

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 IPR 2013-00176

Patent 8,121,904

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

McNAMARA, *Administrative Patent Judge*.

JUDGMENT
TERMINATION OF THE PROCEEDINGS

37C.F.R. § 42.73

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) in IPR2013-00104 and IPR2013-00176 (the IPR Proceedings). The parties' Motion to Terminate stated that "[t]he parties have settled their dispute and have reached agreement to terminate these *inter partes* reviews. A true copy of the Agreement reflecting this agreement is attached hereto as Exhibit A." Motion to Terminate 1-2. The Agreement, dated June 28, 2013 and attached as Exhibit A to the Motion to Terminate, stated that whereas the Parties have agreed to resolve an underlying 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.

Although the Agreement filed as Exhibit A to the Motion to Terminate stated that the Parties had settled their dispute, the Agreement had no terms other than an agreement to move to terminate the IPR proceedings. On July 3, 2013, the Board ordered the Parties to 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. 35 U.S.C. § 317(b).

The Board also required that Patent Owner certify that there are no other patent infringement suits involving the '904 Patent at this time.

In a teleconference with the Board on July 11, 2013, the Parties represented that, although there may be other ongoing disputes between them, there were no other agreements or payments made in consideration of the termination of the IPR Proceedings or the dismissal of the underlying litigation involving the '904 patent. The Parties also submitted the written certification required in the Board's order of July 3, 2013. The Patent Owner further stated in the written certification that there are no pending patent infringement suits involving the '904 patent.

In view of the Parties' certification that the IPR Proceedings are settled and that there are no collateral agreements of any kind, and the Patent Owner's certification that there are no pending infringement suits involving U.S. Patent 8,212,904, the Board determines that it is appropriate to enter judgment¹ without rendering a final written decision.

In view of the foregoing,

It is **ORDERED** that the Parties' Motion to Terminate IPR2013-00104 and IPR2013-00176 is GRANTED and the IPR Proceedings are terminated.

¹ A judgment means a final written decision of the Board or a termination of a Proceeding. 37 C.F.R. § 42.2

Case IPR 2013-00104, IPR 2013-00176
Patent 8,121,904

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