

Kevin Chu

From: Trials [<mailto:Trials@USPTO.GOV>]

Sent: Monday, December 19, 2016 11:54 AM

To: Marissa Ducca <marissaducca@quinnemanuel.com>; Trials <Trials@USPTO.GOV>

Cc: Alan Whitehurst <alanwhitehurst@quinnemanuel.com>; Robert Babayi <robert@vectoriplaw.com>; vg@hkw-law.com; perdiemipr@hkw-law.com

Subject: RE: IPR2016-01061, -01062, -01063, -01064, -01278 – Request to File Joint Motion to Terminate Petitioner Geotab Inc. Pursuant to Settlement with Patent Owner

Counsel,

Patent Owner, PerdiemCo LLC, and Petitioner, Geotab Inc., are authorized to file a joint motion to terminate IPRs 2016-01061, 1062, 1063, 1064, and 1278, as to Geotab only, due to settlement. The joint motion to terminate must be accompanied by a true copy of the parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), and include a statement certifying that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the IPR proceedings. A redacted version of the settlement agreement is not a true copy of the settlement agreement. In addition, the joint motion must discuss the current status of any related district court action in which infringement or invalidity of the claims of the patents at issue has been alleged or is contemplated in the foreseeable future.

PerDiem and Geotab are further authorized to file a request that the settlement agreement be treated as business confidential information under 37 C.F.R. § 42.74(c). In that regard, the parties must file the confidential settlement agreement electronically in accordance with the instructions provided on the Board's website (uploading as "Parties and Board Only" or "Filer and Board Only"). The parties are directed to FAQ G2 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for further instructions on filing the confidential settlement agreement.

Thanks,

Andrew Kellogg,
Supervisory Paralegal
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
Direct: 571-272-5366

From: Marissa Ducca [<mailto:marissaducca@quinnemanuel.com>]

Sent: Friday, December 16, 2016 2:11 PM

To: Trials <Trials@USPTO.GOV>

Cc: Alan Whitehurst <alanwhitehurst@quinnemanuel.com>; Robert Babayi <robert@vectoriplaw.com>; vg@hkw-law.com; perdiemipr@hkw-law.com

Subject: IPR2016-01061, -01062, -01063, -01064, -01278 – Request to File Joint Motion to Terminate Petitioner Geotab Inc. Pursuant to Settlement with Patent Owner

Dear Sir or Madam,

Pursuant to 37 CFR §42.20 and 35 U.S.C. § 317, Patent Owner PerdiemCo LLC ("Patent Owner") and Petitioner Geotab Inc. ("Geotab") jointly and respectfully request the Board's permission to file a Joint Motion to Terminate in each of the following proceedings with respect to Geotab only:

- IPR2016-01061 (U.S. Patent No. 8,223,012);
- IPR2016-01062 (U.S. Patent No. 8,493,207);
- IPR2016-01063 (U.S. Patent No. 8,717,166);
- IPR2016-01064 (U.S. Patent No. 9,003,499); and
- IPR2016-01278 (U.S. Patent No. 9,071,931).

The termination with respect to Geotab is pursuant to a Settlement Agreement in which the parties have agreed to end their disputes in their district court litigation and the aforementioned proceedings. The parties also request permission to file a copy of the fully executed Agreement, as well as a Joint Request that the Settlement Agreement Be Treated as Business Confidential Information pursuant to the procedures set forth in 37 CFR §42.74(c) and 35 USC §317(b). The aforementioned proceedings will still include active petitioners, namely TV Management, Inc. d/b/a GPS North America.

Best regards,
Marissa

Marissa Ducca

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