

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

URNSIGNL, INC. andURNSIGNL FOUNDATION,
Petitioner,

v.

REDMON JEANG LLC,
Patent Owner.

IPR2024-00102 (Patent 11,443,395 B2)
IPR2024-00103 (Patent 11,494,861 B2)
IPR2024-00104 (Patent 11,494,862 B2)¹

Before JENNIFER S. BISK, MICHELLE N. WORMMEESTER, and
ANDREW L. NALVEN, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5(a)

¹ This Order addresses issues that are common to all three cases. The parties are not authorized to use this style heading for any subsequent papers.

IPR2024-00102 (Patent 11,443,395 B2)
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IPR2024-00104 (Patent 11,494,862 B2)

On April 16, 2024, in an email to the Board, TurnSignl, Inc. and TurnSignl Foundation (“Petitioner”) requested the Board withdraw the petitions in each of these cases. Ex. 3001. Petitioner represented that this request is unopposed and is based on a March 11, 2024, finding by the district court that all the challenged claims in the three patents at issue were invalid under 35 U.S.C. § 101. *Id.* Petitioner represented that “Patent Owner and TurnSignl agree that Patent Owner would not appeal” this decision. *Id.*

We sent the following email response on April 17, 2024:

Counsel,

The parties are authorized to file a Joint Motion to Terminate (as a Paper), and, if necessary, a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) (as a separate Paper).

The Joint Motion to Terminate should reference this authorization. The Joint Motion to Terminate also must update the Board concerning the status of any litigation or proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint Motion to Terminate must include a true copy of any agreement or understanding (as an Exhibit to the Motion) and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the inter partes review. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(b).

Any Joint Request to File Settlement Agreement as Business Confidential Information must be filed with the Joint Motion to Terminate. See 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c).

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Because the parties have not yet filed a joint motion to terminate and the institution decision deadline is May 20, 2024, we now amend this authorization and require that any such motion be filed by May 1, 2024. If no motion is filed by May 1, 2024, we will issue a decision on institution in each of these cases and proceed to trial should we decide to institute.

I. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties are authorized to file a Joint Motion to Terminate no later than May 1, 2024, in each of the proceedings; and

FUTHER ORDERED that the parties are authorized to file a Joint Request to File Settlement Agreement as Business Confidential Information no later than May 1, 2024, in each of the proceedings.

FOR PETITIONER:

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