

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MERCEDES-BENZ USA, LLC,
Petitioner,

v.

MICHIGAN MOTOR TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-01113
Patent 6,561,166 B2

Before JAMES P. CALVE, NEIL T. POWELL, and
SCOTT B. HOWARD, *Administrative Patent Judges*.

CALVE, *Administrative Patent Judge*.

TERMINATION

Due to Settlement Before Institution of Trial
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

I. INTRODUCTION

In an email dated October 30, 2023, we authorized the parties to file a joint motion to terminate the instant proceeding, a copy of their settlement agreement, and a joint request to treat the filed copy of their settlement agreement as business confidential information under 35 U.S.C. § 317(b).

On November 2, 2023, the parties filed a Joint Motion to Terminate (“Joint Motion,” Paper 7), a copy of a written Settlement and Patent License Agreement (“Settlement Agreement,” Ex. 1050), and a Joint Request to Maintain Confidentiality Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (“Joint Request,” Paper 8).

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[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 the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

In the Joint Motion, the Parties indicate that they have settled their disputes regarding U.S. Patent No. 6,561,166 (“the ’166 patent”), and the filed copy of their Settlement Agreement is a true and correct copy with no other collateral agreements or understandings made in connection with, or contemplation of, the termination of this proceeding. Joint Motion 3. The parties assert that termination of the proceeding at this early stage promotes efficiency and minimizes unnecessary costs. *Id.* The parties also contend that efficiency and the interest of justice are served best because dismissal will reduce the parties’ expenses and conserve the Board’s resources, which promotes judicial economy and furthers the policy of the Board. *Id.* at 4.

Generally, a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the 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 (“The 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)”); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“Consolidated Guide”) at 86, available at <https://www.uspto.gov/TrialPracticeGuide> Consolidated (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” (citing 35 U.S.C. §§ 317(a), 327)). Here, a trial has not been instituted, and the merits of this proceeding have not been decided. Accordingly, we are persuaded that, under these circumstances, termination of this proceeding is appropriate.

The parties filed a Joint Request to treat the Settlement Agreement as business confidential information, keep it separate from the file of the ’166 patent in this proceeding, and make it available only to authorized parties. Joint Request 2. After reviewing the Settlement Agreement, we find that it contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the parties' Joint Motion is *granted*, and IPR2023-01113 is *terminated* with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that the parties' Joint Request is *granted*, and the Settlement Agreement shall be treated as business confidential information and shall be kept separate from the files of the above-referenced patents and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2023-01113
Patent 6,561,166 B2

PETITIONER:

James Glass
QUINN EMANUEL URQUHART & SULLIVAN, LLP
jimglass@quinnemanuel.com

PATENT OWNER:

Timothy Devlin
Jason Wejnert
DEVLIN LAW FIRM LLC
tdevlin@devlinlawfirm.com
Jason.wejnert@dinsmore.com