

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UMICORE AG & CO. KG,

*Petitioner*

v.

BASF CORPORATION

*Patent Owner*

Case No. IPR2016-00613

U.S. Patent No. 9,039,982 to Patchett et al.

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

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Pursuant to 35 U.S.C. 317, 37 C.F.R. §§42.72 and 42.74, and the authorization provided by the Board on August 30, 2016, Petitioner Umicore AG & Co. KG (“Umicore” or “Petitioner”) and Patent Owner BASF Corp. (“BASF” or “Patent Owner”) jointly move to terminate this *inter partes* review proceeding in view of the parties’ settlement of their dispute relating to U.S. Patent No. 9,039,982 to Patchett et al. (“the ’982 patent”). The parties are filing, concurrently with the present motion, a true and complete copy of their written Settlement and License Agreement (“Settlement Agreement”) (Confidential Exhibit 1014). This Settlement Agreement completely settles the parties’ dispute relating to the ’982 patent.

The parties further jointly certify that there are no other agreements or understandings, oral or written, between Patent Owner and Petitioner, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding as set forth in 35 U.S.C. § 317(b).

The parties request that the Settlement Agreement be treated as business confidential information and kept separate from the file of this IPR. A joint request to treat the Settlement Agreement as business confidential information kept separate from the IPR file pursuant to 35 U.S.C. § 317(b) is being filed concurrently with this motion.

## **I. ARGUMENT**

A joint motion to terminate “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 No. 26, at \*2 (P.T.A.B. July 28, 2014). These factors are addressed in turn below.

### **A. Why Termination is Appropriate (Factor 1)**

Pursuant to 35 U.S.C. § 317(a), “[t]he Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Here, IPR has not yet been instituted, no cross examination has occurred, no hearings have been conducted, and Patent Owner BASF has not yet filed its formal response. Termination is justified in view of the early stage of this proceeding and the absence of any continuing dispute between the parties concerning the ’982 patent.

### **B. Identity and Status of Any Related Litigations (Factors 2 and 4)**

Petitioner and Patent Owner are not aware of any related litigations involving the ’982 patent.

**C. Identity and Status of Any Related Proceedings Currently Before the Office (Factors 3 and 4)**

In addition to the present IPR, Petitioner has also filed two additional IPR petitions addressing patents related to the '982 patent: (1) IPR2016-00610, involving U.S. Patent No. 8,899,023 (“the '023 patent”) and (2) IPR2016-00612, involving U.S. Patent No. 9,032,709 (“the '709 patent”). Petitioner and Patent Owner have also settled their disputes regarding the '023 and '709 patents, and along with this motion, have filed joint motions to terminate both the -00610 and -00612 proceedings.

The '023, '709, and '982 patents are also currently the subject of IPRs instituted in response to petitions filed by Johnson Matthey Inc. in Cases IPR2015-01265, -01266, and -01267. The Board held an oral hearing addressing the three cases on August 23, 2016. (*See, e.g.*, IPR2015-01265, Trial Hearing Order, Paper No. 30.) A final written decision has not yet issued. Umicore is not a party to the -01265, -01266, and -01267 cases. And, the settlement between Umicore and Patent Owner has no bearing on the -01265, -01266, and -01267 cases.

**II. CONCLUSION**

For the foregoing reasons, the parties jointly and respectfully request that the instant proceeding be terminated.

Respectfully submitted,

Dated: August 30, 2016

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