

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZENDRIVE, INC.,
Petitioner,
v.
CAMBRIDGE MOBILE TELEMATICS, INC.,
Patent Owner.

Case No. IPR2023-01440

U.S. Patent No. 10,672,249 B1

**JOINT MOTION TO TERMINATE PURSUANT TO
37 C.F.R. §§ 42.72 & 42.74**

UPDATED LISTING OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 10,672,249 B1 to Balakrishnan et al.
1002	File History of U.S. Patent No. 10,672,249 B1 to Balakrishnan et al.
1003	Declaration of Scott Andrews
1004	U.S. Patent No. 10,567,919 B2 to Schmitt et al.
1005	U.S. Patent No. 9,796,391 B2 to Olson et al.
1006	U.S. Patent No. 9,692,879 B1 to Lack
1007	Docket from <i>Cambridge Mobile Telematics, Inc. v. Zendrive, Inc.</i> , Case No. 1:22-cv-01260 (D. Del.)
1008	U.S. Patent No. 9,053,516 to Stempora
1009	U.S. Patent No. 10,158,977 B2 to Cordova
1010	Horrey et al., “In-Vehicle Glance Duration: Distributions, Tails, and Model of Crash Risk,” Transportation Research Record (Dec. 2007)
1011	Excerpt from Maloney, “Dutton’s Navigation & Piloting” (14 th Ed., 1985)
1012	Barbour et al., “Micromachined Inertial Sensors for Vehicles,” IEEE, 1058-1063 (1998)
1013	U.S. Patent No. 3,197,880 to Rice
1014	Ettelt et al., “A New Low Consumption 3D Compass Using Integrated Magnets and Piezoresistive Nano-Gauges,” Transducers ’11, 40-43 (June 5-9, 2011)
1015	Excerpt from Zhao, “Vehicle Location and Navigation Systems” (1997)

1016	Nowakowski et al., “Map Design: An On-the-Road Evaluation of the Time to Read Electronic Navigation Displays,” Technical Report UMTRI-98-4 (June 1998)
1017	Fleming et al., “Driver Performance and Memory for Traffic Messages: Effects of the Number of Messages, Audio Quality, and Relevance,” Technical Report UMTRI 98-22 (June 1998)
1018	U.S. Patent No. 6,122,682 to Andrews
1019	JP H10-232992 to Nojima (and associated translation)
1020	Excerpt from Resnick et al., “Physics, Part I” (1966)
1021	Confidential Settlement Agreement

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, and the authorization provided by the Board via email on December 21, 2023, Petitioner Zendrive, Inc. (“Petitioner”) and Patent Owner Cambridge Mobile Telematics, Inc. (“Patent Owner”) jointly move to terminate this proceeding in view of the parties’ settlement of their dispute relating to U.S. Patent No. 10,672,249 (“the ’249 patent”). The parties are filing, concurrently with the present motion, a true and complete copy of their written Settlement and License Agreement (“Settlement Agreement”) (Confidential Exhibit 1021). This Settlement Agreement completely settles the parties’ dispute relating to the ’249 patent.

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioner, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of this IPR. A joint request to treat the Settlement Agreement as business confidential information kept separate from the IPR file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently with this motion.

I. Argument

A joint motion to terminate “must (1) include a brief explanation as to why

termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at *2 (P.T.A.B. July 28, 2014). These factors are addressed in turn below.

A. Why Termination is Appropriate

The parties “may terminate the proceeding ... unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, 4 (November 2019); *see also id.*, 86 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding”). Here, the parties have entered into a settlement, and no longer have a dispute regarding the ’249 patent. Further, this proceeding is in its preliminary phase: the Board has yet to issue a decision on institution let alone a final decision on the merits. The Board has routinely terminated proceedings at the request of settling parties in cases that have progressed much further than the present proceeding. *See, e.g., Apex Med. Corp. v. Resmed Ltd.*, IPR2013-00512, Pap.39, 2 (Sept. 12, 2014) (granting motion to terminate in its entirety notwithstanding that instituted proceeding was fully briefed); *Volusion, Inc. v. Versata Software, Inc.*, CBM2013-00018, Pap. 52, 2-3 (June 17, 2014) (granting

motion to terminate instituted proceeding in its entirety after final oral hearing). The Board can conserve its resources by terminating now, removing the need for the Board to further consider the arguments, to issue an institution decision, or render a final decision. Ending this proceeding early will promote the Congressional goal of establishing a more efficient patent system by limiting unnecessary and counterproductive costs. *See* Changes to Implement Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents, 77 Fed. Reg. 48,680 (Aug. 14, 2012).

Termination is also appropriate for public policy reasons. Again, the parties have settled their dispute. And, Congress and federal courts favor settlement of litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir.) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit similarly favors settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). Indeed, the Board has stated an *expectation* that proceedings such as this will be terminated after the filing of a settlement agreement: “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding The Board *expects that a proceeding will terminate after the filing of a*

settlement agreement, unless the Board has already decided the merits of the proceeding. 35 U.S.C. § 317(a), as amended....” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012) (emphasis added).

B. Identity and Status of Any Related Litigations

The following district court litigation involves the '249 patent: *Cambridge Mobile Telematics Inc. v. Zendrive, Inc.*, No. 1:22-cv-01260 (D. Del.). On December 21, 2023, the parties stipulated and agreed to a dismissal of all remaining claims in that case. There are no other currently pending cases involving the '249 patent.

C. Identity and Status of Any Related Proceedings Currently Before the Office

The '249 patent is not currently at issue in any other pending *inter partes* review proceedings.

II. Conclusion

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated.

Respectfully submitted,

Date: 12/22/2023

/K. Patrick Herman/

K. Patrick Herman, Reg. No. 75,018
Orrick, Herrington & Sutcliffe LLP
51 West 52nd Street
New York, NY 10019
Telephone: (212) 506-3596
Email: P52PTABDocket@orrick.com

Attorney for Petitioner

Date: 12/22/2023

/Linnea Cipriano/

Linnea Cipriano, Reg. No. 67,729
Goodwin Procter LLP
620 Eighth Ave.
New York, NY 10018
Telephone: (212) 813-8800
Email: lcipriano@goodwinlaw.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing paper (and associated exhibit) was caused to be served on 12/22/2023 via email upon the following counsel of record for Patent Owner:

Linnea Cipriano (lcipriano@goodwinlaw.com)
Doug Kline (dkline@goodwinlaw.com)
Lana Shiferman (lsiferman@goodwinlaw.com)
Andrew Ong (aong@goodwinlaw.com)
GOODWIN PROCTER LLP

/K. Patrick Herman/

K. Patrick Herman, Reg. No. 75,018
Orrick, Herrington & Sutcliffe LLP
51 West 52nd Street
New York, NY 10019
Telephone: (212) 506-3596
Email: P52PTABDocket@orrick.com