

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

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Pursuant to 35 U.S.C. § 317(a), the Petitioner and Patent Owner jointly request termination of this *inter partes* review, which is directed at U.S. Patent No. 5,954,775.

Termination of this review is appropriate because the parties have resolved their dispute and have reached an agreement to, among other things, terminate this review. Ex. 2001, Settlement and License Agreement (submitted as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)). The petition for review was filed on April 30, 2015. The Board has entered a decision instituting *inter partes* review on October 29, 2015. “Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement.” *Oracle Corp. v. Cmty. United IP, LLC*, CBM2013-00015, Paper 13 (July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765–66 (Aug. 14, 2012)).

US Pat. 5,954,775 is at issue in the following litigations:

- *Signal IP, Inc. v. Mercedes-Benz USA, LLC et al.*, 2-14-cv-03109 (CACD) (pending);
- *Signal IP, Inc. v. BMW of North America, LLC et al.*, 2-14-cv-03111 (CACD) (pending); and
- *Signal IP, Inc. v. Volkswagen Group of America, Inc. d/b/a Audi of America, Inc. et al.*, 2-14-cv-03113 (CACD) (dismissed).

A true copy of the parties' written settlement agreement is being filed as an exhibit contemporaneously with this joint motion to terminate. The settlement agreement has been filed for access by the "Parties and Board Only." The parties desire that the settlement agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request for such is being filed contemporaneously.

Respectfully Submitted,

Dated: 12/30/2015

By: /Michael J. Lennon/
Michael J. Lennon
(Reg. No. 26,562; mlennon@kenyon.com)
Clifford A. Ulrich
(Reg. No. 42,194; culrich@kenyon.com)
Michelle Carniaux
(Reg. No. 36,098; mcarniaux@kenyon.com)
Kenyon & Kenyon LLP
One Broadway
New York, NY 10004
Tel.: 212.425.7200
Fax: 212.425.5288

By: /Tarek N. Fahmi/
Tarek N. Fahmi (Reg. No. 41,402)
tarek.fahmi@ascendalaw.com
Holly J. Atkinson (Reg. No. 69,934)
holly.atkinson@ascendalaw.com
Ascenda Law Group, PC
333 W. San Carlos St., Suite 200
San Jose, CA 95110
Tel.: 866-877-4883
Fax: 408-773-6177
patents@ascendalaw.com

EXHIBIT LIST

Exhibit No.	Description
2001	Settlement Agreement (Parties and Board Only)

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

was served on December 30, 2015, by filing this document through the Patent Review Processing System as well as by delivering a copy via email directed to the attorneys of record for the Petitioner at the following address:

Michael J. Lennon
Clifford A. Ulrich
Michelle Carniaux
Kenyon & Kenyon LLP
One Broadway
New York NY 10004

ptab@kenyon.com

The parties have agreed to electronic service in this proceeding.

Respectfully submitted,

Dated: December 30, 2015

/Tarek N. Fahmi/

Tarek N. Fahmi
Reg. No. 41,402

Ascenda Law Group, PC
333 W San Carlos St., Suite 200
San Jose, CA 95110
Tel: 866-877-4883
Email: patents@ascendalaw.com