

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,
Petitioner

v.

ADAPTIVE HEADLAMP TECHNOLOGIES, INC.,
Patent Owner

Inter Partes Review No.: IPR2016-00196

U.S. Patent No. 7,241,034 C1

JOINT MOTION TO TERMINATE PROCEEDING

Exhibit No.	Description of Exhibit
Patents and Assignment Information	
BMW 1001	U.S. Patent No. 7,241,034, including Reexamination Certificate issued as U.S. Patent No. 7,241,034 C1
BMW 1002	USPTO Assignments on the Web for U.S. Patent No. 7,241,034
Documents Relating to Prosecution of the '034 Patent	
BMW 1003	File History for U.S. Serial No. 10/285,312
BMW 1004	File History for Ex Parte Reexamination Proceedings 90/011,011
BMW 1005	File History for Merged Reexamination Proceedings 90/011,011 & 95/001,621
Expert Declaration	
BMW 1006	Declaration of Dr. John Martens in Support of <i>Inter Partes</i> Review of U.S. Patent No. 7,241,034 C1
BMW 1007	<i>Curriculum Vitae</i> of Dr. John Martens
Prior Art	
BMW 1008	U.S. Patent No. 6,229,263 (“Izawa”)
BMW 1009	U.S. Patent No. 5,868,488 (“Speak”)
BMW 1010	Japanese Patent Application Publication H01-223042, September 6, 1988 (“Uguchi”), with certified English translation
BMW 1011	U.S. Patent Application Publication 2001/0012206 (“Hayami”)
BMW 1012	Japanese Patent Application No. P2001-277938, October 10, 2001 (“Nishimura”), with certified English translation
BMW 1013	U.S. Patent No. 6,671,640 (“Okuchi”)
BMW 1014	UK Published Patent Application GB 2 309 774 A (“Takahashi”)

BMW 1015	U.S. Patent No. 5,562,336 (“Gotou”)
BMW 1016	U.S. Patent No. 5,404,278 (“Shibata”)
BMW 1017	French Patent No. 995,205, with machine translation
BMW 1018	Green, Gavin, “Future Shock: Nothing as otherworldly radical had ever touched down on Planet Earth,” Aug. 10, 2006, available at http://www.motortrend.com/news/c12-0511-1960-citroen-ds/
BMW 1019	U.S. Patent No. 6,547,425
Other	
BMW 1020	Adaptive Headlamp Technologies, Inc.’s Disclosure of Asserted Claims, served in U.S. District Court for the District of Delaware in Case No. 1:14-cv-00962-GMS.
BMW 1021	CONFIDENTIAL Settlement Agreement

Pursuant to 35 U.S.C. §317(a), Petitioner BMW of North America, LLC (“Petitioner”) and Patent Owner Adaptive Headlamp Technologies, Inc. (“Patent Owner”) jointly request termination of this *inter partes* review of U.S. Patent No. 7,241,034 (“the ’034 patent”).

Termination is appropriate because the parties have entered into a settlement agreement that resolves all underlying disputes between the parties with respect to the ’034 patent, including the present *inter partes* review proceeding IPR2016-00196. The petition for review was filed on November 16, 2015. The Board has not entered a decision regarding institution. “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, 48756-66 (Aug. 14, 2012)). Under 35 U.S.C. § 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.” Petitioner and Patent Owner have met this statutory requirement.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the parties’ written settlement agreement is being filed as an exhibit contemporaneously with this joint motion to terminate. (Ex. 1021, Settlement Agreement). 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 have filed a separate request to that effect. As part of the settlement agreement, the parties have agreed to move for dismissal of the related district court litigation *Adaptive Headlamp Technologies, Inc. v. BMW of North America, LLC*, No. 1:14-cv-00962 (D. Del.).

Petitioner and Patent Owner are aware of three additional pending petitions for *inter partes* review of the '034 Patent, including IPR2016-00079, IPR2016-00193, and IPR2016-00501, requested by Koito Manufacturing Co., Ltd., SL Corporation, and Mercedes-Benz USA LLC, respectively. None of the pending *inter partes* reexaminations has been instituted.

Petitioner and Patent Owner understand that the '034 patent has been asserted in other district court litigations where Petitioner is not a named party.

The filing of this joint motion was authorized by the Board in an e-mail communication on April 5, 2016.

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the Board terminate this proceeding in its entirety.

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