

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

Patent No. 5,845,000

Filing Date: June 7, 1995

Issue Date: December 1, 1998

Title: OPTICAL IDENTIFICATION AND MONITORING SYSTEM USING
PATTERN RECOGNITION FOR USE WITH VEHICLES

Case No. IPR2014-00647

**JOINT MOTION TO TERMINATE PROCEEDING
FOR INTER PARTES REVIEW OF U.S. PATENT NO. 5,845,000
PURSUANT TO 35 U.S.C. § 317**

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. 5,845,000, Case No. IPR2014-00647. 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 its preliminary response on July 24, 2014. The IPR was instituted on October 23, 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. 5,845,000 is being litigated in the following civil actions, which are at the stages described below:

- *American Vehicular Sciences LLC v. Toyota Motor Corp., et al.*, No. 2:14-CV-13017 (E.D. Mich.), was transferred to the Eastern District of

Michigan in 2014, and is in its early stages.

U.S. Patent No. 5,845,000 is also the subject of:

- IPR2013-00424 filed by Toyota Motor Corporation, which was instituted on January 14, 2014 and argued before the Board on August 18, 2014, and is awaiting final written decision;
- IPR2015-00262 filed by Toyota Motor Corporation on November 17, 2014 with a motion to join the IPR that is the subject of this Joint Motion to Terminate (No. IPR2014-00647); and
- An *ex parte* reexamination filed by Toyota Motor Corporation on November 13, 2014, for which no control number was available as of the preparation of this filing.

No litigation or proceeding involving U.S. Patent No. 5,845,000 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. 5,845,000, Case No. IPR2014-00647.

Respectfully submitted,

Dated: November 19, 2014

/Thomas J. Wimbiscus/

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JOINT MOTION TO TERMINATE

IPR2014-00647

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