

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN ROOT TECHNOLOGY CO., LTD.
Petitioner,

v.

CHIARO TECHNOLOGY LTD.,
Patent Owner.

IPR2024-00953
Patent 11,413,380 B2

Before MEREDITH C. PETRAVICK, GRACE KARAFFA OBERMANN,
and AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Opposed Request for
Administrative Dismissal of the Petition
35 U.S.C. § 314/316(b), 37 C.F.R. § 42.71(a)

I. BACKGROUND

On May 31, 2024, Shenzhen Root Technology Co., Ltd. (“Petitioner”) filed a Petition (Paper 2), which was accorded a filing date of June 20, 2024 (Paper 4), requesting *inter partes* review of claims 1–46 of U.S. Patent No. 11,413,380 B2. Pet. 1–2. Chiaro Technology Ltd., (“Patent Owner”) has not yet filed its preliminary response, which is due on September 20, 2024.

On July 22, 2024, Petitioner sent an email to the Board requesting “administrative dismissal (prior to institution) of the Petition” in this *inter partes* review. Ex. 3001. (“Request for Administrative Dismissal”). Later that same day, Patent Owner sent an email to the Board opposing the Request for Administrative Dismissal. *Id.* On August 6, 2024, the Board held a telephonic conference with counsel to discuss the issues. Ex. 1017 (“Transcript” or “Tr.”). For the reasons discussed below, we deny Petitioner’s Request for Administrative Dismissal.

II. DISCUSSION

Under 37 C.F.R. § 42.71(a), the Board “may grant, deny, or dismiss any petition,” as appropriate under the circumstances. *Facebook, Inc. v. EveryMD.com LLC*, IPR2018-00050, Paper 19, 4–5 (PTAB Oct. 9, 2018) (explaining that the Board has “broad” authority to dismiss a petition under the applicable statutory and regulatory framework, even after institution). The Board, in deciding whether to grant a petitioner’s request to dismiss a petition, has considered factors such as the petitioner’s reasons for seeking dismissal and whether granting the relief will promote efficiencies.

For example, the Board has granted similar requests and motions to dismiss when: (1) the motion was filed approximately a month after filing,

may eliminate a potential dispute about the timing of the petition's filing under 35 U.S.C. § 311(c), and no response by patent owner had been filed (*Neurent Medical Inc. & Neurent Medical Ltd. v. The Foundry, Inc.*, IPR2024-00281, Paper 10, 2–3 (PTAB Apr. 24, 2024)), (2) the challenged claims were not yet eligible for *inter partes* review under 35 U.S.C. § 311(c), and petitioner planned to refile the petition once the claims became eligible for *inter partes* review (*SharkNinja, Inc. v. Dyson Tech. Ltd.*, IPR2023-01323, Paper 7, 2–3 (PTAB Nov. 28, 2023)); (3) the request was received 13 days after the filing of the petition, the correction regarded only an incorrect reference publication number, and there was no substantive change of any patentability argument (*Hesai Technology Co. Ltd. v. Ouster Inc.*, IPR2023-01375, Paper 5, 2 (September 20, 2023)); (4) petitioner would not re-file another petition on the same patent (*General Elec. v. Siemens*, IPR2021-00722, Paper 11, 2 (PTAB Oct. 7, 2021); *Unified Patents, LLC v. Motion Offense, LLC*, IPR2020-00705, Paper 14, 7 (PTAB. 2020)); and (5) petitioner was time barred from filing another petition for review (*Apple Inc. v. Pinn, Inc.*, IPR2021-00220, Paper 10 (PTAB Mar. 19, 2021); *Samsung Electronics Co. v. Nvidia Corp.*, IPR2015-01270, Paper 12, 3 (PTAB. 2015)).

None of these circumstances is present here, and Petitioner does not provide a similarly persuasive justification for the relief requested. To the contrary, Petitioner has stated that it intends to file a new follow-on petition that would not implicate a time bar under 35 U.S.C. § 315(b). In practical effect, Petitioner seeks a do-over without articulating an adequate reason why one is appropriate or fair to Patent Owner. Ex. 3001; Tr. 5–7.

In its email, Petitioner alleged that a new Petition is necessary to discuss an order in the related district court proceeding, filed June 28, 2024, striking the trial date and pretrial schedule. Ex. 3001. During the call, the Petitioner indicated that it additionally intends to modify its patentability arguments in response to patent owner's June, 2024 district court infringement contentions. Tr. 5. Petitioner stated that due to "word count reasons," decisions were made regarding what claims or grounds would be included in the original Petition. *Id.* at 6, 13. But, Petitioner found "interesting . . . the way the Patent Owner was viewing the patent scope" in the infringement contentions. *Id.* at 10. Petitioner acknowledged that the Board has an existing procedure whereby a second petition can be filed, a ranking provided, and then the first petition can be dismissed, but asserted that an administrative dismissal prior to filing the new petition is "a more efficient solution for everybody." *Id.* at 10–12.

Patent Owner opposed Petitioner's request, arguing that authorizing a motion to withdraw the Petition would unfairly prejudice Patent Owner and would not be more efficient. Ex. 3001; Tr. 23–25. Patent Owner stated that Petitioner was aware of the upcoming complaint for infringement prior to filing the Petition. Tr. 23. Patent Owner indicated a firm desire to proceed without dismissal and pointed out it already has invested time and money to draft a patent owner's preliminary response, which is due September 20, 2024, but which they expect to be finalized by the end of August. *Id.* at 24–25. Thus, Patent Owner argued that there is no sparing of the Patent Owner from incurring further burden or expense. In Patent Owner's view, Patent Owner would be prejudiced by the withdrawal of the Petition as an alternative to the Board ruling on the merits. *Id.* at 23–25.

The circumstances here are more similar to *Fresenius-Kabi USA LLC, Petitioner, v. Astrazeneca AB*, IPR2017-01910, Paper 7, 3–5 (PTAB Nov. 2, 2017), in which the Board denied a similar request and motion when the patent owner opposed, raised no concerns over increased burden to them, and indicated the desire to proceed by filing a preliminary response.

Given that Patent Owner has not yet filed a preliminary response, it is not yet clear that the district court’s schedule change has any bearing on this proceeding. Furthermore, should Patent Owner request denial under 35 U.S.C. § 314(a) in light of the related district court proceeding, Patent Owner has stated it “would not object to a very brief targeted reply to our preliminary response, so long as the Patent Owner gives a sur-reply.” Tr. 25–26.

Under the circumstances here, we see no interest of economy or efficiency by a dismissal of the Petition at this point. Petitioner indicated that they would file a new petition, but one has not yet been filed. The Board has an existing process in place should Petitioner file another petition that would decrease the burden on the Board and Patent Owner, as Petitioner acknowledged. *See* Tr. 10–12; 37 C.F.R. § 42.122(a); “Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019” at 59–61. Petitioner provided no persuasive reason why the Board should dismiss the Petition at this juncture rather than take account of any second-filed petition under that existing process.

Petitioner will incur no further burden or expense during the pre-institution stage. Petitioner will face additional burden or expense only if review is granted based on the instant Petition or on a follow-on petition. Should that occur, as we advised during the teleconference, Petitioner may

seek authorization to file a motion for termination of trial as provided by our rules. 37 C.F.R. § 42.72.

Further, given that Petitioner's counsel indicated during the teleconference that Petitioner will file a follow-on petition challenging the patent at issue in this proceeding, we find that a grant of Petitioner's request, over Patent Owner's objections, would prejudice Patent Owner by undercutting its ability to defend against such a petition. Accordingly, we *deny* Petitioner's request for administrative dismissal of its Petition.

It is

ORDERED that Petitioner's request for administrative dismissal prior to institution is *denied*.

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