

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2014-00617
Patent 7,413,048

Before JAMESON LEE, MICHAEL W. KIM, and LYNNE E. PETTIGREW,
Administrative Patent Judges.

KIM, *Administrative Patent Judge.*

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.72

The parties have requested that the above-captioned proceeding be terminated pursuant to a settlement. The Board authorized the parties to file a joint request to terminate the above-captioned proceeding.

On December 31, 2014, and pursuant to 35 U.S.C. § 317, the parties filed a joint motion to terminate the above-captioned proceeding (Paper 14), along with a copy of the settlement agreement (Ex. 2001). The parties concurrently filed a joint

request to file the settlement agreement as business confidential information, to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 15).

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” The requirement for terminating review with respect to Petitioner is met.

Under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” American Honda Motor Co., Inc. is the sole petitioner in this review. The Board has discretion to terminate this review with respect to American Vehicular Sciences LLC as Patent Owner.

The joint motion to terminate indicates that the parties have settled their dispute, have reached agreement to terminate this proceeding, and have memorialized the parties’ agreement with respect to termination of the underlying litigation involving the ’048 patent in a settlement agreement. Paper 14, 1; Ex. 2001. The joint motion to terminate indicates also that there are no collateral side agreements referred to in the settlement agreement. Paper 14, 1. The joint motion to terminate identifies the following civil action regarding the ’048 patent: *American Vehicular Sciences LLC v. American Honda Motor Co., Inc., et al.*, No. 2:14-CV-13253 (E.D. Mich.). Paper 14, 3. The joint motion to terminate indicates that all claims concerning the ’048 patent between the parties in the aforementioned civil action will be dismissed with prejudice as a result of the settlement agreement. Paper 14, 2-3. The joint motion to terminate indicates further that if the Board elects to continue the review in any respect without the

Petitioner, the Patent Owner will not participate in any way in the review. Paper 14, 1-2.

Petitioner filed a petition on April 11, 2014, and Patent Owner filed a waiver of preliminary response to the Petition on July 18, 2014. The Board instituted *inter partes* review on September 18, 2014. Patent Owner has not filed a Patent Owner Response, and no depositions have been taken. Paper 14, 1. This proceeding has not resulted in a final decision on the merits.

Based on the facts of the case, it is appropriate to terminate the proceeding as to both Petitioner and Patent Owner. Therefore, the joint motion to terminate and the joint motion to file the settlement agreement as business confidential information are *granted*.

Accordingly, it is

ORDERED that the joint motion to file the settlement agreement as business confidential information, to be kept separate from the patent file, is *granted*;

FURTHER ORDERED that the joint motion to terminate the proceeding is *granted*; and

FURTHER ORDERED that the proceeding is *terminated*.

IPR2014-00617
Patent 7,413,048

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