

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

AMERICAN VEHICULAR SCIENCES LLC,
Patent Owner.

Case IPR2014-00645
Patent 6,738,697 B2

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

LEE, *Administrative Patent Judge*.

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

On November 19, 2014, the parties filed a Joint Motion to Terminate Proceeding, pursuant to 35 U.S.C. § 317, with respect to both Petitioner (“Mercedes-Benz”) and Patent Owner (“AVS”). Paper 19. Also on November 19, 2014, the parties filed a copy of their written settlement agreement (Ex. 2001) covering U.S. Patent No. 6,738,697 (“the ’697 patent”) involved in this *inter partes* review, and a joint request to have their settlement agreement treated as

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confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 20). The parties represent that there are no collateral agreements referred to in their settlement agreement. Paper 19, 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).” Mercedes-Benz is the sole petitioner in this review. The Board has discretion to terminate this review with respect to AVS as Patent Owner.

In a conference call held on December 11, 2014, among respective counsel for the parties and Judges Lee, Parvis, and Anderson, the parties indicated that all related civil actions between Mercedes-Benz and AVS, involving the ’697 patent, have been dismissed, including *American Vehicular Sciences LLC v. Mercedes-Benz U.S. Intl., Inc.*, No. 6:13-cv-00310 (E.D. Tex.). The joint motion identifies other related actions involving Patent No. 6,738,697, and defendants other than Mercedes-Benz, which still remain pending. Paper 19, 2–3. On this record, there is no pending motion by any third party for joinder with this *inter partes* review.

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

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It is

ORDERED that the joint motion to terminate IPR2014-00645 is *granted*, and this *inter partes* review is hereby terminated as to all parties including Mercedes-Benz as the Petitioner and AVS as the Patent Owner; and

FURTHER ORDERED that the parties's joint request (Paper 20) 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*.

For PETITIONER

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