

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2014-00647
Patent 5,845,000

Before JAMESON LEE, TREVOR M. JEFFERSON, and
LYNNE E. PETTIGREW, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.72

I. DISCUSSION

On November 19, 2014, pursuant to 35 U.S.C. § 317, the parties filed an authorized joint motion to terminate the above-captioned proceeding (Paper 17), along with a true copy of the written settlement agreement (Ex. 2001). The parties concurrently filed a joint request to file the settlement agreement as business confidential information, to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 18).

Petitioner meets the requirements for terminating review with respect to Petitioner as the Office has not decided the merits of the proceeding under 35 U.S.C. § 317(a), which states that “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

Under 35 U.S.C. § 317(a), “[i]f no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).” Mercedes-Benz USA, LLC is the sole petitioner in this review. The Board has discretion to terminate this review with respect to American Vehicular Sciences LLC as Patent Owner.

The joint motion to terminate indicates that the parties have reached agreement to terminate this proceeding, and have memorialized the parties’ agreement with respect to termination of the inter *partes* review involving the 5,845,000 patent (“the ’000 patent”) in a settlement agreement. Paper

IPR2014-00647
Patent 5,845,000

17, 1; Ex. 2001. The joint motion to terminate indicates that there are no collateral side agreements referred to in the settlement agreement. Paper 17, 1. The joint motion to terminate also states that if the Board elects to continue the review in any respect without the Petitioner, the Patent Owner will not participate in any way in the review. Paper 17, 1-2.

At the present stage of the proceeding, Patent Owner has not filed a Patent Owner Response and has submitted no declarations. Paper 17, 1. In addition, no depositions have been taken. *Id.* This proceeding has not resulted in a final decision on the merits.

Based on the facts of the case, it is appropriate to terminate the proceeding as to both Petitioner and Patent Owner. Therefore, the joint motion to terminate and the joint motion to file the settlement agreement as business confidential information are *granted*.

II. ORDER

Accordingly, it is

ORDERED that the joint motion to file the settlement agreement as business confidential information, to be kept separate from the patent file, is *granted*;

FURTHER ORDERED that the joint motion to terminate the proceeding is *granted*; and

FURTHER ORDERED that the proceeding is *terminated*.

IPR2014-00647
Patent 5,845,000

FOR PETITIONER:

Scott W. Doyle
Jonathan R. DeFosse
Shearman & Sterling LLP
scott.doyle@shearman.com
jonathan.defosse@shearman.com

FOR PATENT OWNER:

Thomas J. Wimbiscus
Scott P. McBride
Christopher M. Scharff
McAndrews Held & Malloy
twimbiscus@mcandrews-ip.com
smcbride@mcandrews-ip.com
cscharff@mcandrews-ip.com