THU A. DANG, KARL D. EASTHOM, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

JUDGMENT

Granting Petitioner's Motion to Dismiss the Petition and
Terminate the Proceeding
37 C.F.R. §§ 42.71(a), 42.72, 42.73(b)

I. INTRODUCTION

DISH Network LLC and DISH Technologies LLC, Petitioner, filed a Petition requesting an *inter partes* review of claims 1–4, 6–9, and 12–15 (the “challenged claims”) of U.S. Patent No. 9,392,302 B2 (Ex. 1001, the “’302 patent”). Paper 2. SafeCast Limited LLC, Patent Owner, filed a Preliminary Response. Paper 8.

After Institution (Paper 9), Patent Owner did not file a Patent Owner response, and Petitioner filed a Reply (Paper 11). Subsequently, Petitioner filed an unopposed Motion to Terminate Proceeding. Paper 12 (“Motion”). The Motion states that Patent Owner “does not object to the filing of this [M]otion to [T]erminate.” Motion 2.

II. DISCUSSION

The Board has broad discretion to dismiss a petition. 37 C.F.R. § 42.71(a) (“The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.”); *see also id.* § 42.5(a) (“The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part[.]”).

In its Motion, Petitioner asserts that “[t]he Board has already determined the [c]hallenged [c]laims are unpatentable in a parallel proceeding involving the same patent and claims.” Motion 1 (citing *Google LLC v. SafeCast Limited LLC*, IPR2023-00652, Paper 16 (Final Written Decision) at 50 (PTAB Oct. 3, 2024) (“ORDERED that Petitioner establishes by a preponderance of evidence that challenged claims 1–4, 6–9, and 12–15 are unpatentable”). Petitioner also asserts that “Patent Owner did not file a notice of appeal in that proceeding and all appeal rights are exhausted.”). *Id.* at 1–2. Petitioner also asserts that “[t]he certificate of

cancellation has already published.” *Id.* at 2. Accordingly, and for other reasons specified in the Motion, Petitioner submits that 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.” *Id.*

PTO records support the unopposed Motion by verifying that in IPR2023-00652, the Office cancelled claims 1–4, 6–9, and 12–15 of the ’302 patent, the challenged claims here, after the Board determined that the petitioner in that case, Google LLC, established the unpatentability of claims 1–4, 6–9, and 12–15 of the ’302 patent. IPR2023-00652, Paper 16 (Final Written Decision); Paper 17 (“Trial Certificate Checklist). Accordingly, “there are no remaining claim[s] in the [instant] trial.” *See* 37 C.F.R. § 42.73(b)(2).

Based on the foregoing and the record, Petitioner establishes good cause to dismiss the Petition and terminate the trial. *See* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate”); § 42.71(a) (“The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.”); § 42.73(b) (“A party may request judgment against itself at any time during a proceeding. Actions construed to be a request for adverse judgment include:
. . . (2) Cancellation or disclaimer of a claim such that the party has no remaining claim in the trial; (3) Concession of unpatentability or derivation of the contested subject matter; and (4) Abandonment of the contest.”).

III. ORDER

ORDERED Petitioner’s unopposed Motion to dismiss the Petition and terminate the proceeding in is *granted*; and

FURTHER ORDERED that the Petition is *dismissed* and the trial is *terminated*.

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