

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
HYUNDAI MOTOR COMPANY,
Petitioners,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2014-00629
Case IPR2015-00176
Patent 8,036,788 B2

Before BARBARA A. PARVIS and
GREGG I. ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On December 31, 2014, a telephone conference call was held between Joseph Melnik and Albert Liou, counsel for American Honda Motor Co., Inc. (“Honda”); Scott McBride and Stephanie Samz, counsel for American Vehicular Sciences LLC (“AVS”); and Judges Parvis and Anderson. Honda and AVS sought authorization to file a motion to terminate this proceeding as to Honda, on the basis that Honda and AVS have settled. Hyundai Motor Company will remain as the sole Petitioner.¹

Generally, the Board expects that a proceeding will terminate as to a petitioner who has settled after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and filed with the Board. 37 C.F.R. § 42.74.

During the conference call, the Honda and AVS sought authorization to file a joint motion to terminate the proceeding as to Honda. In addition, AVS and Honda sought guidance as to the procedure for filing their settlement agreement and to have the settlement agreement be treated as business confidential information under 37 C.F.R. § 42.74(c).

The Board indicated that filing of a joint motion to terminate this proceeding as to Honda is authorized. The joint motion should include: (1) a brief explanation as to why termination is appropriate; (2) the identity of all parties in any related district court case involving the patents at issue in the proceedings sought to be terminated as to Honda; (3) the identity of any related proceedings currently before the Office; and (4) the current status of each such related case or

¹ Ed Naidich and Christopher Kurpinski were on the call for Hyundai Motor Company.

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proceeding with respect to each party to the case or proceeding. *See Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, slip. op. at 2 (PTAB July 28, 2014) (Paper 26). The joint motion must specifically discuss the current status of the related litigation, *Am. Vehicular Sciences. LLC v. American Honda Motor Co., Inc.*, No. 6:13-cv-00226 (E.D. Tex.), with respect to each party to that litigation. The joint motion to terminate as to Honda must be accompanied by **a true copy** of the fully executed settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement is not a true copy of the settlement agreement.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the Board noted that the parties must file the confidential settlement agreement electronically via the Patent Review Processing System (PRPS). With Honda's agreement, AVS should file the settlement agreement in PRPS as "Board Only" so that, once filed, no party may view the settlement agreement. At the time of filing, AVS will serve Honda with a copy of the settlement agreement as filed.

Upon termination of this case as to Honda, this case will continue as to Hyundai Motor Company as the sole Petitioner. Our Order of Joinder November 25, 2014 (IPR2015-00176, Paper 12) is hereby amended to reflect that Hyundai is no longer subject to the restraints in the Order of Joinder related to consolidated filings.

Accordingly, it is:

ORDERED that Honda and AVS are authorized to file a joint motion to terminate this proceeding as to Honda on the basis that the parties have settled;

FURTHER ORDERED that the joint motion is due January 15, 2015;

FURTHER ORDERED that the joint motion must be accompanied by a

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true copy, labeled as an exhibit, of the settlement agreement as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b);

FURTHER ORDERED that the parties may file a separate joint motion requesting that the settlement agreement be treated as business confidential information as specified by 37 C.F.R. § 42.74(c) as per the agreement between Honda and AVS;

FURTHER ORDERED that any confidential settlement agreement must be filed electronically via PRPS as “Board Only;” and

FURTHER ORDERED that Order of Joinder November 25, 2014 (Paper 12) is hereby amended to reflect that Hyundai is no longer subject to the restraints in the Order of Joinder related to consolidated filings.

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