

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.,
Petitioners,

v.

SIGNAL IP, INC.
Patent Owner.

Case IPR2015-01004¹
Patent 6,012,007

NISSAN NORTH AMERICA, INC AND SIGNAL IP, INC.
JOINT MOTION TO TERMINATE AS TO
PETITIONER NISSAN NORTH AMERICA, INC.

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.

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a)-(b), Patent Owner Signal IP, Inc. (“Signal IP”) and Petitioner Nissan North America, Inc. (“Nissan”) hereby jointly move the Patent Trial and Appeal Board (“Board”) to terminate, with regard to Petitioner Nissan only, this *Inter Partes* Review of U.S. Patent No. 6,012,007 (Case No. IPR2015-01004). The Board authorized this motion by way of email dated May 20, 2016.

Petitioner American Honda Motor Co. Inc. (“Honda”), filed its petition for *inter partes* review on April 3, 2015, and trial was instituted on October 1, 2015. Petitioners 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, on February 2, 2016. On April 12, 2016, the Board granted a motion to terminate this proceeding with respect to Petitioner Honda.

Termination with respect to Petitioner Nissan is now 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 Nissan and Patent Owner Signal IP have entered into a written settlement agreement to, *inter alia*, jointly request termination of this *inter partes* review as to Petitioner Nissan. A true and correct copy of the settlement agreement is being filed herewith as Exhibit 2002, 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 Petitioner Nissan or its privies.

Status of Related Litigation

U.S. Patent No. 6,012,007 is at issue in the following pending litigation:

- Signal IP, Inc. v. Fiat USA, Inc. et al., 2-14-cv-13864 (MIED);
- Signal IP, Inc. v. Nissan North America, Inc., 2-14-cv-02962(CACD) (settled);
- Signal IP, Inc. v. Kia Motors America, Inc., 2-14-cv-02457 (CACD) (settled).

On April 17, 2015, the U.S. District Court for the Central District of California entered an Order re Claims Construction regarding, inter alia, U.S. Patent 6,012,007 at issue in the above-noted litigations. On May 20, 2015, various parties to the above-noted litigations entered into a stipulation for entry of a partial final judgment. Pursuant to the stipulation,

In light of the Court's claim construction order, Plaintiff and Defendants stipulate to entry of a partial final judgment that the following claims are invalid due to indefiniteness under 35

U.S.C. § 112, paragraph 2: . . . claims 1, 8, 9, 17, 18, 19, and 20 of the '007 patent. Plaintiff and Defendants reserve all appellate rights including, but not limited to, the right to appeal the Court's April 17, 2015 claim construction order to the United States Court of Appeals for the Federal Circuit. Plaintiff reserves all rights as to claims not addressed by the Court's claim construction order, or any new claims that may be issued by the United States Patent Office.

On May 22, 2015, pursuant to the above-referenced stipulation, the U.S. District Court for the Central District of California entered a Partial Judgment of Invalidity, that

Claims 1, 8, 9, 17, 18, 19, and 20 of U.S. Patent No. 6,012,007 ("the '007 patent") are invalid as indefinite under 35 U.S.C. § 112, paragraph 2.

Status of Related Proceedings

U.S. Patent No. 6,012,007 is also at issue in IPR2016-00292 and IPR2016-00366 (both pending).

For the foregoing reasons, Signal IP and Nissan respectfully request termination of this *Inter Partes* Review of U.S. Patent No. 6,012,007, Case No. IPR2015-01004, with regard to Petitioner Nissan only.

Dated: May 23, 2016

Respectfully submitted,

/Tarek N. Fahmi/

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