UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC
Petitioner

v.

STRAGENT, LLC,
Patent Owner

Case IPR2023-00334
Patent 11,354,179

JOINT MOTION OF PETITIONER AND PATENT OWNER TO TERMINATE INTER PARTES REVIEW PROCEEDING PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.72

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. **§** 42.72, and the Board's authorization provided on May 3, 2023, Petitioner BMW of North America, LLC. ("BMW" or "Petitioner") and Patent Owner Stragent, LLC ("Stragent" or "Patent Owner") (collectively, the "Parties") hereby provide notice that they have reached a settlement agreement and jointly request termination of *inter partes* review Case No. IPR2023-00334 challenging U.S. Patent No. 11,354,179 ("the '179 patent").

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the parties relating to the '400 patent and the '179 patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review 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 proceedings before the request for termination is filed. 37 U.S.C. § 317(a). Further, "no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner." See *id*.

Patent Owner has never filed suit against Petitioner asserting patent infringement of the challenged '400 and '179 patents.

On December 30, 2022, Petitioner filed IPR2023-00333 (directed to the '400

patent) and IPR2023-00334 (directed to the '179 patent). Patent Owner's Preliminary Response in both IPRs was due April 24, 2023. Neither IPR has been instituted and no other motions or actions are outstanding. The proceedings are thus in the preliminary stage, the record lacks full briefing on the trial issues, and the Board has accordingly not decided the merits of the proceedings.

The Parties also represent that they have agreed to settle and dismiss all other litigation between them and that there are no related IPR proceedings in the U.S. Patent and Trademark Office.

The Parties note that there is pending litigation with respect to certain patent family members of the '400 patent and the '179 patent in Delaware between Patent Owner and Volvo Car North America, LLC (1:20-cv-00512) and Volvo Car USA, LLC (1:22-cv-00293) ("Volvo"), neither of whom are a party in interest to either of these *inter partes* reviews.

Further, Patent Owner represents that, other than the pending litigation noted above, it does not have any plans at the present time to assert any of the challenged claims against any particular company. Thus, by granting the present motion, the Board and the Parties can conserve resources.

II. Agreement in Writing Submitted to the Board

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Parties' settlement agreement is being submitted as Exhibit 2001. The settlement

agreement is in writing and constitutes the Parties' entire understanding and agreement.

III. Conclusion

For at least the foregoing reasons, the Parties respectfully request that the Board terminate *Inter Partes* Reviews IPR2023-00333 and IPR2023-00334.

Dated: May 5, 2023

Respectfully submitted,

/G. Andrew Gordon/
G. Andrew Gordon

Counsel for Patent Owner
Stragent, LLC

/Lionel M. Lavenue/
Lionel M. Lavenue

Counsel for Petitioner
BMW of North America, LLC

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Joint Motion of Petitioner and Patent Owner to Terminate Inter Parte Review Proceeding Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72 were served on May 5, 2023, by electronic filing and electronic mail to the following:

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