

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

PINN, INC,
Patent Owner.

Case IPR2021-00221
Patent 10,455,066

MOTION TO DISMISS PETITION FOR *INTER PARTES* REVIEW

I. INTRODUCTION

On March 16, 2021, the Board authorized Apple Inc. (“Petitioner” or “Apple”) to file a motion to dismiss each of its pending petitions for *inter partes* review of U.S. Patent Nos. 10,455,066 (“the ’066 Patent”) and 9,807,491 (“the ’491 Patent”), and thereby terminate IPR2021-00220, IPR2021-00221, and IPR2020-01668.

The instant petition is meritorious, and demonstrates the unpatentability of the challenged claims of the ’066 Patent. Nevertheless, Apple requests that the Board dismiss the instant petition and terminate IPR2021-00221 to preserve the Board’s and parties’ resources and promote a speedy and inexpensive resolution to this dispute.¹ IPR2021-00221 is in its preliminary phase, and the Board has not yet reached the merits by issuing a decision on institution. Petitioner and Patent Owner have met and conferred, and Patent Owner does not oppose the relief requested in this motion. Petitioner now so moves.

II. BACKGROUND

The instant petition is one of three petitions challenging the ’066 Patent filed by Apple, the first having been filed on June 11, 2020 as PGR2020-00066, and the

¹ Petitioner is concurrently filing motions to dismiss its IPR2021-00220 and IPR2020-01668 petitions.

second and third having been filed on November 23, 2020 as IPR2021-00220 and IPR2021-00221 (respectively).

On December 8, 2020, the Board issued a decision on the PGR2020-00066 petition in which it recognized that “the parties’ arguments and evidence suggests that it is more likely than not that Petitioner would prevail with respect to at least one of the claims challenged”; nevertheless, the Board exercised its discretion to deny institution of that petition, having determined “that instituting a post-grant review would be an inefficient use of Board resources.” PGR2020-00066 Pap. 15, 21.

On February 23, 2021, Patent Owner filed its preliminary responses in each of IPR2021-00220 and IPR2021-00221, urging the Board to exercise its discretion to deny both petitions. *See* IPR2021-00220 Pap. 7, 22-34; IPR2021-00221 Pap. 7, 23-35. The Board has not yet issued a decision on institution of either of IPR2021-00220 and IPR2021-00221.

III. ARGUMENTS

Consistent with 37. C.F.R. § 42.71(a) and the Board’s precedent allowing petitioners to withdraw petitions pre-institution, good cause exists to dismiss the instant petition and terminate IPR2021-00221. *See, e.g., Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01257 Pap. 16, 3 (PTAB Jan. 2, 2020)(granting petitioner’s unopposed motion to dismiss “to promote efficiency and minimize

unnecessary costs”); *Samsung Electronics Co. et al. v. Nvidia Corp.*, IPR2015-01270 Pap. 11, 3-4 (PTAB Dec. 9, 2015) (granting petitioner’s motion to dismiss despite opposition by patent owner, “to promote efficiency and minimize unnecessary costs”).

The instant proceeding is in its preliminary stage and a decision on institution is not due until May 23, 2021. As such, it would be appropriate to grant Petitioner’s unopposed motion to dismiss the instant petition and terminate IPR2021-00221 at this early juncture, to preserve the Board’s and parties’ resources and promote a speedy and inexpensive resolution to this dispute. *See Samsung*, IPR2015-01270 Pap. 11, 3.

Moreover, Patent Owner served its complaint alleging infringement of the ’066 Patent more than one year ago, and Petitioner is therefore barred from filing another petition for *inter partes* review with respect to the ’066 Patent. The withdrawal of the instant petition does not prejudice Patent Owner, which does not oppose the relief requested in this motion.

IV. CONCLUSION

Petitioner respectfully requests that the Board dismiss the present petition and terminate IPR2021-00221.

Proceeding No.: IPR2021-00221
Attorney Docket: 39521-0092IP3

Respectfully submitted,

Date: March 18, 2021

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