

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN PINCAN TECHNOLOGY CO., LTD,
Petitioner

v.

THE RIDGE WALLET LLC
Patent Owner

Case IPR2024-00340
Patent 10,791,808

**JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S.
PATENT 10,791,808 UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.71(a)**

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Declaration of Gina A. Johnson
Ex. 2002	Deposition Transcript from Deposition of Chunmei Peng
Ex. 2003	Deposition Transcript from Deposition of Dr. Kimberly Cameron
Ex. 2004	Transcript from June 21, 2023 <i>Markman</i> hearing in USITC Case No. 337-TA-1355
Ex. 2005	Ridge's Answer and Affirmative Defenses to Mosaic's Second Amended Complaint and Counterclaim for Patent Infringement in Case No. 2:20-cv-04556-AB-JC in the Central District of California, dated November 12, 2020
Ex. 2006	Declaration of Dr. Kimberly K. Cameron Regarding Claim Construction of the '808 Patent in USITC Case No. 337-TA-1355
Ex. 2007	Patent Owner's Additional Discovery Requests
Ex. 2008	Expert Report of Kimberly K. Cameron, Ph. D. regarding Invalidity of U.S. Patent No. 10,791,808 in USITC Case No. 337-TA-1355
Ex. 2009	Joint Stipulations for Dismissal in Case No. 2:20-cv-04556-AB-JC in the Central District of California.
Ex. 2010	Order on Claim Construction in Case No. 23-cv-00407-CNS-SBP in the District of Colorado.
Ex. 2011	Final Initial Determination in USITC Case No. 337-TA-1355.
Ex. 2012	Declaration of Inventor Daniel Kane in USITC Case No. 337-TA-1355 (REDACTED).
Ex. 2013	U.S. Patent No. 5,038,985 to Chapin.
Ex. 2014	Rebuttal Expert Report of Thomas Kurfess in USITC Case No. 337-TA-1355.
Ex. 2015	CONFIDENTIAL Settlement Agreement (Restricted Access)

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a), Petitioner Shenzhen Pincan Technology Co., Ltd. (“Petitioner”) and Patent Owner The Ridge Wallet LLC (“Patent Owner”) hereby jointly request termination of the *Inter Partes* Review of U.S. Patent 10,791,808 in IPR2024-00340.

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The parties are concurrently filing a copy of the settlement agreement as Exhibit 2015 along with a request to treat it as confidential business information pursuant to 35 U.S.C. § 317(b) and 35 C.F.R. § 42.74(c).

The undersigned represents that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding, and that Exhibit 2015 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

On December 5, 2024, the Parties informed the Board of their confidential agreement via e-mail and requested authorization to file a joint motion to terminate the *inter partes* review with respect to both parties. As set forth in an e-mail dated December 5, 2024, the Board authorized the filing of the requested joint motion to terminate this proceeding as to both parties.

Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

Public policy favors terminating the present inter partes review proceeding. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986).

The Federal Circuit places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). And, the Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 84 FR 64280, p. 86 (November, 2019).

Terminating this *inter partes* review promotes the congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents*, 77 Fed. Reg. 48,680 (Aug. 14, 2012).

Permitting termination as to all parties provides certainty and fosters an environment that promotes settlements, creating a timely, cost-effective alternative to litigation.

Additionally, termination of this IPR is appropriate as the Board has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 84 FR 64280, p. 86 (November, 2019). Petitioner filed its Petition on January 2, 2024 (Paper 1) and the Board accepted a Corrected Petition on February 8, 2024 (Paper 5). The Board instituted review on July 12, 2024 (Paper 18). Based on discussions regarding a Motion to Strike the expert declaration of Dr. Kimberly Cameron, the Board set Due Date 1 to be December 3, 2024 in an Order dated October 18, 2024. (Paper 23). The Board then struck the expert report of Dr. Kimberly Cameron in support of the Petition on November 20, 2024 (Paper 25). The parties have stipulated to further extend Due Date 1 to permit resolution of this Joint Motion without the need to burden the parties and the Board with the Due Date 1 filings. (Paper 26).

Since institution, the parties have not submitted any further briefs in response to reasoning in the institution decision. The parties have now settled their dispute, and have reached agreement to terminate this proceeding. The USPTO can conserve its resources through terminating the proceeding now, removing the need

for the Board to further consider the arguments or to render a Final Decision.

Furthermore, no other party's rights will be prejudiced by the termination of this proceeding, including, but not limited to, proceedings in the U.S. Patent and Trademark Office involving U.S. Patent No. 10,791,808. While there is a pending Motion to Join the instant proceeding in IPR2024-01264 (IPR2024-01264, Paper 2), the Petition in that case was based on the now-struck declaration of Dr. Cameron (*see* IPR2024-01264, Paper 1, Exhibit 1003). Since IPR2024-01264 was filed after the one-year statutory date for the IPR2024-01264 Petition's petitioner to file an IPR (IPR2024-01264, Paper 13), that is now time-barred and cannot properly be instituted.

In addition, that same petitioner is the petitioner in instituted IPR2024-00692 regarding U.S. Patent No. 10,791,808. The Petitioner in IPR2024-01264 filed an explicit Notice of Ranking Petitions in which it ranked IPR2024-00692 over IPR2024-01264. (IPR2024-01264, Paper 10 at 2). Accordingly, there is no prejudice in granting the instant Joint Motion to Terminate given the already-instituted IPR2024-00692.

For the above reasons, Patent Owner and Petitioner respectfully request termination of this Inter Partes Review of U.S. Patent 10,791,808 (IPR2020-00340).

Date: December 5, 2024

Respectfully Submitted,

/s/ Benjamin E. Weed

Benjamin E. Weed

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e), the undersigned certifies that on December 3, 2024, a complete and entire copy of this JOINT MOTION TO TERMINATE was provided, via email, to the Petitioner by serving the correspondence address of record as follows:

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