

Case IPR2024-00055
Patent No. 9,924,744
Joint Motion to Terminate Proceeding
Attorney Docket No. JTIPAT 7.1O-001

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOGIC TECHNOLOGY DEVELOPMENT LLC,
and
JAPAN TOBACCO INTERNATIONAL U.S.A., INC.,
Petitioners,

v.

SHENZHEN HAPPY VAPING TECHNOLOGY LIMITED,
Patent Owner.

U.S. Patent No. 9,924,744

Inter Partes Review No. IPR2024-00055

JOINT MOTION TO TERMINATE PROCEEDING

TABLE OF CONTENTS

	Page
EXHIBIT LIST	ii
I. REASONS WHY TERMINATION IS APPROPRIATE	1
II. GOOD CAUSE JUSTIFIES TERMINATION OF THE PRESENT PETITION	2
III. STATUS OF RELATED PROCEEDINGS	2
IV. CONCLUSION.....	2

EXHIBIT LIST

Exhibit #	Reference
1001	U.S. Patent No. 9,924,744 (“the ’744 Patent”)
1002	Declaration of Doug Dean in Support of Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,924,744
1003	Doug Dean — Curriculum Vitae
1004	Prosecution History of U.S. Patent No. 9,924,744
1005	U.S. Patent Publication No. 2015/0164141 (“Newton ’141”)
1006	U.S. Patent Publication No. 2013/0228191 (“Newton ’191”)
1007	U.S. Patent Publication No. 2013/0192617 (“Thompson”)
1008	U.S. Patent Publication No. 2014/0060527 (“Liu ’527”)
1009	U.S. Patent Publication No. 2014/0060556 (“Liu ’556”)
1010	U.S. Patent Publication No. 2010/0242974 (“Pan”)
1011	U.S. Patent Publication No. 2015/0189919 (“Liu ’919”)
1012	Defendants’ Motion to Stay Discovery and Other Deadlines, February 17, 2023 (DE30)
1013	Defendants’ Motion to Dismiss for Improper Venue or to Transfer Venue and Incorporated Memorandum of Law, December 15, 2022 (DE13)
1014	Plaintiff’s Response to Defendants’ Motion to Dismiss for Improper Venue or to Transfer Venue, December 29, 2022 (DE17)
1015	First Amended Complaint For Patent Infringement, January 5, 2023 (DE21)
1016	Defendants’ Notice to Reassert Motion to Dismiss for Improper Venue or to Transfer Venue, January 17, 2023 (DE24)
1017	Defendants’ Reply in Support of Motion to Dismiss for Improper Venue or to Transfer Venue, January 17, 2023 (DE25)
1018	Defendants’ Motion for Clarification or, in the Alternative, for Leave to Refile Motion to Dismiss and Incorporated Memorandum of Law, July 21, 2023 (DE53)
1019	Defendants’ Renewed Motion to Stay Discovery and Other Deadlines, June 30, 2023 (DE49)
1020	Plaintiff’s Response to Defendants’ Renewed Motion to Stay Discovery and Other Deadlines, July 14, 2023 (DE50)

Exhibit #	Reference
1021	Reply Memorandum in Support of Defendants' Renewed Motion to Stay Discovery and Other Deadlines, July 21, 2023 (DE52)
1022	Settlement Agreement
1023	Stipulated Notice of Voluntary Dismissal

Petitioners Logic Technology Development LLC and Japan Tobacco International U.S.A., Inc. and Patent Owner Shenzhen Happy Vaping Technology Limited (collectively “Parties”) hereby jointly move to terminate the petition for *inter partes* review filed October 19, 2023, directed to Patent No. 9,924,744 (“the ’744 Patent”) and assigned case number IPR2024-00055 (“the Proceeding”).

Patent Owner filed its mandatory notices on November 8, 2023, and filed its Preliminary Response on January 29, 2024.

Patent Owner filed a lawsuit against Petitioners in the United States District Court for the Southern District of Florida, Civil Action No. 22-cv-61407-Smith (“the Lawsuit”) alleging infringement of the ’744 Patent. The Parties entered a Settlement Agreement (Exhibit 1022) on February 18, 2024, and filed a Stipulated Notice of Voluntary Dismissal (Exhibit 1023) for the Lawsuit on February 19, 2024. On February 21, 2024, the Court entered an Order dismissing all claims in the Lawsuit with prejudice and closing the case. There are no other agreements, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the Proceeding.

I. REASONS WHY TERMINATION IS APPROPRIATE

Termination is proper because the Office has not issued an institution decision and thus has not yet decided the merits of the Proceeding. In addition, the Parties have jointly requested termination. As noted in the Patent Office Trial Practice

Guidelines, “[t]here are strong public policy reasons to favor settlement between the parties The Board expects that a proceeding will terminate . . . unless the Board has already decided the merits of the proceeding.” 77 Fed. Reg. 48768 (Aug. 14, 2012) (citing 35 U.S.C. §§ 317(a), 327). Accordingly, termination is appropriate.

II. GOOD CAUSE JUSTIFIES TERMINATION OF THE PRESENT PETITION

The Office has not yet issued an institution decision. Under 35 U.S.C. § 317(a), even after an IPR review had been instituted, a proceeding shall be terminated upon the joint request of the petitioner and the patent owner, unless the Office decided the merits of the proceeding before the request for termination is filed. The Parties have settled their dispute. As such, granting this motion to terminate the proceeding now, before entry of an institution decision would serve to preserve the Board’s and Parties’ resources and promote a just, speedy and inexpensive resolution. 37 C.F.R. § 42.1(b).

III. STATUS OF RELATED PROCEEDINGS

As summarized above, on February 21, 2024, an Order was entered in the Lawsuit dismissing all claims with prejudice. Thus, the Lawsuit is now closed.

IV. CONCLUSION

For the foregoing reasons, the Parties jointly request termination of the Proceeding. This motion is being filed by Petitioners, with Patent Owner’s consent.

Respectfully submitted,

Dated: February 23, 2024

Dated: February 23, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING**, which was signed by both Parties but *filed* by Counsel for Petitioners was served by filing this document through P-TACTS and by email at the following correspondence address of record for Patent Owner on February 23, 2024.

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Dated: February 23, 2024

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