

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY.,
Petitioner

v.

PAICE L.L.C. AND THE ABELL FOUNDATION, INC.,
Patent Owner

Case IPR2015-00606
Patent 7,237,634

JOINT MOTION TO TERMINATE PROCEEDING UNDER 35 U.S.C. § 317

EXHIBITS

Exhibit Number	Exhibit Name
Exhibit 2101	Table of Ford's IPR Petitions
Exhibit 2102	Appendix A (Jan. 15, 2014)
Exhibit 2103	Bosch Automotive Handbook, 1996 ed.
Exhibit 2104	Declaration of Daniel A. Tishman in Support of Patent Owners' Motion for Pro Hac Vice Admission
Exhibit 2105	Declaration of Neil Hannemann
Exhibit 2106	Neil Hannemann CV
Exhibit 2107	ZVEI, Voltage Classes for Electric Mobility (December 2013)
Exhibit 2108	Gregory W. Davis Deposition Tr. (IPR2015-00758) (January 13, 2016)
Exhibit 2109	5-17-2016 Deposition Transcript of Jeffrey Stein Ph.D.
Exhibit 2110	Patent Owner's Demonstrative Exhibit
Exhibit 2111	Patent Settlement Agreement
Exhibit 2112	Patent License Agreement

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Pursuant to 35 U.S.C. § 317(a), the Petitioner, Ford Motor Company, and Patent Owners Paice L.L.C. and the Abell Foundation, Inc. (collectively, “Parties”) hereby jointly move for an order terminating the *inter partes* review, as a result of a confidential settlement between the Parties. The Parties’ settlement has been made in writing, and copies of the same are being filed concurrently herewith as Exhibits. There are no other agreements relating to the proceeding.

The IPR Proceeding relates to a petition for *Inter Partes* Review filed January 28, 2015, directed to U.S. Patent No. 7,237,634 (the “’634 Patent”), and assigned Proceeding Number IPR2015-00606. The Board entered a final written decision on November 8, 2016, which the Federal Circuit affirmed in part, vacated in part, and remanded on February 1, 2018.

In addition, the Parties desire that their settlement documentation be maintained as business confidential information under 37 C.F.R. § 42.74(c), and a separate joint request to that effect is being filed concurrently herewith.

1. Reasons Why Termination Is Appropriate.

Termination is proper under 35 U.S.C. § 317(a) because the Parties are jointly requesting termination, and the Office has not yet on remand “decided the merits of the proceeding before the request for termination is filed.” Here, the Federal Circuit vacated a portion of the Board’s final determination. On remand, the Board has yet to issue a final written decision, much less to consider new

evidence and briefing, prior to reaching a final written decision in this matter. For example, if remand were to proceed, Patent Owner intends to request the opportunity to submit additional briefing and evidence in view of the Federal Circuit's ruling—a request that Petitioner does not oppose.

As noted in the Patent Office Trial Practice Guidelines, “there are strong public policy reasons to favor settlement between the parties to a proceeding The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding. 35 U.S.C. § 317(a), as amended, and 35 U.S.C. § 327.”¹ Accordingly, termination is appropriate here.

2. Status of Related Cases/Proceedings.

The litigations styled *Paice LLC et al. v. Ford Motor Co.*, No. 1:14-cv-492 (D. Md.) and *Certain Hybrid Electric Vehicles and Components Thereof*, Inv. No. 337-TA-1042 have been dismissed as a result of the settlement between the parties.

¹ See Federal Register Vol. 77, No. 157 at 48768.

3. Conclusion

For the foregoing reasons, the Parties jointly request termination of IPR2015-00606.

Respectfully submitted,

Date: August 28, 2018

/Frank Angileri/
Frank Angileri, Reg. No. 36,733, *for*
Petitioner, Ford Motor Company.

Date: August 28, 2018

/Brian J. Livedalen/
Brian J. Livedalen, Reg. No. 67,450, *for*
Patent Owners, Paice L.L.C. and the
Abell Foundation, Inc.

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