

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOYOTA MOTOR CORPORATION
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC
Patent Owner.

Case IPR2013-00412
Patent 6,738,697

Before JAMESON LEE, TREVOR M. JEFFERSON, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

ORDER
Termination of Proceeding
37 C.F.R. § 42.72

On March 26, 2014, the parties filed a joint motion to terminate this *inter partes* review with respect to both Petitioner (“Toyota”) and Patent Owner (“AVS”). Paper 35. Also on March 26, 2014, the parties filed a copy of their written settlement agreement covering Patent 6,738,697 involved in this *inter partes* review (Ex. 2001), and a joint request to have their settlement agreement

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treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 36). The parties represent that there are no collateral agreements referred to in their settlement agreement. Paper 35, 1.

Under 35 U.S.C. § 317(a), “[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.” The requirement for terminating review with respect to Petitioner is met.

Under 35 U.S.C. § 317(a), “If 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).” Toyota is the sole petitioner in this review. The Board has discretion to terminate this review with respect to AVS as Patent Owner.

In the joint motion, the parties indicate that their settlement agreement provides for dismissal of related civil litigation between Toyota and AVS, involving Patent 6,738,697, in the Eastern District of Texas, if the Board grants the motion to terminate proceeding. Paper 35, 2-3. The motion identifies the civil action as *American Vehicular Sciences v. Toyota Motor Corp., et al.*, No. 6:12-cv-00405 (E.D. Tex.)(filed June 25, 2012). *Id.*

The joint motion identifies other related litigation involving Patent 6,738,697, and defendants other than Toyota, which will not be dismissed even if the Board grants the joint motion to terminate proceeding. Paper 35, 3-6. On this record, the defendants in such other related litigation have not filed a petition for *inter partes* review of Patent 6,738,697, and there is no pending motion by any third party for joinder with this *inter partes* review.

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The joint motion identifies a related *inter partes* review proceeding involving Patent 6,738,697, and filed by Toyota, *i.e.*, IPR2013-00413, and indicates that the parties also are filing a joint motion to terminate that proceeding. Paper 35, 6-7.

AVS has not yet filed a Patent Owner Response in this proceeding or IPR2013-00413. The Board determines that in these circumstances it is appropriate to terminate review both as to Toyota and AVS without rendering a final written decision *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

It is

ORDERED that the joint motion to terminate IPR2013-00412 is *granted*, and this *inter partes* review is hereby terminated as to all parties including Toyota as the Petitioner and AVS as the Patent Owner; and

FURTHER ORDERED that the parties's joint request (Paper 36) to have their settlement agreement (Exhibit 2001) treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is also *granted*.

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