

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SILICON MOTION, INC.,

Petitioner,

v.

UNIFICATION TECHNOLOGIES LLC,
Patent Owner.

Inter Partes Review No. IPR2024-00199
U.S. Patent No. 11,640,359

**JOINT MOTION TO DISMISS
PETITION FOR INTER PARTES REVIEW**

PETITIONER’S EXHIBIT LIST

Ex. No.	Brief Description
1001	U.S. Pat. No. 11,640,359 B2, titled “SYSTEMS AND METHODS FOR IDENTIFYING STORAGE RESOURCES THAT ARE NOT IN USE” to Flynn et al.
1002	U.S. Pat. No. 7,624,239 B2, titled “METHODS FOR THE MANAGEMENT OF ERASE OPERATIONS IN NON-VOLATILE MEMORIES” to Bennett et al.
1003	U.S. Pat. No. 7,057,942 B2, titled “MEMORY MANAGEMENT DEVICE AND MEMORY DEVICE” to Suda et al.
1004	Declaration of R. Jacob Baker, Ph.D., P.E., Regarding U.S. Patent No. 11,640,359.
1005	American National Standard for Information Technology—AT Attachment with Packet Interface – 6 (ATA/ATAPI-6), ANSI INCITS 361-2002 (Sept. 2002) (excerpts filed with permission)
1006	U.S. Pat. Pub. 2003/0079078, titled “CONFIRMATION OF SECURE DATA FILE ERASURE” to Zipprich et al.
1007	Eran Gal et al., <i>Mapping Structures for Flash Memories: Techniques and Open Problems</i> , PROCEEDINGS OF THE IEEE INTERNATIONAL CONFERENCE ON SOFTWARE—SCIENCE, TECHNOLOGY & ENGINEERING (“SwSTE’05”) (digital version), Herzlia, Israel, 2005, pp. 83-92, doi: 10.1109/SWSTE.2005.14.
1008	Original Complaint for Patent Infringement, <i>Unification Techs. LLC v. Silicon Motion Inc.</i> , No. 2:23-cv-266 (E.D. Tex. 2023).
1009	U.S. Provisional Pat. No. 60/873,111 titled “Elemental Blade System,” to Flynn et al.
1010	Docket Report for <i>Unification Techs. LLC v. Silicon Motion Inc.</i> , No. 2:23-cv-266 (E.D. Tex. 2023).
1011	Frank Shu, <i>Notification of Deleted Data Proposal for ATA8-ACS2</i> , T13 (rev. 0 Apr. 21, 2007).

Ex. No.	Brief Description
1012	Frank Shu & Nathan Obr, <i>Notification of Deleted Data Proposal for ATA8-ACS2 Revision 1</i> , T13 (July 26, 2007).
1013	Frank Shu & Nathan Obr, <i>Notification of Deleted Data Proposal for ATA8-ACS2 Revision 2</i> , T13 (September 5, 2007).
1014	Public file history of U.S. Pat. No. 11,640,359 B2, titled “SYSTEMS AND METHODS FOR IDENTIFYING STORAGE RESOURCES THAT ARE NOT IN USE” to Flynn et al.
1015	Curriculum vitae of Jacob Baker, Ph.D., P.E.
1016	U.S. Pat. No. 5,404,485A, titled “FLASH FILE SYSTEM” to Ban.
1017	Expert Report of Sylvia Hall-Ellis, Ph.D. in Support of Public Availability of the Gal Publication.
1018	Docket Control Order, <i>Unification Techs. LLC v. Silicon Motion Inc.</i> , No. 2:23-cv-266 (E.D. Tex. 2023), ECF No. 47
1019	American National Standard for Information Technology—AT Attachment with Packet Interface – 7 Volume 1 – Register Delivered Command Set, Logical Register Set (ATA/ATAPI-7 V1), ANSI INCITS 397-2005 (Feb. 7, 2005) (excerpts filed with permission).
1020	Serial ATA (SATA) Revision 2.5, Serial ATA International Organization (Oct. 27, 2005).
1021	WILLIAM D. BROWN & JOE E. BREWER, NONVOLATILE SEMICONDUCTOR MEMORY TECHNOLOGY (IEEE 1998).
1022	BRIAN DIPERT & MARKUS LEVY, DESIGNING WITH FLASH MEMORY (Annabooks 1994).
1023	H. Nijjima, <i>Design of a Solid-State File Using Flash EEPROM</i> , IBM JOURNAL OF RESEARCH AND DEVELOPMENT, vol. 39, no. 5, pp. 531-545, Sep. 1995.

Ex. No.	Brief Description
1024	U.S. Pat. No. 6,766,432 B2, titled “MEMORY MANAGEMENT SYSTEM SUPPORTING OBJECT DELETION IN NON-VOLATILE MEMORY” to Saltz et al.
1025	<i>Proceedings. IEEE International Conference on Software – Science, Technology and Engineering</i> , IEEE COMPUTER SOCIETY, www.computer.org/csdl/proceedings/swste/2005/12OmNC17hWm (last visited Oct. 30, 2020).
1026	<i>Mapping Structures for Flash Memories: Techniques and Open Problems</i> , IEEE XPLORE, https://ieeexplore.ieee.org/document/1421068 (last visited Dec. 18, 2020).
1027	Confidential Settlement Agreement

I. INTRODUCTION

The Board authorized the parties to file a motion to dismiss the present petition for *inter partes* review and thereby terminate IPR2024-00199 directed to U.S. Patent No. 11,640,359 (“the ’359 Patent”). (Board email dated March 19, 2024). Petitioner Silicon Motion, Inc. and Patent Owner Unification Technologies LLC (“Unification”) have conferred via email, and Unification does not oppose the relief requested in this motion. Petitioner now so moves and respectfully requests that the Board dismiss the present petition and terminate IPR2024-00199. This proceeding is in an early phase, Unification has not yet filed a Patent Owner Response.

I. BACKGROUND AND RELATED IPR PROCEEDINGS

The present petition was filed on December 18, 2023. The parties in this proceeding and the related district court litigation in which the ’359 Patent was asserted,¹ have entered into a confidential settlement agreement (“Settlement Agreement”) that will resolve the parties’ dispute regarding the challenged patents.

¹ The settling parties are 1) Petitioner Silicon Motion, Inc.; and Patent Owner Unification Technologies LLC in this proceeding; and 2) Plaintiff Unification Technologies LLC and Defendant Silicon Motion, Inc. in case 2:23-cv-00266-JRG-RSP (Lead Case), 2:23-cv-00267-JRG-RSP (Member Case).

This Settlement Agreement has been made in writing, and a true and correct copy shall be filed as Exhibit 1027 with this Office as business confidential pursuant to 35 U.S.C. § 317(b). There are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding. Pursuant to the terms of the Settlement Agreement, the parties filed Stipulations of Dismissal in the aforementioned case, and the parties' disputes have been dismissed by the court.

II. ARGUMENT

Good cause exists to dismiss the present petition and terminate IPR2024-00199. The proceeding is in an early stage and Patent Owner Unification has not yet filed a Patent Owner Response. "The Board may . . . dismiss any petition." 37 C.F.R. 42.71(a); *see also* 37 C.F.R. § 42.72 (The Board "may terminate a trial without rendering a final written decision, where appropriate."). Further, the rules governing IPR proceedings "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding." *Id.* § 42.1(b). In determining whether a termination request is "appropriate," the Board primarily examines the stage and nature of the proceedings. *See, e.g., Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 12 at 3 (Dec. 9, 2015). Here, dismissal will preserve both Board and party resources, particularly in view of the early stage of the

proceeding. Moreover, withdrawal of the present petition does not prejudice the Patent Owner, who do not oppose the filing of this motion.

III. CONCLUSION

For the reasons set forth herein, Petitioner respectfully requests that the Board grant the Unopposed Motion to Dismiss Petition for *Inter Partes* Review in Case Number IPR2024-00199 and terminate the proceeding in its entirety.

Dated: March 19, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on March 19, 2024, I caused a copy of the foregoing document to be served via electronic mail, as previously consented to by Patent Owner Unification Technologies LLC, upon the following:

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