

EXHIBIT 2001

AGREEMENT

This Agreement (“Agreement”), dated as of the date of signature of the last signatory below (the “Effective Date”), is entered into by and between Stragent LLC (“Stragent”), and BMW of North America, LLC (“BMW”) (Stragent and BMW may be individually referred to as “Party” and collectively as “Parties”).

WHEREAS, Stragent filed an action against BMW of North America, LLC and BMW Manufacturing Co., LLC in the United States District Court for the District of Delaware claiming infringement of certain United States patents, Case 1:20-cv-00510-JDW and filed another action against Bayerische Motoren Werke AG asserting the same patents, C.A. No. 1:23-cv-0005-JDW (collectively the “Actions”); and

WHEREAS, BMW has denied any liability for infringement of any Stragent patent.

NOW THEREFORE, for valuable consideration, the receipt and sufficiency of which is acknowledged, and other consideration as set forth below, Stragent and BMW agree as follows:

DEFINITIONS

“Covered Entity” means any natural person or other legal entity who, directly or indirectly, through one or more intermediaries, controls, or is controlled by, or is under common control with BMW, as of the Effective Date or at any time after the Effective Date, where “control” (including the terms “controlling,” “controlled by” and “under common control with”) means the possession, direct or indirect, of the power to direct or cause the direction of the management and policies, including by way of example only through the ownership of fifty percent (50%) or more of the voting securities or other interests. For purposes of this Agreement, BMW of North America, LLC; Bayerische Motoren Werke, AG; BMW Manufacturing Co., LLC; and BMW (US) Holding Corporation are all Covered Entities.

“Stragent Patents” means any patent or patent application owned by Stragent as of the Effective Date or which Stragent may own in the future, including all patents and patent applications claiming priority to such patents or from which such patents claim priority, and all reexaminations, reissues, patent applications, divisions, continuations, continuations-in-part, substitutions, additions of such patents, whether issued before or after the Effective Date. For clarity, the Stragent Patents include all patents identified in Exhibit A.

“Relevant Activities and Products” means all past, present and future systems, methods, processes, apparatuses, devices, products, software, vehicles, radios, navigation units, head-units, electronic control units, engine control units, suspension control ECUs, services, or components thereof of BMW or Covered Entities or that are or were or will be made, used, purchased, sold, offered for sale, licensed, leased, exported, imported or otherwise disposed of, by or for BMW or any Covered Entity.

TERMS

1. Covenant Not to Sue.

Stragent grants to BMW and BMW accepts a non-exclusive, fully paid-up, irrevocable covenant that Stragent will not sue (i) BMW, its predecessors, successors, parents, and/or Covered Entities in the United States and/or any foreign jurisdiction, for any or all causes of action, claims, and demands of whatever kind or nature, foreign or domestic, asserted or un-asserted, known or unknown arising from or related to the Stragent Patents, or (ii) BMW's and/or Covered Entity's past, present, or future agents, suppliers, vendors, distributors, customers, licensees, partners, officers, directors, owners, attorneys, or employees, in the United States and/or any foreign jurisdiction, for any or all causes of action, claims, and demands of whatever kind or nature, foreign or domestic, asserted or un-asserted, known or unknown arising from or related to the Stragent Patents (collectively "Covenant Not to Sue").

2. **Attorneys' Fees, Expenses, and Costs.** The Parties agree that they shall bear their own costs, expenses, and attorneys' fees relating to the Actions and to the negotiation of this Agreement.

3. Transferability.

The Covenant Not to Sue does not include the right to assign or otherwise transfer the rights granted under Paragraphs 1 or 2 to any third party without the Parties' express prior written consent. Stragent agrees that it will require any subsequent purchaser or assignee of one or more of the Stragent Patents to agree in writing to be bound by the terms of this Agreement. The failure to obtain such written agreement from a subsequent purchaser or assignee will render any purchase or assignment of the Stragent Patents null and void.

4. Releases.

a. **Release by Stragent of BMW.** Subject to the terms and conditions of this Agreement, Stragent hereby releases and discharges BMW, its predecessors, parents, and Covered Entities, and their past, present, and future agents, suppliers, vendors, distributors, customers, licensees, partners, officers, directors, owners, attorneys, or employees, solely with respect to the Relevant Activities and Products, from or relate to all causes of action, claims, and demands of whatever kind or nature, foreign or domestic, asserted or un-asserted, known or unknown that arise from the Stragent Patents, including without limitation forgiving and releasing any claim for any and all act(s) of alleged infringement that was raised, or could have been raised, in the Actions, on or before the Effective Date.

b. **Release by BMW of Stragent.** Subject to the terms and conditions of this Agreement, BMW hereby releases and discharges Stragent, and each of its owners, managers and members (and its agents, consultants, advisors, attorneys), from all causes of action, claims and demands of whatever kind or nature arising out of the claims or defenses that were or could have been asserted whether known or unknown with respect to Stragent's claims for infringement on or before the Effective Date (including but not limited to fees, costs, and attorneys' fees). Nothing herein precludes or shall be interpreted as exhausting or limiting in any way BMW's right to assert any cause of action, claim or demand of whatever kind or nature in

the event that BMW, its predecessors, parents, and Covered Entities, and their past, present, and future agents, suppliers, vendors, distributors, customers, licensees, partners, officers, directors, owners, attorneys, or employees is accused of infringing the Stragent Patents in the future.

c. No Assignment of Claims. Each Party represents and warrants to the other Party that, as of the Effective Date, no claim of any kind relating to the subject matter of this Agreement has been assigned or otherwise transferred (voluntarily or involuntarily) in any manner.

5. Dismissal of the Actions. Within 3 court days after the Effective Date, the Parties shall cause their respective counsel to execute and file the stipulated dismissals in the form set forth in Exhibit B dismissing with prejudice all claims asserted by Stragent in the Actions and dismissing without prejudice all counterclaims asserted by BMW (or any Covered Entity), with each Party bearing its own costs, fees, and expenses. The Parties shall promptly proceed with any and all additional procedures needed to dismiss with prejudice the Actions and withdraw all pending motions.

6. Other Activities. Upon filing of the stipulated motion:

a. Within five (5) business days of the Effective Date, the Parties will request the United States Patent and Trademark Office—Patent Trial and Appeal Board (“PTAB”) authorization to file joint motions to terminate BMW’s pending Petition For Inter Partes Review of U.S. Patent No. 11,354,179, IPR2023-00334, and Petition For Inter Partes Review of U.S. Patent No. 11,188,400, IPR2023-00333, and will file such motions within three (3) business days of receiving PTAB authorization, in a manner that substantially conforms to the form set forth in Exhibit C;

b. In Case 2022-2062 in the United States Court of Appeals for the Federal Circuit, *Stragent, LLC v. BMW of North America, LLC*, the Parties shall promptly file a Joint Motion to Dismiss providing that in light of the parties’ settlement, and pursuant to Federal Rule of Appellate Procedure 42(b)(1), the parties hereby stipulate and jointly move to voluntarily dismiss the above-captioned appeal with prejudice, with each party to bear its own costs and attorneys’ fees, in the form provided here as Exhibit D. Once the parties have moved to dismiss, BMW agrees to take no position on any motion filed thereafter by Stragent to vacate the Final Written Decision in United States Patent and Trademark Office—Patent Trial and Appeal Board, *Inter Partes* Review No. IPR2021- 00417.

7. Representations and Warranties.

a. By Stragent. Stragent represents and warrants to BMW that (i) Stragent has full power and authority to enter into this Agreement and to grant the Covenant Not to Sue above, (ii) this Agreement is a valid and binding agreement of Stragent enforceable against it in accordance with its terms, (iii) Stragent is the sole owner of all right, title, and interest in and to the Stragent Patents, and (iv) Stragent has not entered into any other contracts, agreements, or obligations that would conflict with the Covenant Not to Sue or this Agreement.

b. By BMW. BMW represents and warrants that (i) it has full power and authority to enter into this Agreement, and (ii) this Agreement is a valid and binding agreement of BMW enforceable against it in accordance with its terms.

8. Miscellaneous.

a. No Acts Contrary to Law. Nothing contained herein shall be construed so as to require the commission of any act contrary to law, and wherever there is any conflict between any provisions contained herein and any present or future statute, law, ordinance, or regulation, the latter shall prevail; but the provision of this Agreement which is affected shall be curtailed and limited only to the extent necessary to bring it within the requirements of the law.

b. Further Assurances. Stragent shall execute and deliver any and all additional papers, documents, and other assurances, and shall do any and all acts and things reasonably necessary in connection with the performance of its obligations hereunder to carry out the intent of the Parties.

c. Modifications or Amendments. No amendment, change, or modification of this Agreement shall be valid, unless in writing and signed by the Parties.

d. Entire Agreement. This Agreement constitutes the entire understanding and agreement of the Parties with respect to its subject matter and any and all prior agreements, understandings, or representations with respect to its subject matter are hereby terminated and canceled in their entirety and are of no further force or effect.

e. Non-Waiver. No waiver by any Party hereto of a breach of any provision of this Agreement shall constitute a waiver of any preceding or succeeding breach of the same or any other provision hereof.

f. Counterparts. This Agreement may be executed in one or more counterparts, each of which shall be deemed an original, but all of which together shall constitute one and the same instrument. The execution and delivery of counterparts of this Agreement, by facsimile or electronic means or by original manual signature, regardless of the means or any such variation in pagination or appearance shall be binding upon the parties executing this Agreement.

g. Captions. The captions appearing at the commencement of the sections hereof are descriptive only and for convenience in reference. Should there be any conflict between any such caption and the section at the head of which it appears, the section and not such caption shall control and govern in the construction of this Agreement.

h. Non-Agency. Nothing in this Agreement is intended or shall be deemed to constitute a partnership, agency, employer-employee, or joint venture relationship between Stragent and BMW. Neither Stragent nor BMW shall incur any debts or make any commitments binding on the other.

i. Governing Law. This Agreement shall be governed and the terms and conditions herein construed according to the laws of the State of Delaware without regard to that

state's body of law controlling conflicts of law. Nothing in this Section or Agreement shall be interpreted to be an admission that BMW, its parents, or any Covered Entities agree that they are subject to jurisdiction in the State of Delaware.

j. Severability. If any provision of this Agreement is held to be illegal or unenforceable, such provision shall be limited or eliminated to the minimum extent necessary so that the remainder of this Agreement will continue in full force and effect and be enforceable. The Parties agree to negotiate in good faith to enforce a substitute provision for any invalid or unenforceable provision that most nearly achieves the intent of such provision.

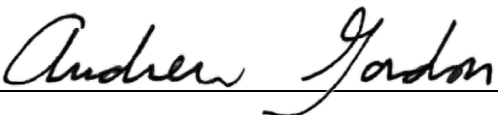
k. Volvo Car USA, LLC, under no condition or scenario, shall receive a full release or covenant not to sue with respect to the Licensed Patents by virtue of this Agreement. For avoidance of doubt, Stragent's covenant not to sue extends to any vehicles or components manufactured or supplied in whole or part by BMW or a Covered Entity irrespective of any involvement by Volvo Car USA, LLC.

* * *

IN WITNESS WHEREOF, the Parties have executed this Agreement as of the Effective Date.

Stragent, LLC

BMW of North America, LLC,

By: 

By: 

Name: Andrew Gordon

Name: Dena Epstein

Title: Manager

Title: Corporate Counsel

Date: April 27, 2023

Date: 4/28/23

EXHIBIT A

List of Patents and Pending Patent Applications Owned by Stragent

Patent number	Application Number
7,802,263	10/737690
8,209,705	12/182,570
8,566,843	13/531,319
9,575,817	14/011,705
9,705,765	15/405,088
10,002,036	15/405,110
10,031,790	15/919,201
10,248,477	16/148,949
11,188,400	16/042,159
11,354,179	17/387,988
NONE	14/011,712
NONE	17/746,730

EXHIBIT B

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

STRAGENT, LLC,

Plaintiff,

v.

**BMW OF NORTH AMERICA, LLC, and
BMW MANUFACTURING CO., LLC,**

Defendants.

Civil Action No. 1:20-cv-00510-JDW

STIPULATED DISMISSAL

Pursuant to Rule 41(a)(1)(A)(ii), Plaintiff and the Defendants (collectively, the “Parties”), jointly stipulate to dismissal of all claims asserted or which could have been asserted by Plaintiff herein with prejudice; any Counterclaims filed by Defendants are dismissed without prejudice. The Parties shall each bear their own attorneys’ fees, costs and expenses incurred in this action.

Respectfully submitted,

/s/ George Pazuniak

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/s/ DRAFT

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Attorneys for Defendants

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

STRAGENT, LLC,

Plaintiff,

v.

BAYERISCHE MOTOREN WERKE AG,

Defendant.

C.A. No. 1:23-cv-0005-JDW

NOTICE OF DISMISSAL

Pursuant to Fed.R.Civ.P. 41(a)(1)(A)(i), Plaintiff hereby dismisses all claims in this action with prejudice as to Defendant.

Dated: April XX, 2023

Respectfully submitted,

/s/ George Pazuniak

George Pazuniak (No. 478)

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Attorneys for Plaintiff

EXHIBIT C

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 No. IPR2023-00333
U.S. Patent No. 11,188,400

Case No. IPR2023-00334
U.S. Patent No. 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 April XX, 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 the following *inter partes* reviews:

1. Case No. IPR2023-00333 challenging U.S. Patent No. 11,188,400 (“the ‘400 patent”);
2. Case No. IPR2023-00334 challenging U.S. Patent No. 11,354,179 (“the ‘179 patent”).

Because none of the IPRs have been joined, this motion has been filed under separate caption in each proceeding.

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 1033. 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: April , 2023

Respectfully submitted,

/s
G. Andrew Gordon

Counsel for Patent Owner
Stragent, LLC

/s DRAFT
Lionel M. Lavenue

Counsel for Petitioner
BMW of North America, LLC

EXHIBIT D

2022-2062

United States Court of Appeals
for the Federal Circuit

STRAGENT, LLC,

Appellant,

v.

BMW OF NORTH AMERICA, LLC,

Appellee.

JOINT MOTION TO DISMISS

In light of the parties' settlement, and pursuant to Federal Rule of Appellate Procedure 42(b)(1), the parties hereby stipulate and jointly move to voluntarily dismiss the above-captioned appeal with prejudice, with each party to bear its own costs and attorneys' fees.

Respectfully Submitted,

/s/ George Pazuniak

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