

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AM GENERAL LLC,
Petitioner,

v.

UUSI, LLC,
Patent Owner.

Cases¹

IPR2016-01050 (Patent 6,148,258)

IPR2016-01051 (Patent 5,729,456)

Before PHILLIP J. KAUFFMAN, MEREDITH C. PETRAVICK, and
RICHARD E. RICE, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

JUDGMENT

Termination Due to Settlement after Institution of *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.74

¹ We use this caption to indicate that this Decision applies to, and is entered in, each case. The parties are not authorized to use this type of caption.

IPR2016-01050 (Patent 6,148,258)

IPR2016-01051 (Patent 5,729,456)

I. Introduction

We instituted trial in IPR2016-01050 on November 14, 2016, and we instituted trial in IPR2016-01051 on November 22, 2016. IPR2016-01050, Paper 17; IPR2016-01051, Paper 13. On November 7, the parties filed in each proceeding a Joint Motion to Terminate *Inter Partes* Review under 35 U.S.C. § 317(a).² IPR2016-01050, Paper 43 (“Joint Motion to Terminate”); IPR2016-01051, Paper 40. Along with the Joint Motion to Terminate, the parties filed a true copy of their agreement to settle. IPR2016-01050, Paper 43, Exhibit B; IPR2016-01051, Paper 40, Exhibit B.

II. Discussion

Under 35 U.S.C. § 317(a), an *inter partes* review proceeding shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Patent and Trademark Office has decided the merits of the proceeding before the request for termination is filed. These proceedings are at a late stage of the trial. However, the Board has not yet entered final written decisions on the merits.

Furthermore, 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).” Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Petitioner is the sole petitioner in this review. The Board has discretion to terminate this review with respect to Patent Owner.

² In a conference call held on November 6, 2017, we authorized the parties to file each Joint Motion to Terminate.

IPR2016-01050 (Patent 6,148,258)

IPR2016-01051 (Patent 5,729,456)

Under 35 U.S.C. § 317(b), any agreement or understanding between a patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. In the Joint Motion to Terminate, the parties represent that they have settled their dispute and have reached an agreement that resolves the dispute in these proceedings and all other disputes between the parties relating to both of the patents at issue. IPR2016-01050, Paper 43, 2; IPR2016-01051, Paper 40, 2. Further, Patent Owner indicates that there are no other proceedings at the Board or other courts involving the patents at issue. *Id.* In support of the Joint Motions to Terminate, the parties submitted a true copy of their written settlement agreement in each proceeding. IPR2016-01050, Paper 43, Ex. B; IPR2016-01051, Paper 40, Ex. B.

Upon consideration of the circumstances of these proceedings, we grant the Joint Motions to Terminate and terminate these proceedings as to both Petitioner and Patent Owner without entering a final written decision in either *inter partes* review. 37 C.F.R. § 42.74.

III. Orders

It is ORDERED that the Joint Motions to Terminate are granted, and these *inter partes* reviews are hereby terminated.

IPR2016-01050 (Patent 6,148,258)

IPR2016-01051 (Patent 5,729,456)

PETITIONER:

Nicole M. Jantzi

Ian B. Brooks

Paul M. Schoenhard

McDermott Will & Emery LLP

njantzi@mwe.com

ibrooks@mwe.com

pschoenhard@mwe.com

PATENT OWNER:

Jay Kesan

Teresa Summers

DiMuro Ginsberg PC

jay@keyiplaw.com

teresa@keyiplaw.com