UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TURNSIGNL, INC. AND TURNSIGNL FOUNDATION,
Petitioner,

v.

REDMON JEANG LLC,
Patent Owner.

CASE No. IPR2024-00104
U.S. Patent No. 11,494,862

JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72 & 42.74

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74, Petitioner TurnSignl, Inc. and TurnSignl Foundation ("TurnSignl") and Patent Owner Redmon Jeang LLC ("Redmon") jointly move to terminate this *inter partes* review proceeding given the Court's Order granting Petitioner TurnSignl's Motion for Judgment on the Pleadings that all asserted/challenged claims were invalid under 35 U.S.C. § 101 and the subsequent agreement of the parties to settle their dispute related to the subject patent, U.S. Pat. No. 11,494,862 (the "'862 patent").

The filing of this Joint Motion was authorized by the Board in its email of April 17, 2024. The parties are submitting this joint motion to terminate this proceeding, along with a true copy of the related Settlement Agreement (Ex. 1047). As TurnSignl is the only Petitioner in this *inter partes* review proceeding, the Settlement Agreement effectively resolves all disputes related to the '862 patent, and this proceeding should be terminated as to both Petitioner and Patent Owner.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

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 claims 1, 6, 7, 10, 11, 15, and 20 of the '862 patent. Petitioner challenged each of the asserted claims in the IPR proceeding.

On March 11, 2024, the Court entered an Order granting Petitioner TurnSignl's Motion for Judgment on the Pleadings, concluding that all asserted/challenged claims for the '862 patent are invalid under 35 U.S.C. § 101. Ex. 1048. On March 13, 2024, the Court entered judgment and closed the case. Ex. 1049. 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, Ex. 1050)), Patent Owner and TurnSignl agreed that Patent Owner would not appeal. There is, therefore, no remaining dispute between the parties in the Litigation, and all claims challenged in the '862 patent stand invalid under 35 U.S.C. § 101.

On April 12, 2024, Petitioner and Patent Owner effectively agreed to resolve the underlying dispute in the above-captioned *inter partes* review and executed the Settlement Agreement on April 26, 2024. Accordingly, termination of this IPR proceeding is appropriate because all disputes between the parties regarding the '862 patent have been resolved. Motions to terminate based on a joint request are routinely granted, even post-institution.[1] Here, the parties are early in the proceeding

[1] *See, e.g.*, *Mylan Pharms. Inc. v. Qualicaps Co., Ltd.*, IPR2017-00203 (P.T.A.B. Dec. 19, 2017) (Paper 60 at 2); *Nike, Inc. v. Point 3 Basketball, LLC*, IPR2016-00396 (P.T.A.B. Feb. 22, 2017) (Paper 20 at 3); *Am. Megatrends, Inc. v. Kinglite Holdings Inc.*, IPR2016-00114 (P.T.A.B. Dec. 13, 2016) (Paper 22 at 2).

stages, limited papers have been filed (only the petition) and no decision on institution has issued. Termination is appropriate because an institution decision has not yet issued. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Settlement Agreement resolving the dispute in the above-captioned *inter partes* review is being submitted as Ex. 1047 by the parties, along with a request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding under 37 C.F.R. § 42.74(c). The parties certify there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

For at least these reasons, Patent Owner and Petitioner submit that termination of this *inter partes* review is appropriate. Pursuant to 35 U.S.C. § 317(a), because the *inter partes* review is being terminated regarding the Petitioner, no estoppel pursuant to 35 U.S.C. § 315(e) shall attach to Petitioner TurnSignl.

Dated: April 29, 2024

By: /Wei Wei Jeang/ Wei Wei Jeang, Reg. No. 33,305 wjeang@fultonjeang.com Jane Du, Reg. No. 65,844 jdu@fultonjeang.com Brian Farlow bfarlow@fultonjeang.com FULTON JEANG PLLC 6911 Truxton Drive Dallas, TX 75231 Telephone: (512) 766-8166 *Counsel for Redmon Jeang LLC*	By: /Mark C. Nelson/ Mark C. Nelson, Reg. No. 43,830 (*Lead Counsel*) mnelson@btlaw.com Daniel A. Valenzuela, Reg. No. 69,027 (*Backup Counsel*) daniel.valenzuela@btlaw.com Juanita DeLoach *(Admitted Pro Hac Vice)* juanita.deloach@btlaw.com BARNES & THORNBURG LLP 2121 N. Pearl St., Suite 700 Dallas, TX 75201 Telephone: (214) 258-4200 Fax: (214) 258-4199 *Counsel for TurnSignl, Inc. and TurnSignl Foundation*

CERTIFICATE OF SERVICE

I certify that a true and correct copy of JOINT MOTION TO TERMINATE PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R §§ 42.72 & 42.74 and all supporting exhibits were served on April 29, 2024, electronically via e-mail to:

Wei Wei Jeang
wjeang@fultonjeang.com

Jane Du
jdu@fultonjeang.com

Brian Farlow
bfarlow@fultonjeang.com

wwu@fultonjeang.com
docketing@fultonjeang.com

Dated: April 29, 2024

By: /Mark C. Nelson/
Mark C. Nelson, Reg. No. 43,830
BARNES & THORNBURG LLP
2121 N. Pearl St., Suite 700
Dallas, TX 75201
Telephone: (214) 258-4200
Fax: (214) 258-4199

Lead Counsel for TurnSignl, Inc. and TurnSignl Foundation