

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2014-00643
Patent 7,630,802 B2

Before JAMESON LEE, BARBARA A. PARVIS, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

ORDER
Termination of Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On January 16, 2015, a joint motion to terminate this *inter partes* review was filed by Petitioner Mercedes-Benz USA, LLC (“Mercedes-Benz”) and Patent Owner, American Vehicular Sciences LLC (“AVS”). Paper 21. Also, on January 16, 2015, Mercedes-Benz and AVS filed a copy of their written settlement agreement covering Patent 6,746,078 involved in this *inter partes* review (Ex. 2001). Mercedes-Benz and AVS also filed a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 22. Mercedes-Benz and AVS represent that the settlement agreement filed as Exhibit 2001 is a true and accurate copy of their settlement agreement. Paper 21.

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 the 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 Mercedes-Benz is met.

Under 35 U.S.C. § 317(a), “If 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).” Mercedes-Benz is the sole petitioner in this review. The Board has discretion to terminate this review with respect to AVS as Patent Owner.

Mercedes-Benz and AVS indicate that related civil litigation between Mercedes-Benz and AVS involving Patent 6,746,078 has already been dismissed. Paper 21. The related civil litigation is identified as *American Vehicular Sciences LLC v. Mercedes-Benz U.S., Int’l., Inc.*, 6:13-cv-00310 (E.D. Tex.). *Id.*

The joint motion to terminate identifies other related litigation involving Patent 7,630,802, and defendants other than Mercedes-Benz, which will not be dismissed even if the Board grants the joint motion to terminate this proceeding. Paper 21. Additionally, other petitions have been filed for *inter partes* review of Patent 7,630,802. See IPR2013-00414, IPR2014-00637, IPR2014-00638, IPR2015-00174. However, there is no pending motion by any third party for joinder with this *inter partes* review.

AVS has not yet filed a Patent Owner Response in this proceeding. The Board determines that in these circumstances it is appropriate to terminate review both as to Mercedes-Benz and AVS without rendering a final written decision. See 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

It is

ORDERED that the joint motion to terminate IPR2014-00643 is *granted*, and this *inter partes* review is hereby terminated; and

FURTHER ORDERED that the Mercedes-Benz and AVS's joint request (Paper 22) to have their settlement agreement (Exhibit 2001) treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is also *granted*.

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Patent 7,630,802 B2

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