

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA LLC

Petitioner,

v.

ADAPTIVE HEADLAMP TECHNOLOGIES, INC.,

Listed Patent Owner.

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

“Automatic Directional Control System for Vehicle Headlights”

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

Inter Partes Review No. 2016-00501

Pursuant to 35 U.S.C. § 317(a), Petitioner Mercedes-Benz USA (“MBUSA” or Petitioner) and Patent Owner Adaptive Headlamp Technologies, Inc. (“AHT” or Patent Owner) jointly request termination of IPR2016-00501, which is directed to U.S. Patent No. 7,241,034 (the “’034 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 a 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 a related district court action, case no. 1:15-cv-00075 (D. Del.). Petitioner and Patent owner understand that the ’034 patent has been asserted in other district court litigations where Petitioner is not a named party. In response to the *third* requirement, Petitioner and Patent Owner are aware of pending *inter partes* reexaminations of the ’034 Patent: IPR2016-00079; IPR2016-00193; and IPR2016-00196. In response to the *fourth* requirement, with respect to proceedings before the Patent Office, the pending *inter partes* reexaminations were requested by Koito Manufacturing Co., Ltd., SL Corporation, and BMW or North America, LLC. None of the pending *inter partes* reexaminations have been instituted. With respect to the district court litigation between Petitioner and Patent Owner, the parties intend to file a joint motion to dismiss.

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 '034 Patent. A true copy of the agreement is filed concurrently herewith. *See* Ex. 2001. The parties request that the settlement agreement be treated as business confidential information, and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). 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 32763-91, 32747-12, 32746-229, 32582-373, 29557-220, 24045-235, 22813-432, 20540-476, and 13729-559 regarding assignment of the '034 Patent from the inventors its initial assignee, Dana Corporation, and ultimately to Patent Owner. 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 '034 Patent.

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