

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA LLC

Petitioner,

v.

ANTENNATECH LLC,

Listed Patent Owner.

U.S. Patent No. 8,180,279

“Wireless Hotspot Arrangement”

**JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35
U.S.C. § 317(A)**

Inter Partes Review No. 2015-01576

Pursuant to 35 U.S.C. § 317(a), Petitioner Mercedes-Benz USA (“MBUSA” or Petitioner) and Patent Owner AntennaTech LLC (“Antennatech” or Patent Owner) jointly request termination of IPR2015-01576, which is directed to U.S. Patent No. 8,180,279 (the “279 Patent”).

I. Statement of Precise Relief Requested

Pursuant to 35 U.S.C. § 317(a), Petitioner and Patent Owner jointly request termination of this *inter partes* review pursuant to settlement.

II. Statement of Facts

No decision on institution has been issued yet in this case. Further, Petitioner and Patent Owner have reached an agreement to settle this *inter partes* review proceeding. A “Joint Motion of Petitioner and Patent Owner to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317 and 37 C.F.R. §42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreement. *See* 35 U.S.C. 317(b) (requiring parties to file agreements in writing with the Office).

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.”

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

In response to the *first* requirement, termination is appropriate in this case because the parties have settled their dispute in the related district court action. A “Joint Motion of Petitioner and Patent Owner to File Settlement Agreement as Business Confidential Information Under 35 U.S.C. § 317 and 37 C.F.R. §42.74” is being filed concurrently with this Joint Motion to Terminate in reference to sealing of the settlement agreement. In response to the *second* requirement, the Petitioner and the Patent Owner are the parties to that related district court action, case no. 1:14-cv-00949-GMS (D. Del.). Petitioner and Patent owner understand that the ‘279 patent has been asserted in other district court litigations where Patent Owner is not a named party. In response to the *third* requirement, Petitioner and Patent Owner are aware of a pending *ex parte* reexamination of the ‘279 Patent, which has been assigned control number 90/013,460 (the “‘460 reexamination”). In response to the *fourth* requirement, with respect to proceedings before the Patent Office, the ‘460 reexamination was requested by Volkswagen Group of America, Inc., was instituted on claim 6 of the ‘279 patent, and currently has a non-final action pending on claim 6 of the ‘279 patent. There has been no action yet with respect to the instant proceeding, IPR2015-01576. With respect to the district court litigation between

Petitioner and Patent Owner, the court has dismissed that action pursuant to Fed. R. Civ. P. 41(a). 1:14-cv-00949-GMS (D. Del.) at Dkt. 24.

III. Argument

The Board should terminate this case as the parties jointly request, for the following reasons. First, Petitioner and Patent Owner have met the statutory requirement that they file a “joint request” to terminate before the office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). Under section 317(a), an *inter partes* review shall be terminated upon such joint request “unless the Office has decided the merits of the proceeding before the request for termination is filed.” There are no other preconditions of 35 U.S.C. § 317(a). And in this proceeding, a decision on initiation is still months away.

Second, the parties have reached a settlement as to all the disputes in this proceeding and as to the ‘279 Patent. A copy of the agreement is filed concurrently herewith. *See* Ex. 2001. The parties further jointly certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind, that are made in connection with or in contemplation of, the termination of the instant proceeding.

Third, a termination of this proceeding will preserve the Board's resources and obviate the need for any more Board involvement in this matter.

IV. Statement of Patent Owner Regarding Assignment of Ownership and Authority of Representation

Pursuant to 37 C.F.R. 3.73(c), Patent Owner identifies Reel/Frame number 026742/0311 and 032661/0616 regarding assignment of the '279 Patent from the inventors to Chester Holdings, LLC, and from Chester Holdings, LLC to Patent Owner, respectively. Patent Owner has therefore specified where documentary evidence of a chain of title from the original owner to the Patent Owner is recorded in the assignment records of the Patent Office, pursuant to 37 C.F.R. 3.73(c).

V. Conclusion

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of this *inter partes* review of the '279 Patent.

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