

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

---

Patent No. 6,738,697  
Filing Date: July 3, 2002  
Issue Date: May 18, 2004

Title: TELEMATICS SYSTEM FOR VEHICLE DIAGNOSTICS

Case No. IPR2014-00634  
&  
Case No. No. 2014-01543 (Joined with -00634)

---

**JOINT MOTION TO TERMINATE PROCEEDINGS  
FOR INTER PARTES REVIEW OF U.S. PATENT NO. 6,738,697  
PURSUANT TO 35 U.S.C. § 317**

---

**JOINT MOTION TO TERMINATE PROCEEDINGS**

IPR2014-00634 & -01543

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a)-(b), Petitioners American Honda Motor Co., Inc. (“Honda”) and Hyundai Motor Company (“Hyundai”) (collectively, “Petitioners”), and Patent Owner American Vehicular Sciences LLC (“AVS”) jointly request termination of the *Inter Partes* Review (IPR) of U.S. Patent No. 6,738,697, Case Nos. IPR2014-00634 and IPR2014-01543. Honda, Hyundai, and AVS are collectively referred to herein as “Parties” and individually as a “Party.” The Parties agree that each Party bear its own fees and expenses.

These reviews are in their early stages. Honda filed its petition for *inter partes* review on April 15, 2014. AVS filed a waiver of its right to a preliminary response on July 22, 2014. The review was instituted on August 26, 2014. Thereafter, Hyundai filed its petition for *inter partes* review, and Hyundai was joined in Honda’s *inter partes* review. No depositions have been taken. The Patent Owner has not filed any substantive paper, and the Patent Owner has submitted no declaration. The Parties have agreed to settle their dispute and have reached agreements to terminate these reviews. The Settlement Agreement with Honda has been made in writing and is filed separately as Exhibit 2001, the Settlement Agreement with Hyundai has been made in writing and is filed separately as Exhibit 2002. Each Settlement Agreement is being filed concurrently with a Joint

**JOINT MOTION TO TERMINATE PROCEEDINGS**

IPR2014-00634 & -01543

Request to Treat Agreement as Business Confidential Information Under 35 U.S.C. §317 (b) and 37 C.F.R. § 42.74 (c). There are no collateral agreements referred to in the Parties' Settlement Agreements.

**The Settlement Agreements reflect the Parties' desires that the Board terminate these reviews in their entirety. Accordingly, if the Board elects to continue either review in any respect without the Petitioners (instead of a full dismissal), AVS will not participate in any way in these reviews.**

As stated in 35 U.S.C. § 317(a), because all of Honda, Hyundai and AVS request this termination, it is understood that no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner Honda, and that no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner Hyundai. As provided in 37 C.F.R. § 42.73(d)(3), because no adverse judgment has been entered, it is also understood that, as to Patent Owner AVS, no estoppel under 37 C.F.R. § 42.73(d)(3) shall attach to AVS.

A conference call in IPR2014-00634 was held on October 29, 2014 between counsel for the Parties and Judges Lee, Kim, and Pettigrew. The Parties advised the Board that they have agreed in principle to settle, and discussed with the Board a joint motion to terminate the proceeding and to file the Parties' Settlement Agreement as business confidential information. During the conference call, the Board provided guidance to the parties regarding the form of such motion, based on

**JOINT MOTION TO TERMINATE PROCEEDINGS**

IPR2014-00634 & -01543

the agreement in principle that the parties had reached regarding settlement. A conference call in IPR2014-01543 was scheduled for October 29, but was averted, and counsel for Hyundai was fully apprised of the contents of the conference call in connection with IPR2014-00634.

On December 4, 2014, the parties wrote to the Board seeking authorization to file a joint motion to terminate. On December 5, 2014, the parties were notified via e-mail that the parties were authorized to file a joint motion to terminate.

The parties understood that they were also to file separate papers requesting that the Settlement Agreements be treated as business confidential information as specified in 37 C.F.R. § 42.74(c).

Termination of this proceeding is appropriate as the Parties have agreed to settle their disputes.

U.S. Patent No. 6,738,697 is being litigated in the following civil actions, all claims of which pertaining to U.S. Patent No. 6,738,697 will be dismissed with prejudice as a result of the Settlement Agreements:

- *American Vehicular Sciences LLC v. American Honda Motor Co., Inc. et al.*, No. 2:14-CV-13251 (E.D. Mich.), was transferred to the Eastern District of Michigan in 2014, and is in its early stages.
- *American Vehicular Sciences LLC v. Hyundai Motor Co. et al.*, No.

**JOINT MOTION TO TERMINATE PROCEEDINGS**

IPR2014-00634 & -01543

2:14-CV-13247 (E.D. Mich.), was transferred to the Eastern District of Michigan in 2014, and is in its early stages.

- *American Vehicular Sciences LLC v. Kia Motors America, Inc. et al.*, No. 2:14-CV-13249 (E.D. Mich.), was transferred to the Eastern District of Michigan in 2014, and is in its early stages.

No litigation or proceeding involving U.S. Patent No. 6,738,697 other than that identified above is contemplated in the foreseeable future.<sup>1</sup>

Wherefore, AVS, Honda and Hyundai respectfully request termination of the *Inter Partes* Reviews of U.S. Patent No. 6,738,697, Case Nos. IPR2014-00634 and IPR2014-01543.

Respectfully submitted,

Dated: December 8, 2014

/Thomas J. Wimbiscus/

Thomas J. Wimbiscus (Reg. No. 36,059)  
Scott P. McBride (Reg. No. 42,835)  
McANDREWS, HELD & MALLOY, LTD.  
500 West Madison St., 34<sup>th</sup> Floor  
Chicago, IL 60661  
Telephone: (312) 775-8000

---

<sup>1</sup> U.S. Patent No. 6,738,697 is also the subject of IPR2014-00645. A motion to terminate is pending in that IPR, but as of the preparation of this filing has not yet been ruled on by the Board.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.