

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,
Petitioner

v.

APPLE INC.,
Patent Owner

Case No. IPR2024-00169

U.S. Patent No. 10,076,257 B2

MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW

I. INTRODUCTION

On January 24, 2024, the Board authorized AliveCor, Inc. (“Petitioner” or “AliveCor”) to file a motion to dismiss the pending petition for *inter partes* review of U.S. Patent No. 10,076,257 (the “’257 patent”) and thereby terminate IPR2024-00169.

In view of the institution of IPR2023-00950, AliveCor hereby requests that the Board dismiss the instant petition and terminate IPR2024-00169 to preserve the Board’s and the parties’ resources and promote a speedy and inexpensive resolution to this dispute. IPR2024-00169 is in its preliminary phase, and the Board has not yet reached the merits by issuing a decision on institution. Petitioner and Patent Owner have met and conferred, and Patent Owner does not oppose the relief requested in this motion.

II. BACKGROUND

The instant petition is one of two petitions challenging the ’257 patent filed by AliveCor. The first was filed on June 7, 2023, as IPR2023-00950. AliveCor requested that the Board institute review in the present proceeding and grant its motion for joinder if, and only if, the Board previously denied institution of the earlier AliveCor petition in the IPR2023-00950 proceeding.

On January 9, 2024, the Board granted institution in the IPR2023-00950 proceeding, finding that “Petitioner has a reasonable likelihood of success in proving

that at least one claim of the '257 patent is unpatentable.” *AliveCor, Inc. v. Apple Inc.*, IPR2023-00950, Paper 12 at 2 (PTAB Jan. 9, 2024).

III. ARGUMENT

Consistent with 37 C.F.R. § 42.71(a) and the Board’s precedent allowing petitioners to withdraw petitions pre-institution, good cause exists to dismiss the instant petition and terminate IPR2024-00169. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257, Paper 16 at 3 (PTAB Jan. 2, 2020) (granting petitioner’s unopposed motion to dismiss “to promote efficiency and minimize unnecessary costs”); *Samsung Elecs. Co. v. Nvidia Corp.*, IPR20150-1270, Paper 11 at 3–4 (PTAB Dec. 9, 2015) (granting petitioner’s opposed motion to dismiss “to promote efficiency and minimize unnecessary costs”).

The instant proceeding is in its preliminary stage. The deadline for Patent Owner to file a preliminary response is February 26, 2024. Because Patent Owner has not filed a preliminary response, a decision on institution is still months away. Moreover, in this proceeding, AliveCor indicated that its intent was to “participate in a single *inter partes* review” (IPR2024-00169, Paper 1 at 1) and AliveCor requested that the Board institute review and grant its joinder motion if, and only if, the Board has previously denied institution of the earlier AliveCor Petition in the -00950 proceeding. *See* IPR2024-00169, Paper 1 at 89. Institution was granted in the -00950 proceeding. As such, it would be appropriate to grant Petitioner’s

unopposed motion to dismiss the instant petition and terminate IPR2024-00169 to preserve the Board's and parties' resources and promote a speedy and inexpensive resolution to this dispute. *See Samsung*, IPR20215-01270, Paper 11 at 3.

Moreover, Patent Owner served its district court complaint alleging infringement of the '257 patent more than one year ago, and Petitioner is therefore barred from filing another petition for *inter partes* review with respect to the '257 patent. Thus, the withdrawal of the instant petition does not prejudice Patent Owner. Patent Owner does not oppose this motion, and Patent Owner does not intend to file any response.

IV. CONCLUSION

Petitioner respectfully requests that the Board dismiss the present petition and terminate IPR2024-00169.

Date: January 26, 2024

By: /Christopher TL Douglas /
Christopher TL Douglas

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), the undersigned hereby certifies that true and correct copies of the above-captioned **MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW**, was served via electronic mail to the following attorneys of record for Patent Owner:

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Date: January 26, 2024

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