

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORP. and
CONTINENTAL AUTOMOTIVE SYSTEMS, INC.,
Petitioners,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2022-01130
Patent 8,811,356 B2

Before JAMES P. CALVE, SCOTT A. DANIELS, and
FREDERICK C. LANEY, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

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With our authorization, Petitioner Toyota Motor Corp. (“Toyota”) and Patent Owner filed a Joint Motion to Terminate this proceeding. Paper 21.

The parties assert that they

have entered into a settlement agreement that resolves all underlying disputes between Petitioner Toyota and Patent Owner, including the related district court proceeding, *Intellectual Ventures I LLC and Intellectual Ventures II LLC v. Toyota Motor Corp., Toyota Motor North America, Inc., Toyota Motor Engineering & Manufacturing North America, Inc., Toyota Motor Sales USA, Inc.*[], Case No. 2:21-cv-00389 (E.D. Tex.) (the “Lawsuit”), and this *inter partes* review proceeding IPR2022-01130, involving U.S. Patent No. 8,811,356 (the “356 patent”), currently before the Board.

Id. at 2.

Toyota and Patent Owner represent that Exhibit 1018, which we have reviewed, is “a true copy of the settlement agreement between Petitioner Toyota and Patent Owner.” *Id.* Toyota and Patent Owner further represent that “there are no other collateral agreements, oral or written, or understandings between the Petitioner Toyota and Patent Owner made in connection with, or in contemplation of, the termination of the proceeding.” *Id.* at 2–3. According to Toyota and Patent Owner, “[t]he agreement ends all patent disputes between Petitioner Toyota and Patent Owner, including this IPR proceeding with respect to Petitioner Toyota.” *Id.* at 3. Toyota and Patent Owner represent that Petitioner Continental Automotive Systems, Inc. (“Continental”) does not oppose this motion and remains active in this proceeding. *Id.* at 4.

In a separate paper, Toyota and Patent Owner jointly request that the Board treat Exhibit 1018 as business confidential information and keep this exhibit separate from the file of the '356 patent. Paper 22, 3. Toyota and Patent Owner further request that, because Petitioner Continental is not requesting termination, and will remain a petitioner in this proceeding, the settlement agreement between Toyota and Patent Owner remain categorized as “Board Only” in this proceeding. *Id.* at 2.

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 Board has not yet decided the merits of this proceeding. Thus, we terminate this proceeding with respect to Toyota. Section 317(a) also provides that, if no petitioner remains in the *inter partes* review, the Office may terminate the review. In this proceeding, Continental remains a petitioner. Thus, we do not terminate the review as to Continental and Patent Owner.

After reviewing the settlement agreement between Toyota and Patent Owner, we find that the settlement agreement contains confidential business information regarding the terms of settlement, and we determine that good cause exists to treat the settlement agreement as business confidential information. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74. Furthermore, because Continental remains in this proceeding, and Toyota and Patent Owner do not wish Continental to be able to access the settlement

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agreement, the settlement agreement will remain categorized as “Board only” in the Board’s P-TACTS system.

It is

ORDERED that the Joint Motion to Terminate is *granted* as to
Petitioner Toyota Motor Corp.;

FURTHER ORDERED that this proceeding is *terminated* as to
Petitioner Toyota Motor Corp.;

FURTHER ORDERED that this proceeding will continue between
Petitioner Continental Automotive Systems, Inc., and Patent Owner;

FURTHER ORDERED that Exhibit 1018 be treated as business
confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R.
§ 42.74(c) and also remain designated as available only to “Board” in the
Board’s P-TACTS system.

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