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

Case No. IPR2023-01049
U.S. Patent No. 8,805,416

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 2, 2024, Petitioner BMW of North America, LLC. ("BMW" or "Petitioner") and Patent Owner NorthStar Systems LLC ("NorthStar" 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. IPR2023-01190 challenging U.S. Patent No. 6,898,432 ("the '432 patent");
2. Case No. IPR2023-00890 challenging U.S. Patent No. 8,032,297 ("the '297 patent");
3. Case No. IPR2023-00934 challenging U.S. Patent No. 8,478,527 ("the '527 patent");
4. Case No. IPR2023-01049 challenging U.S. Patent No. 8,805,416 ("the '416 patent");
5. Case No. IPR2023-01191 challenging U.S. Patent No. 8,805,416 ("the '416 patent"); and
6. Case No. IPR2023-01017 challenging U.S. Patent No. 8,014,943 ("the '943 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 ’432 patent, ’297 patent, ’527 patent, ’416 patent, and the ’943 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*.

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.

Further, Patent Owner represents that 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 1024. 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 IPR2023-01190, IPR2023-00890, IPR2023-00934, IPR2023-01049, IPR2023-1191, and IPR2023-01017.

Dated: April 2, 2024

Respectfully submitted,

/Vincent J. Rubino, III/
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/Lionel M. Lavenue/
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Counsel for Petitioner
BMW of North America, LLC

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION OF PETITIONER AND PATENT OWNER TO TERMINATE *INTER PARTES* REVIEW PROCEEDING** was served on April 2, 2024, via email directed to counsel of record for Patent Owner at the following:

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Dated: April 2, 2024

By: /Lisa C. Hines/
Lisa C. Hines
Case Manager
FINNEGAN, HENDERSON, FARABOW,
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