

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBER TECHNOLOGIES, INC.
Petitioner,

v.

QUARTZ AUTO TECHNOLOGIES LLC
Patent Owner.

Case IPR2020-01231 (Patent 6,446,004 B1)
Case IPR2020-01232 (Patent 9,460,616 B1)

Before KEN B. BARRETT, LYNNE H. BROWNE, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

ORDER
Settlement Prior to Institution of Trial
35 U.S.C. § 42.74

I. INTRODUCTION

In each of the above-captioned proceedings, Uber Technologies, Inc. (“Petitioner”) and Quartz Auto Technologies, LLC (“Patent Owner”) (collectively “the Parties”) filed a Joint Motion to Terminate. Paper 11¹ (“Joint Motion”). Accompanying each Joint Motion, the Parties filed a copy of their Settlement, Release, and License Agreement. Ex. 1024. As authorized by 37 C.F.R. § 42.74, the Parties filed a Joint Request to Keep Separate with the Joint Motion. Paper 12 (“Joint Request”).

In each Joint Motion, the Parties state that they “jointly request termination” of the above-captioned proceedings. Joint Motion 1. The Parties assert that “[t]ermination of each proceeding is proper” because: 1) “the parties are jointly requesting termination;” 2) “the Board has not yet ‘decided the merits of the proceeding before the request for termination is filed’”; 3) “the related district court action, *Quartz Auto Technologies LLC v. Uber Technologies, Inc.*, Civil Action No. 6-20-cv-00126, pending in the Western District of Texas, is being concurrently dismissed;” and 4) “the parties executed a confidential settlement agreement to terminate this proceeding.” *Id.* at 1–2 (citations omitted).

There are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 84 Fed. Reg. 64,280 (Nov. 21, 2019). Each of the above-captioned proceedings is in its preliminary stage, and we have not yet decided whether to institute a trial. In view of the early stage in these proceedings and the settlement agreement between the Parties, we determine that good cause exists and that it is

¹ Citations herein are to the record in IPR2020-01231. Corresponding papers and exhibits may be found in the record of IPR2020-01232.

IPR2020-01231, -01232
Patent 6,446,004, 9,460,616

appropriate to dismiss the petition and terminate each of these proceedings as to the Parties, without rendering a decision on institution or a final written decision. *See* 37 C.F.R. § 42.74.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

II. ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate and Joint Requests to Keep Separate are granted; and

FURTHER ORDERED that the preliminary proceedings in IPR2020-01231 and IPR2020-01323 are terminated and their petitions are dismissed.

For PETITIONER:

Naveen Modi
Joseph Palys
Phillip Citroen
Jason Heidemann
PAUL HASTINGS LLP
naveenmodi@paulhastings.com
josephpalys@paulhastings.com
phillipcitroen@paulhastings.com
jasonheidemann@paulhastings.com

For PATENT OWNER:

Nicholas T. Peters
David Gosse
Timothy Maloney
FITCH, EVEN, TABIN & FLANNERY LLP
ntpete@fitcheven.com
dgosse@fitcheven.com
tpmalo@fitcheven.com