

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.,
Petitioner,

v.

SIGNAL IP, INC.,
Patent Owner.

Case IPR2015-01088
Patent 5,954,775

Before JOSIAH C. COCKS, MITCHELL G. WEATHERLY, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate

35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

On December 30, 2015, Volkswagen Group of America, Inc. (“Petitioner”) and Signal IP, Inc. (“Patent Owner”) filed a “Joint Motion to Terminate *Inter Partes* Review” (Paper 9, “Mot.” or “Motion”), indicating that the parties have resolved their dispute and have reached an agreement to, among other things, terminate this review (Mot. 2). The parties concurrently filed a copy of a “Settlement and License Agreement” executed by Petitioner and Patent Owner (Ex. 2004,¹ “Agreement”) and a “Joint Request to Keep Paper Separate” (Paper 10, “Req.”) indicating that the Agreement contains business confidential information and requesting that it be kept as a separate paper to be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Req. 2).

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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

The trial phase of this proceeding is in its early stages, as Patent Owner has not yet filed a Patent Owner Response and Petitioner has not yet filed a Reply. Accordingly, we have not yet decided the merits of the proceeding. Moreover, apart from the instant Motion, there are no outstanding motions in this proceeding. Under these circumstances, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner without rendering a final written decision pursuant to 35 U.S.C. § 318(a). *See* 37 C.F.R. §§ 42.72, 42.74.

¹ The parties filed the Settlement and License Agreement as Exhibit 2001, but Patent Owner previously filed copies of certain district court filings as Exhibits 2001 through 2003 on September 3, 2015. Accordingly, the Settlement and License Agreement has been renumbered as Exhibit 2004.

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Accordingly, it is

ORDERED that the Joint Motion to Terminate *Inter Partes* Review is *granted*;

FURTHER ORDERED that the *Inter Partes* Review instituted on October 29, 2015, is *terminated* with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to Keep Paper Separate is *granted*, and Exhibit 2004 is to be kept separate from the file of the involved U.S. Patent No. 5,954,775 and treated as confidential business information to be made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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