

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SanDisk LLC
Petitioner,

v.

MEMORY TECHNOLOGIES, LLC
Patent Owner

Patent No. RE45,542

Inter Partes Review No. IPR2017-01022

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74 AND
JOINT REQUEST TO KEEP PAPERS SEPARATE
AS BUSINESS CONFIDENTIAL INFORMATION**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Patent Owner Memory Technologies, LLC and Petitioner SanDisk LLC jointly request termination of Inter Partes Review No. IPR2017-01022, which is directed to U.S Pat. No. RE45,542 (the “Challenged Patent”). The Parties additionally request that the settlement agreement be treated in its entirety as Business Confidential Information.

I. Request to Terminate

This proceeding is in the preliminary phase. The Petition was accorded a filing date on March 24, 2017. Patent Owner has not yet filed a preliminary response to the petition, and no trial has yet been instituted. The Parties jointly requested permission to file this motion on June 16, 2017 and received authorization to file the motion on June 27, 2017.

The Parties jointly submit that termination is appropriate because they have reached an agreement resolving their disputes involving the Challenged Patent. More specifically, the Parties have agreed to settle and dismiss their related district court litigation (*Memory Technologies, LLC v. SanDisk LLC, et al.*, No. 8:16-cv-02163-JLS-DFM (C.D. Cal.)) and the related ITC action (*In the Matter of Certain Flash Memory Devices and Components Thereof*, Inv. No. 337-TA-1034.). (Please note, there was a typographical error in the petition and the ITC action was inadvertently identified as No. 337-TA-3186. The correct number for the ITC

not yet been instituted, and no cross-examination or other discovery has occurred. Additionally, public policy consideration favor settlement between the parties. See Office Trial Practice Guide, 77 Fed. Reg. 48,756 at 48,768 (Aug. 14, 2012).

The agreement to terminate this proceeding has been made in writing, and a true and correct copy of the same is attached as Exhibit 2001. There are no additional collateral agreements or undertakings made in connection with, or in contemplation of, termination of this proceeding.

II. Status of Related Litigation

As noted above, the related district court and ITC action between Patent Owner and Petitioner have been settled. The related district court case has been dismissed. The Joint Motion to Terminate Investigation Based on Settlement and Patent License Agreement has been filed with the United States International Trade Commission and a decision from the ITC is pending. *See* Memory Technologies, LLC Exhibits 2001, 2002 and 2003.

III. Request To Treat Settlement Agreement as Business Confidential Information

The Parties hereby jointly request that the settlement agreement (including any related attachments) filed herewith as Memory Technologies, LLC Exhibit 2001 be treated as business confidential information, be kept separate from the file of the above captioned IPR, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant

settlement agreement has been filed for access by the “Parties and Board Only.”

V. Conclusion

For the foregoing reasons, Patent Owner and Petitioner jointly request that the Board terminate this Inter Partes Review proceeding, treat the settlement agreement filed herewith as business confidential information and keep the agreement separate from the file of the above captioned IPR.

Dated: July 7, 2017

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that a true copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72 AND JOINT REQUEST TO KEEP PAPERS SEPARATE AS BUSINESS CONFIDENTIAL INFORMATION** was served this 7th day of July, 2017, by e-mail upon the following:

Eliot D. Williams, eliot.williams@bakerbotts.com
Brian Oaks, brian.oaks@bakerbotts.com
Chris Ryan, chris.ryan@bakerbotts.com
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SanDisk has consented to service by electronic means.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY LLP

Dated: July 7, 2017

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