

Dear Trials:

Petitioner TurnSignl (TurnSignl, Inc. and TurnSignl Foundation) submits this unopposed request to move to withdraw the petitions in IPR2024-00102 (11,443,395), IPR2024-00103 (11,494,861), and IPR2024-00104 (11,494,862) (the "IPR patents"). Each of the three IPR patents are part of the same patent family and share substantially the same specifications.

As described in Patent Owner's Mandatory Notices (Paper 6 at 1) and Petitions under "Related Matters," the parties have been involved in parallel district court litigation, *Redmon Jeang LLC v. TurnSignl, Inc. and TurnSignl Foundation*, Case No. 0:22-cv-02749-NEB-LIB (Oct. 31, 2022) (the "Litigation") in the United States District Court for the District of Minnesota. In the Litigation, Patent Owner asserted claim 1 of the '395 patent, claims 1, 6, 7, 10, 11, 15, 16, and 20 of the '861 patent, and claims 1, 6, 7, 10, 11, 15, and 20 of the '862 patent. Petitioner challenged each of the asserted claims in the IPR proceedings.

On March 11, 2024, the Court entered an Order granting Petitioner TurnSignl's Motion for Judgment on the Pleadings that all asserted/challenged claims for the three IPR patents were invalid under 35 U.S.C. § 101. Dkt. 81. On March 13, 2024, the Court entered judgment and closed the case. Dkt. 82. A copy of the Court's Order and Judgement are attached. On April 12, 2024 (the last date by which Patent Owner could file a Notice of Appeal to the Federal Circuit (*see* attached Civil Notice, Dkt. 82-1)), Patent Owner and TurnSignl agreed that Patent Owner would not appeal. There is, therefore, no remaining dispute between the parties, and all claims challenged in the IPR patents stand invalid under 35 U.S.C. § 101.

Petitioner now seeks to withdraw the petition in each proceeding. Patent Owner does not oppose. Petitioner requests the Board grant withdrawal because (1) this request is made well before the expected institution decision that is due by May 20, 2024, and thus this request differs from the request in, for example, *Ocado Group PLC v. Autostore Technology AS*, PGR2021-00038, Paper 10 (July 30, 2021) (request made two weeks before institution due date); (2) withdrawal will conserve the resources of the Board and avoid an unnecessary decision due to the finality of the lower court's judgment; and (3) withdrawal will also save time and expenses for all parties because there is no longer an active controversy.

Petitioner, therefore, respectfully requests that the Board grant Petitioner's unopposed request to file an unopposed motion to withdraw the IPR petitions and subsequently seek a refund of the post-institution fees.

Regards,

Juanita

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