

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHARKNINJA OPERATING LLC,
SHARKNINJA MANAGEMENT LLC, AND
SHARKNINJA SALES COMPANY,
Petitioner,

v.

iROBOT Corporation,
Patent Owner.

PGR2021-00066
Patent 10,835,096 B2

Before BARRY L. GROSSMAN, TERRENCE W. MCMILLIN, and
JASON W. MELVIN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

ORDER
Dismissal Prior to Institution of Trial
35 U.S.C. § 324

I. BACKGROUND

SharkNinja Operating LLC, SharkNinja Management LLC, and SharkNinja Sales Company (collectively, “Petitioner”) filed on March 19, 2021, a Petition requesting a post grant review (“PGR”) of claims 1, 3–10, 12–14, 16–23, 25, and 26 of U.S. Patent No. 10,835,096 B2 (“the ’096 patent”). Paper 1. iRobot Corporation (“Patent Owner”) filed a Preliminary Response to the Petition on June 28, 2021. Paper 6.

After these initial filings, there followed a first series of pre-institution e-mails from the parties that resulted in an authorized Reply from Petitioner to address Patent Owner’s Preliminary Response arguments related to discretionary denial under 35 U.S.C. § 314(a) and claim construction arguments. Paper 8. Patent Owner filed an authorized Sur-reply. Paper 10.

A second series of pre-institution e-mails resulted in additional briefs from the parties (*see* Papers 15, 16) concerning a Request to Correct Inventorship filed by Patent Owner in the Patent and Trademark Office, but not with the Board, seeking to correct the named inventive entity of the ’096 patent. *See* Ex. 2011. A conference call was held on July 30, 2021, between the Judges on the panel and counsel for the parties to discuss Patent Owner’s filed Request to Correct Inventorship. A court reporter retained by Petitioner also was on the call and transcribed the call. *See* Ex. 1027. Following the discussion of issues, it was determined that additional briefing concerning the Request to Correct Inventorship was required. Paper 13. Petitioner (Paper 15) and Patent Owner (Paper 16) each filed briefs addressing whether Patent Owner needed Board authorization to file a certificate of correction of inventorship. We then issued an Order (Paper 17) granting Patent Owner’s request for retroactive authorization, if needed, and also granting Petitioner’s request for authorization to file a motion to

withdraw its petition in this proceeding prior to institution. Patent Owner's Request to Correct Inventorship has been granted. Ex. 2013 (filed in this proceeding on August 24, 2021). Petitioner's Motion to Withdraw the Petition (Paper 19, "Mot. Withdraw") is now before us. Patent Owner does not object to Petitioner withdrawing the Petition. Paper 16, 5 ("in the interest of promoting efficient resolution of this proceeding, iRobot does not oppose Petitioners' request to withdraw its petition if retroactive authorization is granted.").

The Board has not addressed the merits of the petition in this proceeding. A decision whether to institute a post-grant review is due September 24, 2021.

II. DISCUSSION

Petitioner asserts that the change in in the inventive entity of the '096 patent as a result of the Certificate of Correction raises a significant question as to whether a reference on which Petitioner relies in this post-grant review proceeding, the "Kleiner" reference, qualifies as prior art against the '096 patent. Mot. Withdraw 2 (citing Paper 16, 5). Petitioner states that this change in inventorship "render[s] moot this entire [post-grant] proceeding." Mot. Withdraw 3. Petitioner concludes that "withdrawal of the Petition at this pre-institution stage of the proceeding would preserve both the Board's and the parties' resources." *Id.* We agree. As stated above, Patent Owner does not object to withdrawal of the petition.

Accordingly, we grant Petitioner's Motion to Withdraw its petition for post-grant review and terminate further proceedings in PGR2021-00066.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Withdraw its petition for post-grant review is granted; and

FURTHER ORDERED that further proceedings in PGR2021-00066 are terminated.

PGR2021-00066
Patent 10,835,096 B2

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