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Paper 20
Entered: April 17, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

NORTHSTAR SYSTEMS LLC,
Patent Owner.

IPR2023-00890 (Patent No. 8,032,297 B2)
IPR2023-00934 (Patent No. 8,478,527 B2)
IPR2023-01017 (Patent No. 8,014,943 B2)[1]

Before MEREDITH C. PETRAVICK, BENJAMIN D. M. WOOD, and RYAN H. FLAX, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

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

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[1] This Order addresses issues that are the same in all identified cases. We exercise our discretion to issue one Order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

I. INTRODUCTION

With the Board's authorization, Petitioner and Patent Owner (collectively referred to as "the Parties") filed a Joint Motion to Terminate the above-identified proceedings due to settlement. Paper 19 ("Joint Motion").[2] In support of the Joint Motion, the Parties filed a Settlement Agreement (Ex. 1019 ("Settlement Agreement")).[3]

II. DISCUSSION

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings, and that the filed copy of the Settlement Agreement is a true copy. Joint Motion 2, 4. The Parties further represent that their settlement agreement resolves all disputes between the parties relating to, *inter alia*, U.S. Patent Nos. 8,032,297, 8,478,527, and 8,014,943, challenged in these proceedings. *Id*. at 2–3. The Parties also represent "that they have agreed to settle and dismiss all other litigations between them and that there are no related IPR proceedings in the U.S. Patent and Trademark Office." *Id*. at 3.

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

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[2] For purposes of expediency, we refer to papers and exhibits filed in IPR2023-00890. Patent Owner filed similar motions and exhibits in IPR2023-00934 and IPR2023-01017.

[3] Although authorized to do so, the Parties did not file a request that the settlement agreement be treated as business confidential information under 35 U.S.C. § 317.

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." Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

We instituted a trial on IPR2023-00890 on November 9, 2023. Paper 11 (in that proceeding). We instituted a trial on on IPR2023-00934 on December 8, 2023. Paper 11 (in that proceeding). We instituted a trial on IPR2023-01017 on December 8, 2023. Paper 12 (in that proceeding). We have not yet decided the merits of any of the above identified proceedings, and final written decisions have not been entered. Notwithstanding that the above identified proceedings have moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceedings are appropriate. Under these circumstances, we determine that good cause exists to terminate the above identified proceedings with respect to the Parties.

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate (Paper 19) is *granted*, and IPR2023-00890, IPR2023-00934, and IPR2023-01017 are *terminated* with respect to Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

IPR2023-00890 (Patent No. 8,032,297 B2)
IPR2023-00934 (Patent No. 8,478,527 B2)
IPR2023-01017 (Patent No. 8,014,943 B2)

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