

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HYUNDAI MOTOR AMERICA, INC.
Petitioner

v.

CLEAR WITH COMPUTERS, LLC
Patent Owner,

Case IPR2013-00104
&
Case IPR2013-00176

Patent 8,121,904

Before, HOWARD B. BLANKENSHIP, BRIAN J. McNAMARA and,
TRENTON A. WARD, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER TO CLARIFY MOTION TO TERMINATE

Conduct of the Proceedings
37C.F.R. § 42.05

On June 18, 2013 and June 25, 2013 the Board held teleconferences with Hyundai Motor America, Inc. (Petitioner) and Clear With Computers, LLC (Patent Owner), collectively the Parties, to discuss their desire to withdraw IPR2013-00104 and IPR2013-00176 (the IPR proceedings), both of which involve US Patent 8,121,904 (the '904 Patent). During the teleconferences, the Parties explained that an underlying district court litigation *Clear With Computers, LLC v. Hyundai Motor America, Inc.*, Case No. 6:12-CV-00077-LED (E.D. Tex.) (the Litigation) had been dismissed with prejudice and that, although other defendants remained in the case, no other defendant was accused of infringing the '904 Patent. The Board advised the Parties that there is no provision for withdrawal of a petition for *inter partes* review, but that the Parties were authorized to move to terminate both IPR proceedings. The Board reminded the Parties of the requirements of 35 U.S.C. § 317 for terminating an *inter partes* review.

On June 28, 2013, the Parties filed a Joint Motion To Terminate Proceedings under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b) (Motion To Terminate). The parties' Motion to Terminate states that "[t]he parties have settled their dispute, and have reached agreement to terminate these *inter partes* reviews. A copy of the Agreement reflecting this agreement is attached hereto as Exhibit A." The Agreement attached as Exhibit A states that whereas the Parties have agreed to resolve the Litigation and the *inter partes* reviews and whereas Patent Owner has

filed an unopposed motion to dismiss with prejudice all claims against Petitioner for infringement of the '904 Patent, the Parties agree that they shall jointly move for termination of the IPR Proceedings. The Agreement is dated June 28, 2013.

35 U.S.C. § 317(a) authorizes the Office to terminate an *inter partes* review with respect to a petitioner and provides that, if no petitioner remains, the Office may terminate the review or proceed to a final written decision. 35 U.S.C.

§ 317(b) requires that any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with or in contemplation of, the termination of an *inter partes* review shall be in writing. 35 U.S.C. § 317 (b) further requires that a true copy of such agreement or understanding shall be filed in the Office before the termination of the *inter partes* review as between the parties.

The Agreement filed as Exhibit A to the Motion To Terminate has no terms other than an agreement to move to terminate the IPR proceedings. The Motion To Terminate, however, states that the Parties have settled their dispute. Although the reference to settlement of a dispute in the Motion To Terminate suggests that the Parties have reached some principles of agreement, there are no such agreements mentioned in Exhibit A.

In view of the circumstances, it is **ORDERED** that the Parties certify in writing 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 sue, confidentiality agreements, or other agreements of any kind, that are made in connection with, or in contemplation of, the termination of the IPR Proceedings.

It is **FURTHER ORDERED** that if any such agreements or understandings have been reached, the Parties commit them to writing and file them with the Office. 35 U.S.C. § 317(b). The Parties are authorized to file such agreements with a request that they be treated as business confidential information under 37 C.F.R. § 42.74(c).

It is **FURTHER ORDERED** that Patent Owner also certify that there are no other patent infringement suits involving the '904 Patent at this time.

The Parties are also reminded of the Duty of Candor that applies in proceedings before the Office. 37 C.F.R. § 42.11.

Case IPR2013-00104, IPR2013-00176
Patent 8,121,904

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