

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

MICHIGAN MOTOR TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-01224
Patent 6,557,540 B1

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

TARTAL, *Administrative Patent Judge*.

TERMINATION

Granting Joint Motion to Terminate
Due to Settlement After Institution of Trial
Dismissing Patent Owner's Prior Motion to Terminate
35 U.S.C. §317; 37 C.F.R. §§ 42.5(a), 42.74

Patent Owner Michigan Motor Technologies, LLC (“Patent Owner”) and Petitioner BMW of North America, LLC (“Petitioner”) filed a Joint Motion to Terminate *Inter Partes* Review (Paper 22 (“Joint Motion to Terminate” or “JMT”)) and a Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 23 (“Joint Motion to Keep Confidential and Separate”)) in this proceeding. For the reasons discussed below, the Joint Motion to Terminate and the Joint Motion to Keep Confidential and Separate are *granted*.

We instituted this proceeding on February 15, 2024 (Paper 15) and we have not reached a final written determination as to the patentability of any challenged claim. In the Joint Motion to Terminate, the Parties state that they have agreed to jointly seek termination of this *inter partes* review proceeding, and that they have filed a true and accurate copy of their “Settlement and Patent License Agreement” (Ex. 1051 (“Agreement”)), as required under 37 C.F.R. § 42.74(b), as an exhibit. JMT 3; Ex. 1051. The Parties further state that the Agreement “represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding.” JMT 3.

The Parties also explain that the related district court case concerning the same patent at issue here was dismissed pursuant to Patent Owner’s Notice of Voluntary Dismissal filed in district court. JMT 4–5. Additionally, prior to filing the Joint Motion to Terminate, Patent Owner informed the Board that it has “disclaimed all of the challenged claims” in this proceeding. Paper 21 (citing Ex. 2005 (the “Disclaimer”).

In view of the stage of this proceeding, the settlement between Patent Owner and Petitioner, and the Disclaimer, we determine that good cause

exists to terminate this *inter partes* review proceeding. We, therefore, *grant* the Joint Motion to Terminate.¹

Further, after reviewing the Agreement between the Parties, 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). Accordingly, we *grant* the Joint Motion to Keep Confidential and Separate.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Terminate (Paper 22) is *granted*;

FURTHER ORDERED, that Patent Owner's Motion to Terminate (Paper 21) is *dismissed*;

FURTHER ORDERED, that this proceeding is *terminated*; and,

FURTHER ORDERED that the Joint Motion to Keep Confidential and Separate (Paper 23) is *granted*, and the Agreement (Ex. 1051) 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).

¹ Patent Owner informed the Board of its Disclaimer in conjunction with an earlier motion to terminate filed by Patent Owner (Paper 21), which we dismiss as moot in light of our determination here to grant the Joint Motion to Terminate (Paper 22).

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FOR PETITIONER:

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

Matthew Middleton
DLA PIPE LLP (US)
Matthew.middleton@us.dlapiper.com

FOR PATENT OWNER

Timothy Devlin
Jason Wejnert
DEVLIN LAW FIRM LLC
TD-PTAB@devlinlawfirm.com