

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC., NISSAN NORTH AMERICA,
INC., and KIA MOTORS AMERICA, INC.,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

Case IPR2015-01004¹
Patent 6,012,007

Before MEREDITH C. PETRAVICK, JEREMY M. PLENZLER, and
JAMES A. TARTAL, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ Nissan North America, Inc. and Kia Motors America, Inc. were joined as parties to this proceeding via Motions for Joinder in IPR2016-00113 and IPR2016-00115, respectively.

A conference call was held on Tuesday, March 29, 2016, to discuss the effect, on Petitioners Nissan North America, Inc. (“Nissan”) and Kia Motors America, Inc. (“Kia”), of a settlement reached between Petitioner American Honda Motor Co., Inc. (“Honda”) and Patent Owner in the underlying district court litigation. Counsel for Honda, Nissan, Kia, and Patent Owner, and Judges Petravick and Plenzler participated on the call.

All parties agreed to a collective filing of the Petitioner’s Reply by Nissan and Kia, and Nissan and Kia indicated that Kia would file the Petitioner’s Reply. Accordingly, we authorized Nissan and Kia to collectively file the Petitioner’s Reply in place of Honda.

During the call, Honda additionally requested authorization to file what was initially characterized as a joint motion to have it terminated as a Petitioner in this proceeding, but which it later characterized as a motion to dismiss it as a Petitioner in this proceeding. Honda indicated that it had settled its dispute in the underlying district court proceeding by obtaining a sub-license from a third party (i.e., a party that had obtained a license from Patent Owner). Accordingly, Honda indicated that there was no settlement agreement between Patent Owner and Honda to file, as required by 35 U.S.C. § 317(b).

Honda and Patent Owner are authorized to file a joint motion to terminate. *See* 35 U.S.C. § 317(a). The joint motion shall explain the circumstances of the dismissal of Honda from the underlying district court litigation. The parties are reminded that any agreement or understanding between Patent Owner and Honda, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing,

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and a true copy of that agreement or understanding shall be filed in the Office. 35 U.S.C. § 317(b). If no agreement exists between Honda and Patent Owner, as Honda represented during the call, in order to ensure compliance with 35 U.S.C. § 317(b) based on the facts of this proceeding, the parties are required to certify in writing that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including, but not limited to, licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of the instant proceeding. With respect to the sub-license obtained by Honda, if Honda files a motion to terminate that does not include the filing of that sub-license agreement, the motion should explain the circumstances of the sub-license agreement, including the nature of the relationship between the grantor of the sub-license and Honda (i.e., whether there is any form of corporate relationship between the parties, such as parent-subsidary) and why that agreement cannot and/or should not be filed in this proceeding. Any agreement filed to satisfy § 317(b) may be filed as “Board Only” in order to maintain the confidentiality of such an agreement and avoid the details of the agreement being disclosed to Petitioners Nissan and Kia.

In the event Honda and Patent Owner do not file a joint motion to terminate and, instead, believe that Honda should be dismissed as a Petitioner in this proceeding, as Honda appeared to suggest on the call, Honda is authorized to file a request for authorization to file a motion, limited to three pages, explaining the basis for such a motion to have it dismissed, including why termination would not be appropriate and how the

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circumstances of the proposed dismissal would affect the requirements of § 317(b) (i.e., an explanation as to why there would be no agreement to file with the Board).

It is

ORDERED that Petitioners Nissan and Kia are authorized to file a coordinated Petitioner's Reply in place of Petitioner Honda filing the Petitioner's Reply;

FURTHER ORDERED that Petitioner Honda and Patent Owner are authorized to file a joint motion to terminate as outlined above by no later than April 8, 2016; and

FURTHER ORDERED that in place of such a joint motion to terminate, Petitioner Honda may file a 3 page request for authorization to file a motion to have it dismissed from this proceeding, by no later than April 8, 2016, explaining the basis for a motion to have it dismissed as a petitioner in this proceeding, including why termination would not be appropriate and how the circumstances of the proposed dismissal would affect the requirements of § 317(b).

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