

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Unified Patents, LLC

Petitioner,

v.

Motion Offense, LLC

Patent Owner.

Case No. IPR2020-00705

MOTION TO DISMISS AND TERMINATE

I. INTRODUCTION

Pursuant to the Board's September 1, 2020 Order, Unified Patents, LLC ("Unified") submits this motion to dismiss and terminate IPR2020-00705 under 37 C.F.R. § 42.71(a).

The Board has discretion to “*grant*, deny, or dismiss *any* petition or *motion*,” and to “enter *any appropriate order*.” 37 C.F. R. § 42.71(a) (emphasis added). Although Unified's Petition is meritorious, Unified nonetheless respectfully requests that the Board dismiss the petition and terminate the proceeding for the good cause shown herein. Specifically, this proceeding is in a preliminary stage, prior to institution, and Unified has recently sought to reallocate its budgets and resources, including, in light of the COVID-19 pandemic.

No proceeding has been initiated, and termination will achieve a just, speedy, and inexpensive resolution of the dispute. Petitioner has no further interest in challenging the subject patent in the future. The Board has yet to issue any decision, much less a decision on institution and preservation of resources would be real and substantial. Withdrawal is also in the interest of justice, as the parties have no other dispute, and dismissal will resolve all matters.

II. ARGUMENT

Good cause exists to voluntarily dismiss Unified's petition and terminate this proceeding prior to institution. Unified seeks to reallocate its budgets and resources,

including in light of the COVID-19 pandemic. Unified does not wish to spend additional resources on this proceeding. Patent Owner would not be prejudiced by dismissal and the Board's subsequent termination of this matter.

The Board has broad authority to terminate a petition prior to institution under 37 C.F.R. §§ 42.71(a) and 42.5(a). *See Facebook, Inc. v. EveryMD.com*, IPR2018-00050, Paper 19 (P.T.A.B. Oct. 9, 2018) (“[T]he regulations expressly provide the Board with broad authority to dismiss a petition where appropriate” and dismissing, among other reasons, since it was an “inefficient use of the Boards resources,” petitioner requested termination, and the proceedings were “at a relatively early stage”); *see also Samsung Elecs. Co. v. NVIDIA Corp.*, IPR2015-01270, Paper 11 (P.T.A.B. Dec. 9, 2015) (noting that “the rules do not expressly preclude termination ... during the preliminary proceedings” and dismissing because the case was “at [an] early juncture” and “to promote efficiency and minimize unnecessary costs”). When determining whether termination is “appropriate,” the Board has primarily looked to what stage of the proceedings the request is made and has repeatedly granted pre-institution termination. *See, e.g., Samsung*, IPR2015-01270, Paper 11 (granting opposed motion to terminate proceeding prior to institution of IPR); *HTC Corp. v. Patentmarks Comm., LLC*, IPR2014-00905, Paper 7 (P.T.A.B. Aug. 26, 2014) (same, stating that a “decision on the Petition ... has not yet been rendered. Under these circumstances, we determine that it is appropriate ... to terminate this proceeding

without rendering a final written decision.”). As with the Board’s many prior decisions, the facts here warrant dismissal and termination, at least to reduce the parties’ expenses, conserve Board resources, and promote efficiency.

Petitioner is not aware of any example wherein the Board found that it could not—or would not—terminate a proceeding at Petitioner’s request to withdraw prior to institution. In the few cases where the Board has denied a petitioner’s request for termination—all after institution—the Board has repeatedly attributed the advanced stage of the proceeding as weighing against termination. *See, e.g., Blackberry Corp. et al. v. MobileMedia Ideas LLC*, IPR2013-00016, Paper 31 (P.T.A.B. Dec. 11, 2013) (denying motion to terminate due to the advanced stage of the proceeding); *Masterimage 3D, Inc. et al. v. Reald Inc.*, IPR2015-00035, Paper 30 (P.T.A.B. June 25, 2015) (denying petitioner’s request to file a motion to terminate where the decision to institute issued two months prior). That is not the case here; the proceeding has not begun, and Unified’s request for dismissal and termination of the proceedings is early, voluntary, and consistent with precedent.

In its communication with the Board, Patent Owner indicated its intent to oppose this motion, despite its urging that institution should be denied (*see, e.g.,* Patent Owner Preliminary Response, pp. 3, 36); this is contrary to the stated purpose of the Board to expeditiously resolve disputes. Essentially, Patent Owner requests the Board to overlook its mandate, take on an additional administrative burden, and issue an

institution decision that either serves as an advisory opinion or asks an unwilling petitioner to litigate through a final written decision. There is no precedent for such a remarkable and prejudicial remedy prior to institution. Accordingly, Patent Owner's request should be denied.

During the conference call with the Board, Patent Owner alleged that Unified is seeking to avoid naming all real-parties-in-interest ("RPIs") by seeking to withdraw this petition. Not so. In over 200 matters, whenever challenged, Unified has always been found to be the sole real-party-in-interest in its proceedings. *See, e.g., Carucel Investments, L.P.*, IPR2019-01079, Paper 9 (Nov. 12, 2019); *American Patents LLC*, IPR2019-00482, Paper 36 (Aug. 6, 2019); *Uniloc 2017 LLC*, IPR2017-02148, Paper 82 (Apr. 11, 2019); *Barkan Wireless IP Holdings, L.P.*, IPR2018-01186, Paper 27 (Jan. 8, 2019), *Bradium Technologies, LLC*, IPR2018-00952, Paper 31 (Dec. 20, 2018), *Mobility Workx, LLC*, IPR2018-01150, Paper 9 (Dec. 3, 2018); *Realtime Adaptive Streaming, LLC*, IPR2018-00883, Paper 36 (Nov. 27, 2018); *Plectrum LLC*, IPR2017-01430, Paper 30 (Nov. 13, 2018). Here Unified, as it has done in other proceedings, has twice produced voluntary discovery related to RPI early and expeditiously, despite the preliminary phase of this proceeding. Petitioner seeks to withdraw based on realignment of budgets and its own limited resources, speculative aspersions notwithstanding. *See, e.g., LKQ Corporation v. GM Global Technology Operations LLC*, IPR2020-00063, Paper 11 (Mar. 6, 2020) and IPR2020-00065, Paper

12 (Mar. 6, 2020); *NEC Corporation et al. v. Neptune Subsea IP Limited*, IPR2018-01190, Paper 9 (Jan. 21, 2019); *Samsung Electronics Co., Ltd., et al. v. NVIDIA Corporation*, IPR2015-01314, Paper 8 (Nov. 30, 2015) and IPR2015-01270, Paper 8 (Nov. 30, 2015).

Nonetheless, as an added reassurance, Petitioner confirms that there are no side or other agreements with any other party in relation to this proceeding. And Petitioner has confirmed to Patent Owner, telephonically, and confirms to the Board that it does not intend to file another patent challenge against this patent or known related patents.

The Board should dismiss the petition and terminate this proceeding. Doing so would save the Board and the parties the time and resources needed to take IPR2020-00705 through final written decision, if the challenge is instituted. Furthermore, termination is also a just resolution, as Patent Owner will not be prejudiced by termination at this preliminary proceeding stage but rather will benefit from preserving its own resources.

III. CONCLUSION

The Board should allow the withdrawal prior to institution and terminate IPR2020-00705.

September 8, 2020

Respectfully submitted,

/s/ David M. Tennant

David M. Tennant

Registration No. 48,362

WHITE & CASE LLP

701 Thirteenth Street, NW

Washington, DC 20005-3807

Counsel for Petitioner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on September 8, 2020 a copy of the foregoing MOTION TO DISMISS AND TERMINATE was provided via email to:

Timothy Devlin (email: TD-PTAB@devlinlawfirm.com)

Derek Dahlgren (email: ddahlgren@devlinlawfirm.com)

dlflitparas@devlinlawfirm.com

September 8, 2020

Respectfully submitted,

/s/ David M. Tennant

David M. Tennant

Registration No. 48,362