

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERCEDES-BENZ USA, LLC, and  
BMW OF NORTH AMERICA, LLC,  
Petitioner,

v.

MICHIGAN MOTOR TECHNOLOGIES, LLC,  
Patent Owner.

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IPR2023-01224  
Patent 6,557,540 B1

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Before JAMES A. TARTAL, BARBARA A. PARVIS, and  
SCOTT B. HOWARD, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER  
Settlement Prior to Institution of Trial  
as to Mercedes-Benz USA, LLC  
*37 C.F.R. § 42.74*

Patent Owner Michigan Motor Technologies, LLC (“Patent Owner”) and Petitioner Mercedes-Benz USA, LLC (“Mercedes-Benz”) filed a “Joint Motion to Terminate as to Mercedes-Benz USA, LLC” (Paper 7 (“Motion”)) and a “Joint Request to Maintain Confidentiality Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74” (Paper 8 (“Joint Request”)) in this proceeding. Patent Owner and Mercedes-Benz represent that they have reached settlement as evidenced by the written “Settlement and Patent License Agreement” (Ex. 1050 (“Agreement”)), filing a true copy of the same as required under 37 C.F.R. § 42.74(b). Motion 3. For the reasons discussed below, the Motion and Joint Request are *granted*.

In the Motion, Mercedes-Benz and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceeding as to Mercedes-Benz, and that the filed copy of the Agreement is a true and complete copy. Motion 3. Mercedes-Benz and Patent Owner further represent that “[t]here are no collateral agreements or understandings in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

This proceeding is at an early stage, and we have not yet decided whether to institute a trial. In view of the early stage of the proceeding and the settlement between Patent Owner and Mercedes-Benz, we determine that good cause exists to dismiss the petition for *inter partes* review and terminate the proceeding with respect to Mercedes-Benz. BMW of North America, LLC will remain as Petitioner in this proceeding.

After reviewing the Agreement between Patent Owner and Mercedes-Benz, we find that the Agreement contains confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the Agreement as business confidential information and

keep it separate from the file of U.S. Patent No. 6,557,540 B1. *See* 37 C.F.R. § 42.74(c).

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate with respect to Mercedes-Benz USA, LLC is *granted*;

FURTHER ORDERED that the petition is *dismissed* with respect to Mercedes-Benz USA, LLC;

FURTHER ORDERED that BMW of North America, LLC will remain as Petitioner in this proceeding, and the case will continue to proceed;

FURTHER ORDERED that the Joint Request to Maintain Confidentiality is *granted*, and the Agreement (Ex. 1050) shall be kept separate from the file of U.S. Patent No. 6,557,540 B1, 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); and

FURTHER ORDERED that the caption of this case is modified as sets forth in the Appendix and the remaining parties are directed to use this caption in all further filings.

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Appendix - Sample Case Caption

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