

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.,  
Petitioners,

v.

SIGNAL IP, INC.  
Patent Owner.

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

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KIA MOTORS AMERICA, INC AND SIGNAL IP, INC.  
JOINT MOTION TO TERMINATE

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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.

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 Kia Motors America, Inc. (“Kia”) hereby jointly move the Patent Trial and Appeal Board (“Board”) to terminate this *Inter Partes* Review of U.S. Patent No. 6,012,007 (Case No. IPR2015-01004).

## **I. REASONS FOR GRANTING THE MOTION**

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. See, e.g., Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing this motion by way of email dated May 25, 2016. Guidance as to the content of a motion to terminate is provided in IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements and is accompanied by the parties’ settlement agreement (Ex. 2003), as required by 35 U.S.C. § 317(b) and 35 C.F.R. § 42.74 (b).

**a. Brief Explanation of Why Termination is Appropriate**

Termination is appropriate under 35 U.S.C. § 317(a) because oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. 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. (“Nissan”) 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. A motion to terminate with respect to Petitioner Nissan is presently pending (Paper No. 24).

Further, Petitioner Kia and Patent Owner Signal IP have resolved their dispute and have entered into a written settlement agreement to, *inter alia*, jointly request termination of this *inter partes* review. A true and correct copy of the settlement agreement is being filed herewith as Exhibit 2003, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). The underlying litigation between the parties has already been dismissed.

Thus, termination of the proceeding satisfies the Congressional goal of establishing a more efficient and streamlined patent system that, *inter alia*, limits unnecessary and counterproductive litigation costs. See “Changes to Implement

Inter Partes Review Proceedings, Post-Grant Review Proceedings, and Transitional Program for Covered Business Method Patents,” Final Rule, 77 Fed. Reg., No. 157, p. 48680 (Tuesday, August 14, 2012). By permitting termination of review proceedings as to all parties, upon settlement of their disputes, the USPTO provides a measure of certainty as to the outcome of such proceedings. Such certainty helps foster an environment that promotes settlements, creating a timely, cost-effective alternative to litigation. Further, pursuant to 35 U.S.C. § 317(a), no estoppel shall attach to Petitioner Kia or its privies.

**b. 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).

On April 17, 2015, the U.S. District Court for the Central District of California entered an Order re Claims Construction in *Signal IP, Inc. v. BMW of North America, LLC et al.*, Case No. 2:14-cv-03111-JAK, regarding, *inter alia*, U.S. Patent 6,012,007 at issue in the above-noted litigation. On May 20, 2015, various parties to Case No. 2:14-cv-03111-JAK and its related cases 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.

Former litigations involving U.S. Patent No. 6,012,007 that have now been terminated are:

- *Signal IP, Inc. v. Toyota North America, Inc. et al.*, 2-15-cv-05162 (CACD);
- *Signal IP, Inc. v. Hyundai Motor America*, 8-15-cv-01085 (CACD);
- *Signal IP, Inc. v. Hyundai Motor America*, 2-15-cv-05166 (CACD);
- *Signal IP, Inc. v. Ford Motor Company*, 2-14-cv-13729 (MIED);
- *Signal IP, Inc. v. Fiat USA Inc. et al.*, 2-14-cv-03105 (CACD);

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