

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SIGNAL IP, INC.,  
Patent Owner.

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Case IPR2015-01004<sup>1</sup>  
Patent 6,012,007

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

PLENZLER, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate with Respect to  
Petitioner American Honda Motor Co., Inc.  
*35 U.S.C. § 317(a)*

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<sup>1</sup> 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.

IPR2015-01004  
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On April 7, 2016, Petitioner American Honda Motor Co., Inc. (“Honda”) and Patent Owner, filed a joint motion to terminate this proceeding with respect to Petitioner Honda under 35 U.S.C. § 317(a). Paper 20 (“Mot.”).

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.” In their joint motion, the parties request termination of this proceeding because “a Honda entity has obtained a license to [U.S. Patent No. 6,012,007] from a third party” and “[t]he 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.” Mot. 1. The merits of this proceeding have not been decided.

Under 35 U.S.C. § 317(b), any agreement or understanding 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 the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. The parties represent that “Petitioner [Honda] 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” and that “[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).” *Id.* Because, as discussed above, the underlying litigation was dismissed as a result of Petitioner Honda obtaining a license to U.S. Patent No. 6,012,007 from a

third party, the parties represent there is no settlement agreement between Petitioner Honda and Patent Owner. *Id.* at 1–2. The parties represent that

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.

*Id.* In view of these representations, we are persuaded that Petitioner Honda and Patent Owner have met the requirements of 35 U.S.C. § 317(b).

Upon consideration of the facts in the case before us, we grant the joint motion and terminate this proceeding with respect to Petitioner Honda. The proceeding is not terminated with respect to Nissan North America, Inc. or Kia Motors America, Inc.

It is

ORDERED that the joint motion to terminate this proceeding with respect to Petitioner Honda is granted.

IPR2015-01004  
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