

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN HONDA MOTOR CO., INC.,
Petitioner

v.

SIGNAL IP, INC.,
Patent Owner

Case IPR2015-01004¹
Patent 6,012,007

**PETITIONER'S MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. §317**

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.

EXHIBITS

- Honda-1001 U.S. Patent No. 6,012,007 to Fortune et al. (“the ’007 Patent”)
- Honda-1002 Excerpts from the Prosecution History of the ’007 Patent (“the Prosecution History”)
- Honda-1003 Declaration of Dr. Kirsten M. Carr re the ’007 Patent
- Honda-1004 U.S. Patent No. 5,474,327 (“Schousek”)
- Honda-1005 U.S. Patent No. 5,232,243 (“Blackburn”)
- Honda-1006 Joint Claim Construction Brief , *Signal IP v. American Honda Motor Co., et al.*, Case 2:14-cv-02454-JAK-JEM, Document 46 (Joint Claim Construction Brief)
- Honda-1007 Email from Holly Atkinson confirming agreement to terminate
- Honda-1008 Joint Motion to Dismiss and Court Order, *Signal IP v. American Honda Motor Co., et al.*, Case 2:14-cv-02454-JAK-JEM, filed March 23, 2016.

Pursuant to 35 U.S.C. § 317(a), Petitioner American Honda Motor Co., Inc. (“Honda”) requests termination of this inter partes review of United States Patent No. 6,012,007, Case No. IPR2015-01004, as to Petitioner Honda only.

The Board authorized the filing of the instant Motion in an Order dated April 2, 2016 (Paper 19).

Termination with respect to Petitioner Honda is proper under 35 U.S.C. § 317(a), because the parties are jointly requesting termination and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” Further, Petitioner and Patent Owner have entered into a written agreement memorializing the prior oral agreement to jointly request termination of this inter partes review as to Petitioner Honda. A true and correct copy is being filed herewith as Exhibit 1007, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). Pursuant to 35 U.S.C. § 317(a), no estoppel shall attach to American Honda Motor Co., Inc. or its privies.

The litigation between the parties, *Signal IP, Inc. v. American Honda Motor Co., Inc. et al.*, Case No. 2-14-cv-02454, in the U.S. District Court for the Central District of California, was dismissed on March 23, 2016. As indicated during the March 28, 2016 conference between the Board and the parties, a Honda entity has obtained a license to the ‘007 patent from a third party. The third party is neither a

parent nor subsidiary of, and has no other corporate interrelationship to, Petitioner Honda, Patent Owner Signal IP or any of Petitioner's or Patent Owner's related entities. Additionally, Petitioner Honda and its related corporate entities are not a party to the agreement between Patent Owner and the third party. Thus, neither agreement represents an "agreement or understanding between the patent owner and a petitioner," as recited in 35 U.S.C. § 317(b), or an "agreement or understanding between the parties," as recited in 37 C.F.R. §42.74(b). Therefore, neither agreement should be filed. To satisfy § 317 the parties have memorialized their informal oral agreement regarding jointly terminating this inter partes review in the agreement filed as Exhibit 1007. There are no other agreements or understandings between Patent Owner and Petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of this inter partes review. The Joint Motion to Dismiss filed in the District Court and the Court's corresponding order are also being provided as Exhibit 1008.

Aside from this *inter partes* review proceeding, the '007 Patent is also the subject of the following proceeding(s) currently before the Office:

Proceeding	Requestor/Petitioner	Status
IPR2015-01116	Volkswagen Group of America, Inc.	Not instituted
IPR2016-00113	Nissan North America, Inc.	Instituted; joined with the present review

IPR2016-00115	Kia Motors America, Inc.	Instituted; joined with the present review
IPR2016-00292	Toyota Motor Corporation	Pending
IPR2016-00366	Aisin Seiki Co., Ltd.	Pending

As mentioned above, this request to terminate is only as to IPR2015-01004 and only as to Petitioner Honda.

The '007 patent has been asserted in the following litigations:

Proceeding	Status
<i>Signal IP, Inc. v. Kia Motors America, Inc.</i> , Case No. 2:14-cv-02457 (C.D. Cal.)	Active
<i>Signal IP, Inc. v. Mazda Motor of America, Inc.</i> , Case No. 8:14-cv-00491 (C.D. Cal.)	Active
<i>Signal IP, Inc. v. Nissan North America, Inc.</i> , Case No. 2:14-cv-02962 (C.D. Cal.)	Active
<i>Signal IP, Inc. v. Fiat U.S.A., Inc. et al.</i> , Case No. 2:14-cv-13864 (E.D. Mich., formerly C.D. Cal. Case No. 2:14-cv-03105)	Active
<i>Signal IP, Inc. v. American Honda Motor Co., Inc. et al.</i> , Case No. 2:14-cv-02454 (C.D. Cal.)	Concluded
<i>Signal IP, Inc. v. BMW of North America, LLC et al.</i> , Case No. 2:14-cv-03111 (C.D. Cal.)	Concluded
<i>Signal IP, Inc. v. Ford Motor Company</i> , Case No. 2:14-cv-13729 (E.D. Mich., formerly C.D. Cal. Case No. 2:14-cv-03106)	Concluded
<i>Signal IP, Inc. v. Hyundai Motor America</i> , Case No. 8:15-cv-01085 (C.D. Cal.)	Concluded
<i>Signal IP, Inc. v. Hyundai Motor America</i> , Case No. 2:15-cv-05166 (C.D. Cal.)	Concluded
<i>Signal IP, Inc. v. Jaguar Land Rover North America, LLC</i> , Case No. 2:14-cv-03108 (C.D. Cal.)	Concluded
<i>Signal IP, Inc. v. Mazda Motor of America, Inc.</i> , Case No. 2:14-cv-02459 (C.D. Cal.)	Concluded

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