

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Mercedes-Benz USA, LLC,  
Petitioner

v.

American Vehicular Sciences LLC  
Patent Owner

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Patent No. 6,738,697

Filing Date: July 3, 2002

Issue Date: May 18, 2004

Title: TELEMATICS SYSTEM FOR VEHICLE DIAGNOSTICS

Case No. IPR2014-00645

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

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Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a)-(b), Petitioner Mercedes-Benz USA, LLC (“Mercedes” or “Petitioner”), 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 No. IPR2014-00645. Mercedes and AVS are collectively referred to herein as “Parties.” The Parties agree that each party bear its own fees and expenses.

This IPR is in its early stages. Mercedes filed its petition for *inter partes* review on April 16, 2014. AVS filed a waiver of its right to a preliminary response on July 24, 2014. The IPR was instituted on August 28, 2014. 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 an agreement to terminate this IPR. The Settlement Agreement between the parties has been made in writing and is filed separately as Exhibit 2001, concurrently with a Joint 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 Agreement.

**The Settlement Agreement reflects the parties’ desires that the Board terminate this IPR in its entirety. Accordingly, if the Board elects to continue this IPR in any respect without the Petitioner (instead of a full dismissal), AVS**

**will not participate in any way in this IPR.**

As stated in 35 U.S.C. § 317(a), because both Mercedes and AVS request this termination, it is understood that no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner Mercedes. 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.

On November 18, 2014, the parties advised the Board that the parties had reached a settlement in this IPR, and the parties sought authorization to file a joint motion to terminate the proceeding. On November 19, 2014, the parties received written authorization to file a joint motion to terminate.

The parties understood that they were also to file a separate paper requesting that the Settlement Agreement 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, which are at the stages described below:

- *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. 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.

U.S. Patent No. 6,738,697 is also the subject of IPR2014-00634 filed by America Honda Motor Co., which was instituted on August 26, 2014.

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

Wherefore, AVS and Mercedes respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 6,738,697, Case No. IPR2014-00645.

Respectfully submitted,

Dated: November 19, 2014

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