

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOMINION DEALER SOLUTIONS, LLC,
Petitioner,

v.

AUTOALERT, INC.,
Patent Owner.

Case IPR2014-00684
Patent 8,396,791 B2

Before JAMESON LEE, JONI Y. CHANG, and MICHAEL R. ZECHER,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

On March 11, 2014, the parties filed a Joint Motion to Terminate this *inter partes* review with respect to both Petitioner (“Dominion”) and Patent Owner (“AutoAlert”). Paper 26. Also on March 11, 2015, the parties filed a copy of their settlement agreement (Ex. 1015), and a Joint Motion to have the settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 27).

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), “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).” Dominion is the sole petitioner in this review. The Board has discretion to terminate this review with respect to AutoAlert as Patent Owner.

In the Joint Motion to Terminate, the parties indicate that the related district court action between them and involving U.S. Patent No. 8,396,791 B2 (“the ’791 patent”) was dismissed on March 6, 2015. Paper 26, 3. The motion identifies the civil action as *AutoAlert, Inc. v. Dominion Dealer Solutions, LLC et al.*, SACV12-01661 JST (JPR) (C.D. Cal.). *Id.* Two other entities also were named defendants in that case.

The Joint Motion identifies another related litigation involving the ’791 patent. Paper 26, 5. It is identified as *Dominion Dealer Solutions, LLC v. Michele K. Lee, Deputy Director of the United States Patent and Trademark Office*, Appeal

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No. 2014-1557 (Fed. Cir.). *Id.* The parties represent that they are in the process of having the case dismissed with respect to all named parties there. *Id.*

AutoAlert has filed a Patent Owner Response in this proceeding. Paper 18. Dominion, however, has not yet filed a Reply. The Board determines that, based on the circumstances of this case, it is appropriate to terminate review both as to Dominion and AutoAlert 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 IPR2014-00684 is *granted*, and this *inter partes* review is hereby terminated as to all parties including Dominion as Petitioner and AutoAlert as Patent Owner;

FURTHER ORDERED that the parties' Joint Motion (Paper 27) to have their settlement agreement (Ex. 1015) treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) also is *granted*; and

FURTHER ORDERED that the status of Exhibit 1015 in PRPS (Patent Review Processing System) will be re-designated to "Board Only."

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