

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR COMPANY, HYUNDAI MOTOR AMERICA,
HYUNDAI MOTOR MANUFACTURING ALABAMA, LLC,
KIA MOTORS CORPORATION, KIA MOTORS AMERICA, INC., and
KIA MOTORS MANUFACTURING GEORGIA, INC.,
Petitioner,

v.

BLITZSAFE TEXAS, LLC,
Patent Owner.

Case IPR2016-01476, Patent 8,155,342 B2
Case IPR2016-01477, Patent 7,489,786 B2

Before JAMESON LEE, MIRIAM L. QUINN, and
KERRY BEGLEY, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

ORDER

Denying Request for Permission to File a Joint Motion to Terminate and a
Joint Motion to File a Settlement Agreement as Business Confidential
Information

35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74(b)

IPR2016-01476, Patent 8,155,342 B2
IPR2016-01477, Patent 7,489,786 B2

On January 31, 2017, the Board received an email from counsel for Petitioner Hyundai Motor Company, Hyundai Motor America, Hyundai Motor Manufacturing Alabama, LLC, Kia Motors Corporation, Kia Motors America, Inc., and Kia Motors Manufacturing Georgia, Inc. (collectively, “Petitioner”) indicating that they have agreed to settle their dispute with Patent Owner Blitzsafe Texas, LLC. IPR2016-01476, Ex. 3003; IPR2016-01477, Ex. 3002. Petitioner requested permission to file a joint motion to terminate IPR2016-01476 and IPR2016-01477, and to file the settlement agreement, after it is executed, as business confidential information. IPR2016-01476, Ex. 3003; IPR2016-01477, Ex. 3002.

Petitioner’s request for permission to file a joint motion to terminate and joint motion to file the settlement agreement as business confidential information is denied as unnecessary and moot. In each case, the Petition was denied and no *inter partes* review was instituted. IPR2016-01476, Paper 12; IPR2016-01477, Paper 13. Accordingly, there is no “trial” or “inter partes review instituted” to be terminated under 37 C.F.R. § 42.72 or 35 U.S.C. § 317(a). There also is no “preliminary proceeding” to be terminated, because we denied institution of trial in each case. Moreover, 37 C.F.R. § 42.74(b)’s requirement that any agreement or understanding “made in connection with, or in contemplation of, the termination of a *proceeding*” does not apply to IPR2016-01476 and IPR2016-01477. 37 C.F.R. § 42.74(b) (emphasis added); *see* 35 U.S.C. § 317(b). Specifically, in light of the denial of institution of *inter partes* review in each case, neither case in its present posture qualifies as a “proceeding,” i.e., “a trial or a preliminary proceeding,” as defined in 37 C.F.R. § 42.2. 37 C.F.R. § 42.2 (defining “preliminary proceeding,” “proceeding,” and “trial”).

IPR2016-01476, Patent 8,155,342 B2
IPR2016-01477, Patent 7,489,786 B2

ORDER

Accordingly, it is:

ORDERED that Petitioner's request for permission to file a joint motion to terminate and joint motion to file the settlement agreement as business confidential information is *denied*.

IPR2016-01476, Patent 8,155,342 B2
IPR2016-01477, Patent 7,489,786 B2

PETITIONER:

Paul R. Steadman
Matthew D. Satchwell
Gianni Minutoli
Nicholas Panno
DLA PIPER LLP
paul.steadman@dlapiper.com
matthew.satchwell@dlapiper.com
gianni.minutoli@dlapiper.com
nicholas.panno@dlapiper.com

PATENT OWNER:

Peter Lambrianakos
Sharhar Harel
Vincent J. Rubino, III
BROWN RUDNICK LLP
plambrianakos@brownrudnick.com
sharel@brownrudnick.com
vrubino@brownrudnick.com