

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GEOTAB INC. AND  
TV MANAGEMENT, INC., D/B/A GPS NORTH AMERICA  
Petitioners

v.

PERDIEMCO LLC  
Patent Owner

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Case IPR2016-01063  
U.S. Patent No. 8,717,166

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**JOINT MOTION TO TERMINATE THE PROCEEDINGS WITH  
RESPECT TO GEOTAB INC. ONLY, UNDER 35 U.S.C. § 317(a)**

As authorized in the Patent Trial and Appeal Board's (the "Board")

December 19, 2016 e-mail (Ex. 2009), and pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Patent Owner PerdiemCo LLC ("Patent Owner") and Petitioner Geotab Inc. ("Geotab") jointly and respectfully request that the *inter partes* review ("IPR") of U.S. Patent No. 8,717,166 be terminated with respect to Geotab only, due to settlement between Patent Owner and Geotab.

**1. Brief Explanation As To Why Termination Is Appropriate**

On May 19, 2016, Geotab, along with separate parties Teletrac Inc. and Navman Wireless North America, Ltd. (collectively, "Teletrac") and TV Management, Inc. d/b/a GPS North America filed the instant IPR (Paper No. 5). On June 7, 2016, the Board issued a Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper No. 6). Patent Owner filed a response on September 7, 2016. On December 12, 2016, Patent Owner and Geotab settled their dispute and executed a confidential settlement agreement to terminate Geotab's involvement in this proceeding and the Parties' related district court litigation. A Stipulation and Order of Dismissal agreed to by the Parties in the related district court litigation has been filed in the district court.

Pursuant to 37 C.F.R. § 42.74(b), the Parties' confidential settlement agreement is in writing, and a true and correct copy is being filed concurrently

herewith as Exhibit 2010.<sup>1</sup> The Parties are also filing concurrently herewith a joint request to treat the confidential settlement agreement as business confidential information and keep it separate from the files of the IPR and the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The Parties hereby certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the IPR proceedings.

Termination of this proceeding with respect to Geotab is proper under 35 U.S.C. § 317(a) because the Board has not yet decided the merits of this proceeding. This proceeding will continue with respect to the remaining Petitioner. Accordingly, Patent Owner and Geotab respectfully request that the Board terminate the *inter partes* review of U.S. Patent No. 8,717,166 with respect to Geotab only, due to settlement between Patent Owner and Geotab.

## **2. Related Litigations Involving The Patent At Issue**

There are no ongoing related litigations involving the patent at issue in this proceeding.

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<sup>1</sup> The settlement agreement is being filed electronically via PTAB E2E with access to the “Board Only.” The settlement contains both Patent Owner’s and Geotab’s business confidential information, which cannot be made available to any of the other Petitioners remaining in this proceeding.

**3. Related Proceedings Currently Before The Office**

There are no related proceedings currently before the Office involving the patent at issue and Geotab. This proceeding will continue with respect to the remaining Petitioner. Patent Owner and Geotab are likewise concurrently filing similar motions to terminate with respect to Case Nos. IPR2016-01061 (U.S. Patent No. 8,223,012); IPR2016-01062 (U.S. Patent No. 8,493,207); IPR2016-01064 (U.S. Patent No. 9,003,499); and IPR2016-01278 (U.S. Patent No. 9,071,931).

**4. Current Status Of The Related Litigations**

The previously noticed litigations against all other defendants have settled.

For the foregoing reasons, the Parties jointly and respectfully request termination of the present proceeding with respect to Geotab.

Joint Motion to Terminate

Case IPR2016-01063  
U.S. Patent No. 8,717,166

Date: December 20, 2016

Respectfully submitted,

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