UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,

MERCEDES-BENZ USA, LLC,

Petitioner

v.

MICHIGAN MOTOR TECHNOLOGIES, LLC,

Patent Owner

Case IPR2023-01031
U.S. Patent No. 8,909,482

CO-PETITIONER MERCEDES-BENZ USA, LLC AND PATENT OWNER MICHIGAN MOTOR TECHNOLOGIES, LLC'S JOINT MOTION TO TERMINATE AS TO MERCEDES-BENZ USA, LLC

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.5(a), 42.71(a), and 42.72, and the Board's authorization received on October 30, 2023, Co-Petitioner Mercedes-Benz USA, LLC ("Mercedes") and Patent Owner Michigan Motor Technologies, LLC ("Patent Owner") jointly move to withdraw and terminate IPR2023-01031 as to Mercedes.

Mercedes notes, as set forth below, that this termination request is only between Patent Owner and Petitioner Mercedes, and does not include Co-Petitioner BMW of North America, LLC ("BMW"). Moreover, as set forth in the Joint Request to Maintain Confidentiality, the settlement agreement is confidential between Mercedes and Patent Owner. That confidentiality agreement likewise does not include Petitioner BMW, and Mercedes has filed that confidentiality agreement so that it is only viewable by the Board.

I. LEGAL STANDARD

35 U.S.C. § 317(a) provides that "[a]n inter partes review instituted under this chapter shall be terminated with respect to ***any petitioner*** upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." 37 C.F.R. § 42.72 also provides that "[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including … pursuant to a joint request under 35 U.S.C. 317(a)." Finally, the Consolidated Trial Practice Guide states that "[a] petitioner

and a patent owner may terminate the proceeding ***with respect to the petitioner*** by filing a written agreement with the Board, unless the Board has already decided the merits of the proceeding before the request for termination is filed." Patent Trial and Appeal Board Consolidated Trial Practice Guide, Nov. 19 at 4. Thus, Congressional statute and the Board's Trial Practice Guide allow the Board to terminate a Petition with respect to a single Co-Petitioner.

II. FACTUAL BACKGROUND

Patent Owner commenced litigation against Mercedes asserting U.S. Patent No. 8,909,482 (the "'482 patent") in *Michigan Motor Technologies, LLC v. Mercedes-Benz USA, LLC*, No. 22-cv-03957 (N.D. Ill.). On June 6, 2023, Mercedes and Co-Petitioner BMW of North America, LLC ("BMW") filed a Petition requesting *inter partes* review of the '482 patent. *See* Paper 2. The Board has not yet issued an institution decision.

Patent Owner and Mercedes (but ***not*** BMW) have agreed to settle their disputes and have reached a written agreement (the "Settlement Agreement") to terminate this IPR proceeding, subject to the Board's approval. Mercedes is filing, confidentially, a true and correct copy of the Settlement Agreement contemporaneously herewith as Exhibit 1050. There are no collateral agreements or understandings in connection with, or in contemplation of, the termination of this proceeding. Mercedes is also filing a joint request that the Settlement Agreement be

treated as business confidential information and be kept separate from the file of the '482 patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). It is understood that the Settlement Agreement as filed shall be available only pursuant to a Government agency on written request to the Board or as otherwise specified in 37 C.F.R. § 42.74(c). Mercedes and Patent Owner represent that they have complied with all requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

III. ARGUMENT

Dismissal of the Petition as to Mercedes is appropriate here because Mercedes and Patent Owner jointly request dismissal, and the proceeding is at an early stage. The Board has not yet issued any institution decision. Terminating the IPR "at this early juncture, promotes efficiency and minimizes unnecessary costs." *Sony Corp. v. Straight Path IP Group Inc.*, IPR2014-00230, Paper 13, at 3 (PTAB May 2, 2013). Efficiency and the interest of justice are best served because dismissal will reduce the parties' expenses and conserve the Board's resources, which promotes judicial economy and furthers the policy of the Board. *See, e.g.,* Patent Trial and Appeal Board Consolidated Trial Practice Guide, Nov. 19 at 86.

IV. CONCLUSION

For the reasons discussed above, Mercedes and Patent Owner respectfully request that the Board grant this joint motion to terminate this proceeding as to Mercedes.

Date: November 2, 2023

/s/ James M. Glass

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that on November 2, 2023 the foregoing paper from Co-Petitioner Mercedes was served via email on the following counsel of record for Patent Owner and Co-Petitioner BMW:

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