

Filed on behalf of Petitioners
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR AMERICA, INC., HYUNDAI MOTOR COMPANY,
KIA MOTORS CORPORATION & KIA MOTORS AMERICA, INC.
Petitioners

v.

PAICE LLC &
ABELL FOUNDATION, INC.
Patent Owners

Case: IPR2016-00246
U.S. Patent No. 7,237,634

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317(a), Petitioners and Patent Owners jointly request termination of *inter partes* review (IPR) no. IPR2016-00246, which is directed to U.S. Patent No. 7,237,634. The parties are also separately filing motions to terminate IPR2016-00247, 00248, 00249 and 00251, which are also directed to U.S. Patent No. 7,237,634, as well as IPR2016-00272 and 00250, which are directed to U.S. Patent Nos. 7,104,347 and 8,214,097, respectively.¹

Termination of this proceeding is appropriate as the parties have settled their dispute and have reached an agreement to terminate all of the above-identified *inter partes* review proceedings. The parties have entered into a written Settlement Agreement, a true copy of which has been submitted as Exhibit No. 1302. The parties desire and jointly request that this Settlement Agreement be treated as confidential business information and that it be kept separate from the files of the challenged patents and the above-identified IPRs in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties are separately filing joint requests to this effect.

¹ The petitions for all of the identified proceedings were accompanied by joinder motions. The parties respectfully request that the Board dismiss these joinder motions as moot.

The applicable statute, 35 U.S.C. § 317(a), provides that an *inter partes* review proceeding “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.” In this case, the Board has not yet rendered decisions regarding whether trial will be instituted. Thus, the Board has not yet reached any decision on the merits of the proceeding. Termination at this early juncture promotes efficiency, conserves Board resources and minimizes unnecessary costs.

On December 14, 2015, the parties advised the Board that they have reached a settlement, and sought authorization to file a joint motion to terminate the proceeding. The Board authorized the filing of a joint motion to terminate this proceeding on December 15, 2015. Per the Board’s December 15, 2015 email, the parties understood that they were also to file separate papers requesting that the Settlement Agreement be treated as business confidential information as specified in 37 C.F.R. § 42.74(c) and that the Settlement Agreement was to be filed in PRPS under the designation of “Parties and Board Only.”

In view of the foregoing, the parties jointly and respectfully request that the instant proceeding be terminated and that motion for joinder with IPR2015-00722 be dismissed as moot.

Date: December 22, 2015

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing JOINT MOTION TO TERMINATE PROCEEDING PURSUANT TO 35 U.S.C. § 317 was served electronically via e-mail on December 22, 2015, in its entirety on the following:

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