

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Sandisk Technologies, Inc.,
Petitioner,

v.

Longitude Flash Memory Solutions Ltd.,
Patent Owner.

Case No. IPR2025-01281

U.S. Patent No. 11,456,365

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

TABLE OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 11,456,365 to Polishchuk et al. (“the ’365 patent”)
1002	Certified Prosecution file history for the ’365 patent (“Prosecution History”)
1003	Declaration of Jack C. Lee
1004	U.S. Patent Application Publication No. 2012/0068255 to Changhyun Lee, et al. (“Lee ’255”)
1005	Korean Patent Publication No. 2011-0118961 to Gi Hong Lee et al. and Certified English Translation of Korean Patent Publication No. 2011-0118961 to Gi Hong Lee et al. (“Lee ’961”)
1006	U.S. Patent Application Publication No. 2006/0065919A1 to Ichiro Fujiwara (“Fujiwara”)
1007	L. Lukasiak and A. Jakubowski, <i>History of Semiconductors</i> , Journal of Telecommunications and Information Technology, Vol. 3 (2010) (“Lukasiak”)
1008	U.S. Patent No. 4,203,158 to Dov Frohman-Bentchkowsky, et al. (“Frohman-Bentchkowsky”)
1009	U.S. Patent Application Publication No. 2006/0255399 to Ju-Hyung Kim, et al. (“Kim ’399”)
1010	U.S. Patent Application Publication No. 2003/0122204 to Kazumasa Nomoto, et al. (“Nomoto”)
1011	U.S. Patent Application Publication No. 2009/0179253 to Levy, et al. (“Levy”)
1012	U.S. Patent Application Publication No. 2011/0045647 to Jin-Hwa Heo, et al. (“Heo”)
1013	U.S. Patent Application Publication No. 2011/0281429 to Udayan Ganguly, et al. (“Ganguly”)
1014	U.S. Patent Application Publication No. US 2006/0113586 to Szu-Yu Wang (“Wang ’586”)

Exhibit No.	Description
1015	U.S. Patent No. 6,897,533 to Jean Yee-Mei Yang, et al. (“Yang ’533”)
1016	U.S. Patent Application Publication No. 2006/0198189 to Hang-Ting Lue, et al. (“Lue ’189”)
1017	U.S. Patent Application Publication No. 2009/0059676 to Shen Chih Lai, et al. (“Lai ’676”)
1018	Erh-Kun Lai, et al., <i>A Multi-Layer Stackable Thin-Film Transistor (TFT) NAND-Type Flash Memory</i> , Proceedings of the 2006 International Electron Devices Meeting (IEEE Dec. 2006) (“Lai Article”)
1019	U.S. Patent Application Publication No. 2005/0006696A1 to Mitsuhiro Noguchi, et al. (“Noguchi”)
1020	Antonio Arreghini, et al., <i>Experimental Characterization of the Vertical Position of the Trapped Charge in Si Nitride-Based Nonvolatile Memory Cells</i> , IEEE Transactions on Electron Devices, Vol. 55, No. 5 (May 2008) (“Arreghini”)
1021	U.S. Patent Application Publication No. 2010/0157680A1 to Masaaki Higuchi, et al. (“Higuchi”)
1022	U.S. Patent Application Publication No. 2008/0128790 to Jin-Hyo Jung (“Jung”)
1023	U.S. Patent Application Publication No. 2003/0198106 to Jeong-Hyuk Choi (“Choi”).
1024	U.S. Patent Application Publication No. 2009/0026460 to Tien-Fan Ou, et al. (“Ou”)
1025	Falong Zhou, et al., <i>VNDRM: A Novel Four-Bits-Per-Cell Vertical Channel Dual-Nitride-Trapping-Layer ROM for High Density Flash Memory Applications</i> , Proceeding of 2006 European Solid-State Device Research Conference (IEEE Sept. 2006) (“VDNROM”)
1026	H. Tanaka, et al., <i>Bit Cost Scalable Technology with Punch and Plug Process for Ultra High Density Flash Memory</i> , 2007 IEEE Symposium on VLSI Technology (June 2007) (“Tanaka”)

Exhibit No.	Description
1027	Toshiba Press Release, Toshiba Develops New NAND Flash Technology (June 12, 2007) (“Toshiba PR”)
1028	U.S. Patent Application Publication No. 2010/0178759A1 to JinGyun Kim, et al. (“Kim ’759”)
1029	Moon Kyung Kim, et al., <i>A Comparison of N+ Type and P+ Type Polysilicon Gate in High Speed Non-Volatile Memories</i> , Material Research Society Symposium Proceedings, Vol. 997 (MRS 2007) (“Kim Article”)
1030	U.S. Patent Application Publication No. 2006/0118858 to Sang-hun Jeon (“Jeon”)
1031	U.S. Patent Application Publication No. 2005/0237809 to Yen-Hao Shih, et al. (“Shih”)
1032	U.S. Patent Application Publication No. 2012/0276696 to Jun-Kyu Yang, et al. (“Yang ’696”)
1033	U.S. Patent Application Publication No. 2013/0270625 to Byong-hyun Jang, et al. (“Jang”)
1034	U.S. Patent Application Publication No. 2012/0068247 to Changhyun Lee, et al. (“Lee ’247”)
1035	U.S. Patent Application Publication No. 2012/0299086 to Jaegoo Lee (“Lee ’086”)
1036	U.S. Patent Application Publication No. 2011/0316064 to Jung Ho Kim, et al. (“Kim ’064”)
1037	U.S. Provisional Application No. 60/940,160 (“’160 Provisional App.”)
1038	Prosecution file history for the ’434 patent (U.S. Application No. 12/152,518) (“’434 Pros. Hist.”)
1039	Prosecution file history for the ’374 patent (U.S. Application No. 13/288,919) (“’374 Pros. Hist.”)
1040	Prosecution file history for the ’537 patent (U.S. Application No. 13/539,466) (“’537 Pros. Hist.”)
1041	U.S. Patent No. 6,912,163 to Wei Zheng, et al. (“Zheng”)

Exhibit No.	Description
1042	S.M. Sze and K. Ng, <i>Physics of Semiconductor Devices</i> (3 rd Ed. Wiley-Interscience 2007) (“Sze”)
1043	U.S. Patent Application Publication No. 2010/0019312 to Katsuyuki Sekine, et al. (“Sekine”)
1044	U.S. Patent No. 7,450,423 to Erh-Kun Lai, et al. (Lai ’423)
1045	Declaration of June Munford
1046	IEEE Declaration of Gordon MacPherson
1061	Search Disclosure Declaration of Nilesh Kumar (Submitted for <i>In Camera</i> Inspection by the Board Only)
1062	U.S. Patent No. 8,633,537 (“’537 patent”)
1063	U.S. Patent No. 9,929,240 (“’240 patent”)
1064	Motion to Stay Pending IPR Grant Rates, Docket Navigator, last visited December 16, 2025 (“Stay Grant Rates”)
1065	Median time-to-trial statistics for the U.S. District Court for the Northern District of California
1066	Judge P. Casey Pitts Standing Order for Civil Trials (“Standing Order”)
1067	Pretrial Order in <i>Kawasaki Jukogyo Kabushiki Kaisha v. Rorze Corp.</i> , 22-cv-04947 (N.D. Cal. May 20, 2025) (“Kawasaki Pretrial Order”)
1068	Pretrial Order in <i>Entangled Media, LLC v. Dropbox Inc.</i> , 23-cv-03264 (N.D. Cal. Sept. 15, 2025) (“Dropbox Pretrial Order”)
1069	Plaintiff’s Stipulation Regarding Invalidity Contentions filed October 29, 2025, in <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 25-cv-02389 (N.D. Cal.) (“Sotera Stipulation”)
1070	IPValue’s and Longitude Flash Memory Solutions’ Disclosure of Asserted Claims and Infringement Contentions in <i>Sandisk Corp. v. IPValue Management, Inc., et al.</i> , 25-cv-02389 (N.D. Cal.) (“Infringement Contentions”)

Exhibit No.	Description
1071	Exhibit D: P.R. 3-1(B) Chart for U.S. Patent No. 11,456,365 (“’365 patent claim chart”)
1072	Stipulation of Dismissal in <i>Sandisk Corporation v. IP Value Management, Inc., et al.</i> , 5:25-CV-02389-PCP (N.D. Cal.)
1073	Stipulation of Dismissal in <i>IP Value Management, Inc., et al. v. Sandisk Corp., et al.</i> , 8:25-CV-00119-MWF(DFMx) (C.D. Cal.)
1074	(Confidential Patent License Agreement)

Petitioner Sandisk Technologies, Inc., and Patent Owner Longitude Flash Memory Solutions, Ltd. (collectively “Parties”) hereby jointly move to dismiss the petition for *inter partes* review in this proceeding. In accordance with 37 C.F.R. § 42.20(b), the parties received authorization from the Board to file this motion on January 21, 2026.

The parties have settled with respect to the challenged patent and have reached an agreement to terminate this IPR. Termination of this proceeding is proper pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74.

First, this is a joint request by parties that have settled their dispute. 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). Both Congress and the 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.”). 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). Here, no public interest or other factors weigh against termination of this proceeding.

Second, the Director has not yet “decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a); 77 Fed. Reg. 48768 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”). Petitioner filed its petition for *inter partes* review on September 3, 2025. Patent Owner filed its mandatory notices on September 24, 2025, and a request for discretionary denial on November 17, 2025. Petitioner filed its opposition to the request for discretionary denial on December 16, 2025, and Patent Owner filed its Preliminary Response on December 16, 2025. On January 9, 2026, the Director referred the Petition for review for the merits and non-discretionary considerations. *See* Doc. No. 14. The Director has yet to issue an institution decision. No other party’s rights will be prejudiced by the termination of this *inter partes* review. This supports the propriety of terminating this proceeding even though the settlement and termination provisions of 35 U.S.C. § 317, on their face, apply only to “instituted” proceedings. 77 Fed. Reg. 48680, 48683 (Aug. 14, 2012) (§ 317(a) provides that “[a]n *inter partes* review . . . will be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”). Indeed, the Board has terminated entire IPR proceedings based on joint motions to terminate

before institution. *See Samsonite, LLC v. Otter Prods., LLC*, IPR2015-00507, Paper 13, at 2 (P.T.A.B. July 31, 2015) (granting motion to terminate pre-institution).

Third, the parties have dismissed their dispute in the district court proceedings with respect to the Challenged Patent: *Sandisk Corporation v. IP Value Management, Inc., et al.*, 5:25-CV-02389-PCP (N.D. Cal.), and *IP Value Management, Inc., et al. v. Sandisk Corp., et al.*, 8:25-CV-00119-MWF(DFMx) (C.D. Cal.). True copies of the stipulations of dismissal are filed herewith as Exhibits 1072 and 1073.

Alternatively, the parties jointly request dismissal of this *inter partes* review pursuant to 37 C.F.R. § 42.71(a). The Board has recognized that dismissal of pre-institution petitions is available upon a showing of good cause. *See, e.g., Ecobee, Inc. v. Lime Green Lighting, LLC*, IPR2019-00315, Paper 9 at 2-3 (P.T.A.B. March 19, 2019) (treating joint motion under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74 as a motion to dismiss under 37 C.F.R. § 42.71(a) and granting motion to dismiss pre-institution). Dismissal under 37 C.F.R. § 42.71(a) is appropriate here because the parties have settled their dispute and the Director has not yet issued a decision whether to institute an *inter partes* review. Further, this proceeding is still in a preliminary stage, the Board has not considered the merits of the Petition, and the parties are jointly requesting dismissal. Dismissal is warranted under these circumstances. *See* 37 C.F.R. § 42.71(a) (authorizing the Board to dismiss a

petition); *Sony Corp. v. Avago Tech's Gen. IP (Singapore) Pte. Ltd.*, IPR2017-00520, Paper 10 at 2-3 (P.T.A.B. June 22, 2017) (granting joint motion to dismiss pre-institution); *World Programming LTD v. SAS Institute, Inc.*, IPR2019-01457, Paper 19 at 2 (P.T.A.B. Dec. 27, 2019) (granting dismissal where proceeding is at early stage and dismissal will preserve the Board's resources).

As required by 35 U.S.C. § 317 and 37 C.F.R. § 42.74, the Parties' settlement agreement has been made in writing, and a true and correct copy of the same is filed herewith as Exhibit 1074. The Parties desire the settlement agreement be maintained as business confidential under 37 C.F.R. §42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

Date: January 21, 2026

Respectfully submitted,

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Harper Batts/

Harper Batts (Reg. No. 56,160)

ATTORNEYS FOR PETITIONER
SCANDISK TECHNOLOGIES, INC.

RUSS AUGUST & KABAT

/Neil A. Rubin/

Neil A. Rubin (Reg. No. 67,030)

Brian D. Ledahl (Pro Hac Vice)

James A. Milkey (Reg. No. 79,503)

Philip X. Wang (Reg. No. 74,621)

ATTORNEYS FOR PATENT OWNER
LONGITUDE FLASH MEMORY
SOLUTIONS LTD.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 21, 2026, a true and correct copy of the Unopposed Joint Motion to Dismiss the Petition for *Inter Partes* Review and Exhibits 1072-1074 were served in entirety via email to all parties to this proceeding at the addresses indicated:

Counsel for Patent Owner
Longitude Flash Memory Solutions, Ltd.
Russ August & Kabat

Neil A. Rubin

nrubin@raklaw.com

James A. Milkey

jmilkey@raklaw.com

Philip X. Wang

pwang@raklaw.com

ipvalue@raklaw.com

SHEPPARD, MULLIN,
RICHTER & HAMPTON LLP

/Harper Batts/

Harper Batts (Reg. No. 56,160)
Attorney for Petitioner

Date: January 21, 2026

1540 El Camino Real Suite 120
Menlo Park, CA 94025
Tel: (650) 815-2673