

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESLA, INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

IPR2025-00638
Patent 8,898,395 B1

Before HYUN J. JUNG, CARL M. DEFRANCO, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

MEYERS, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
37 C.F.R. § 42.71(a)

With our authorization, the parties filed a joint motion to dismiss the Petition and terminate the instant proceeding on the basis that “[t]he Parties have fully and permanently resolved their dispute with regard to U.S. Patent No. 8,898,395 [(Ex. 1001, “the ’395 patent”)], the patent at issue in this IPR

proceeding,” and that “all claims related to the ’395 patent in the parallel proceeding have been dismissed *with prejudice*.” See Paper 6 (“Joint Mot.”), 1; *see also* Ex. 1029 (district court order granting the parties’ joint motion to dismiss claims and counterclaims with prejudice). Other than the district court order, the parties state that “there is no settlement agreement or collateral agreement between the Parties with respect to the ’395 patent.”

Joint Mot. 4. More particularly, the Parties

confirm that, beyond their joint agreement to file this motion and move in the parallel proceeding to dismiss *with prejudice* the Parties’ claims with respect to the ’395 patent, there are no other agreements between the Parties, written or oral, between the Parties made in connection with, or in contemplation of, the dismissal of the Petition and termination of this proceeding.

Id.

A decision on whether to institute a trial has not been made yet in this proceeding. In the joint motion to dismiss and terminate, the parties represent that “there is no longer any dispute—and will never be—between the Parties with respect to the ’395 patent,” and “[g]ood cause . . . exists to dismiss the Petition and to terminate this IPR proceeding.” Joint Mot. 2. Under these circumstances, we determine that it is appropriate to terminate the instant proceeding without rendering any further decisions.

In consideration of the foregoing, it is hereby:

ORDERED that the parties’ joint motion to dismiss the Petition and terminate the instant proceeding is *granted* and the proceeding is hereby *terminated*.

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