

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC. ET AL.

Petitioner

v.

CUOZZO SPEED TECHNOLOGIES LLC

Patent Owner

IPR2013-00373

Patent 6,778,074

**JOINT MOTION TO TERMINATE PROCEEDING AS TO PETITIONER
PURSUANT TO 35 U.S.C. § 317**

Pursuant to 35 U.S.C. § 317(a) Petitioner Garmin International, Inc. et al. (“Petitioner”) and Patent Owner Cuozzo Speed Technologies (“Patent Owner”) jointly request termination of IPR2013-00373, which is directed to Patent 6,778,074 (the “’074 Patent”), as to Petitioner.

On December 18, 2013, the United States Patent and Trademark Office (“USPTO”) issued a Decision to Institute Inter Partes Review of certain claims of the ‘074 Patent. IPR2013-000373, Paper 12. No final written decision on the merits of this review proceeding has been entered. The parties have settled their dispute, and have reached agreement to terminate this *inter partes* review.

The parties’ Settlement Agreement has been made in writing, and a true copy of same is attached hereto as Exhibit 1116.¹ The parties desire that the Settlement Agreement be maintained as business confidential information under 37 C.F.R. §42.74(c) and a separate joint request to that effect is being filed on even date herewith.

1. Reasons Why Termination is Appropriate.

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 request of

¹ The Settlement Agreement is being filed electronically via the Patent Review Processing System (PRPS) as “Parties and Board Only.”

the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Because the parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed,” the USPTO is required to terminate the inter partes review with respect to Petitioner. Within the context of Section 317(a) a decision on the merits must be something beyond a decision instituting trial. Otherwise the quoted phrase would be rendered meaningless because every “*inter partes* review instituted under this chapter” originates with a decision instituting trial. Here, no decision on the merits has been made. Accordingly, the USPTO is required to terminate this inter partes review with respect to Petitioner based on this joint request.

Petitioner takes no position on whether this review proceeding should be terminated with respect to Patent Owner.

Because § 317(a) indicates that the USPTO is not required to terminate an inter partes review when no petitioner remains in the proceeding, Patent Owner is providing comments as to why termination with respect to Patent Owner is proper in *Patent Owner’s Explanation as to Why Termination Is Appropriate*, attached hereto as Appendix 1.

2. Related District Court Litigations and Status.

The ‘074 Patent is the subject of the following pending litigations:

Case Name	Docket No.	Court	Defendants	Status
<i>Cuozzo Speed Technologies LLC v. Garmin International, Inc.; Garmin USA, Inc.; Chrysler Group LLC</i>	Civil Action No. 2:12-cv-03623-CCC-JAD	U.S.D.C. for the District of New Jersey	Chrysler Group LLC; Garmin International, Inc. (will be dismissed); Garmin USA, Inc. (will be dismissed)	Pending
<i>Cuozzo Speed Technologies LLC v. General Motors Company</i>	Civil Action No. 2:12-cv-03624-CCC-JAD	U.S.D.C. for the District of New Jersey	General Motors Company	Pending
<i>Cuozzo Speed Technologies LLC v. JVC Americas Corporation</i>	Civil Action No. 2:12-cv-03625-CCC-JAD	U.S.D.C. for the District of New Jersey	JVC Americas Corporation	Closed
<i>Cuozzo Speed Technologies LLC v. TomTom, Inc. and Mazda Motors of America, Inc.</i>	Civil Action No. 2:12-cv-03626-CCC-JAD	U.S.D.C. for the District of New Jersey	TomTom, Inc. and Mazda Motors of America, Inc.	Pending

3. Future Participation by the Parties.

Pursuant to the Settlement Agreement, Petitioner will not further participate in these proceedings, even if they are not terminated pursuant to this joint motion.

Patent Owner reserves its right to participate, if necessary. Patent Owner notes,

however, that in the absence of Petitioner, it is unclear how these proceedings could properly proceed.

Respectfully submitted,

January 23, 2014
Date

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