

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

TransCore, LP
Petitioner

v.

Access International, Inc.
Patent Owner

Case IPR2018-00048
Patent No. 7,286,158

**JOINT MOTION TO TERMINATE INTER PARTES REVIEW
PROCEEDINGS PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

I. INTRODUCTION

The Petitioner, TransCore LP and Patent Owner, Axxess International, Inc. (collectively referred to herein as “the Parties”) jointly request termination of inter partes Case No. IPR2018-00048 in accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74.

Petitioner and Patent Owner have agreed to settle all disputes between the Parties involving U.S. Patent No. 7,286,158 (the ‘158 patent), including all litigation and Patent Office proceedings related thereto. In particular, the Parties agreed to settle and dismiss their related district court litigation (Axxess International, Inc. v. TransCore, LP, Northern District of Texas Case No. 3:17-cv-01697-M).

Pursuant to 37 C.F.R. § 42.74(b), the Parties’ settlement agreement made in contemplation of termination of the proceedings is in writing, and a true and correct copy of such document is being filed herewith as Exhibit No. 1014. No other such agreements, written or oral, exist between the Parties.

II. BACKGROUND

On October 10, 2017, the Petitioner filed a petition for an inter partes review of claims 1-5, 8-12 and 19-21 of the '158 Patent.

On October 18, 2017, the Board accorded a filing date to the Petition. The deadline for the Board to instate the IPR has not yet passed.

On March 22, 2018, the Parties agreed to settle all of their disputes involving the '158 patent, including an agreement for the Patent Owner to file a dismissal with prejudice of all claims asserted by the Patent Owner in the pending litigation, and for the Parties to file a Joint Motion to Terminate IPR2018-00048.

On March 23, 2018 the Board authorized the Parties to file a joint motion to dismiss the petition, and for the settlement agreement to be treated as business confidential information and kept separate from the file (Exhibit 1013; email from Patent Trial and Appeal Board dated March 23, 2018).

III. TERMINATION OF THE IPR IS APPROPRIATE

Under 35 U.S.C. § 317(a), an inter partes review shall be terminated with respect to a party upon such joint request “unless the Office has decided the merits of the proceedings before the request for termination is filed.” Termination of this proceeding is appropriate because the Board has not yet decided the merits of the proceeding. More specifically, the Board has not yet decided to instate IPR2018-

00048.

As noted above, the Parties have reached a settlement agreement that resolves all disputes between the parties regarding the '158 patent. A true copy of the settlement agreement is filed concurrently herewith as Exhibit 1014. The settlement agreement requires, in part, that the Parties seek termination of this proceeding within five business days of the effective date of the settlement agreement. The settlement agreement further requires that the Parties seek dismissal of the related district court litigation within five business days of the effective date of the settlement agreement. Accordingly, the Petitioner and Patent Owner meet the statutory requirements for a "joint request" to terminate before the Office "has decided the merits of the proceedings." 35 U.S.C. §317(a).

Finally, there are strong public policy reasons to favor settlement between the parties to a proceeding.

IV. RELATED LITIGATION

As noted above, the Patent Owner brought an action for patent infringement with respect to the '158 patent in the Northern District of Texas. As part of the settlement agreement, the Patent Owner will file a termination of that proceeding within five business days of the settlement agreement.

No other litigation or proceedings exist between the Petitioner and Patent

Owner.

**V. TREATMENT OF SETTLEMENT AGREEMENT AS
BUSINESS CONFIDENTIAL INFORMATION**

Petitioner and Patent Owner hereby request that the settlement agreement filed herewith as Exhibit 1014 be treated as business confidential information, and be kept separate from the file of the above identified IPR, and be available only to the Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The settlement agreement contains confidential information that the Parties wish to remain private. The settlement agreement was executed with the intent that the contents thereof be kept confidential to the Parties. The settlement agreement has been filed for access by the “Parties and Board only” in view of this request.

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