

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TRW AUTOMOTIVE U.S. LLC

Petitioner

v.

MAGNA ELECTRONICS, INC.

Patent Owner

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Case IPR2015-01685

Patent 8,710,969

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**JOINT MOTION TO TERMINATE PROCEEDING  
PURSUANT TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74**

**AND**

**JOINT REQUEST THAT SETTLEMENT & LICENSE AGREEMENT BE  
TREATED AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT  
TO 35 U.S.C. § 317 and 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.72, Petitioner TRW Automotive U.S. LLC (“TRW”) and Patent Owner Magna Electronics, Inc. (“Magna”) (collectively, the “Parties”) jointly request termination of *Inter Partes* Review Case IPR2015-01685.

The IPR cases currently pending between the Parties are listed below in Table 1.

Table 1: Pending IPRs between the Parties

<b>Trial Number</b>	<b>Filing Date</b>	<b>Patent</b>
IPR2015-01693	8/8/2015	8749367
IPR2015-01692	8/8/2015	8749367
IPR2015-01685	8/7/2015	8710969
IPR2015-01013	4/7/2015	8686840
IPR2015-01012	4/7/2015	8686840
IPR2015-00961	3/27/2015	8116929
IPR2015-00960	3/27/2015	8116929
IPR2015-00950	3/27/2015	8636393
IPR2015-00949	3/27/2015	8629768
IPR2015-00923	3/24/2015	8686840
IPR2015-00439	12/19/2014	8599001
IPR2015-00438	12/19/2014	8599001
IPR2015-00437	12/19/2014	8599001
IPR2015-00436	12/19/2014	8599001
IPR2014-01499	9/12/2014	8531279
IPR2014-01497	9/12/2014	8531278

On February 10, 2016, the Parties e-mailed the Board to request the Board’s authorization to file joint motions to terminate the IPR Proceedings listed in Table

1. The Parties also sought the Board's authorization to file with the motions to terminate the IPRs requests to treat the written Settlement & License Agreement as business confidential information. The Board, in an e-mail dated February 10, 2016, authorized the Parties to file a motion to terminate and a request to treat the written Settlement & License Agreement as business confidential information in Case IPR2015-01685.

TRW filed its Petition in Case IPR2015-01685 on August 7, 2015 and challenged certain claims of Magna Patent No. 8,710,969. Magna filed its Preliminary Response (Paper 6) on November 19, 2015. The Board issued its Institution Decision (Paper 7) on February 10, 2016, and instituted trial as to claims 1–11 and 13–23 of the '969 Patent. Under the Scheduling Order dated February 10, 2016 (Paper 8, p. 6), Magna's Patent Owner Response is due on May 10, 2016.

The Parties have settled all of their disputes involving the '969 Patent, as well as other patents owned by Magna which cover or relate to forward facing camera systems. Pursuant to 37 C.F.R. § 42.74(b), the Parties' Settlement & License Agreement has been made in writing, and a true and correct copy is filed herewith as Exhibit 1010. The Settlement & License Agreement requires the Parties to cooperate to request that the Board terminate all pending TRW IPRs. The Settlement & License Agreement also calls for the dismissal of all pending lawsuits between the Parties that relate to the Magna Patents identified above in Table 1, particularly:

- *Magna Electronics Inc. v. TRW Automotive Holdings Corp., et al.*, No. 1:12-cv-00654 (W.D. Mich.).
- *Magna Electronics Inc. v. TRW Automotive Holdings Corp., et al.*, No. 1:13-cv-00324 (W.D. Mich.).
- *Magna Electronics Inc. v. TRW Automotive Holdings Corp., et al.*, No 1:13-cv-01364 (W.D. Mich.).
- *Magna Electronics Inc. v. TRW Automotive Holdings Corp., et al.*, No. 1:14-cv-00341 (W.D. Mich.).

The Trial Practice Guide notes that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” (77 Fed. Reg. 48756, 48768 (August 14, 2012)). The Trial Practice Guide further provides that “[t]he 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 [, *see* ] 35 U.S.C. 317(a), as amended, and 35 U.S.C. 327.” *Id.* The Parties thus request termination of Case IPR2015-01685 with respect to both Magna and TRW. The Parties also request that the Settlement & License Agreement (Ex. 1010) be treated as business confidential information under 35 U.S.C. § 317(b). Because Magna and TRW request this termination as to TRW, no estoppel under 35 U.S.C. § 315(e) shall attach to TRW under 35 U.S.C. § 317(a).

\* \* \*

Respectfully Submitted,

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Date: February 15, 2016

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