

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR COMPANY,

Petitioner

v.

MICHIGAN MOTOR TECHNOLOGIES LLC,

Patent Owner

Case IPR2018-01077

Patent No. 7,143,501

**JOINT MOTION OF PETITIONER AND PATENT OWNER
TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317**

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.74, and the Board’s September 24, 2018 email granting the Parties permission to file this motion, Petitioner Hyundai Motor Company (“Hyundai”) and Patent Owner Michigan Motor Technologies LLC (“MMT”) (collectively the “Parties”) jointly request termination of this *Inter Partes* Review, Case No. IPR2018-01077. As there are no other petitioners in this proceeding and the proceeding is still at an early stage, the Parties respectfully submit that termination of the proceeding is appropriate.

STATEMENT OF FACTS

MMT sued Hyundai in *Michigan Motor Technologies LLC v. Hyundai Motor Company et al*, No. 2:17-cv-12901 (E.D. Mich), alleging infringement of U.S. Patent No. 7,143,501 (“the ’501 patent”).

Hyundai filed a Petition for *Inter Partes* Review of the ’501 patent on May 19, 2018. A Patent Owner Preliminary Response has not been filed nor has an Institution Decision been issued in this case.

The Parties have reached an agreement to end the present actions between them. Filed herewith is a true copy of the Parties agreement (Exhibit 1010). A “Joint Request to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317(b)” is being filed concurrently with this Joint Motion to Terminate to keep the settlement agreement confidential.

ARGUMENT

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

The Board should terminate this case as the Parties jointly request, for the following reasons.

1. Brief Explanation As To Why Termination is Appropriate

The Parties have met the statutory requirement that they file a “joint request” to terminate this proceeding before the office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). A decision on institution of this case is still many weeks away. No prior motions are pending.

The Parties have reached a settlement in the related litigation as to the ’501 patent and to end this dispute. A copy of the confidential settlement is filed concurrently herewith. *See* Ex. 1010. The Parties further jointly certify that there is no other agreement or understanding between them, including any collateral agreements, made in connection with, or in contemplation of, the termination of

the instant proceeding as set forth in 35 U.S.C. § 317(b).

The Parties respectfully submit that termination of this proceeding is appropriate because (a) this proceeding is at an early stage and no motions are outstanding; (b) the Parties have reached agreement to end their dispute concerning U.S. Patent No. 7,143,501; (c) the Parties have agreed to dismiss the related district court litigation with respect to U.S. Patent No. 7,143,501; (d) the Parties agree that this *Inter Partes* Review should be terminated; and (e) termination of this proceeding will preserve the Board's resources and obviate the need for any more Board involvement in this matter.

2. Identity of All Parties in Related Litigations Involving the Patent-At-Issue

The parties in *Michigan Motor Technologies LLC v. Hyundai Motor Company et al*, Case No. 2:17-cv-12901 (E.D. Mich) are Patent Owner, MMT, Petitioner, Hyundai, and Hyundai America Technical Center, Inc.

3. Identity of Any Related Proceedings Currently Before the Office

There are no other pending proceedings before the Office related to the '501 patent.

4. Current Status of Each Related Litigation and Proceeding

The joint stipulation filed in Case No. 2:17-cv-12901 requests dismissal with prejudice of all of Patent Owner's claims relating to the '501 patent.

CONCLUSION

For at least the foregoing reasons, Petitioner Hyundai Motor Company and Patent Owner Michigan Motor Technologies LLC respectfully request termination of this *Inter Partes* Review.

Dated: September 26, 2018

Respectfully submitted,

/Brian C. McCormack/

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