Trials@uspto.gov
Tel: 571-272-7822

Paper: 9
Date: November 16, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MICHIGAN MOTOR TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-01031 (Patent 8,909,482 B2)
IPR2023-01032 (Patent 6,581,565 B2)
IPR2023-01233 (Patent 6,581,574 B1)
IPR2023-01234 (Patent 6,588,260 B1)[1]

Before JAMES P. CALVE, NEIL T. POWELL, BARBARA A. PARVIS, MICHAEL L. WOODS, SCOTT B. HOWARD, and STEPHEN E. BELISLE, *Administrative Patent Judges*.[2]

PER CURIAM.

ORDER
Settlement as to Mercedes-Benz USA, LLC
37 C.F.R. § 42.74

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[1] This Order applies to each of the identified proceedings. The parties are not authorized to use this style heading for any subsequent papers.
[2] This is not an expanded panel of the Board, but instead represents all of the judges paneled in the identified proceedings.

I. INTRODUCTION

With the Board's authorization, Petitioner Mercedes-Benz USA, LLC ("Mercedes-Benz") and Michigan Motor Technologies, LLC ("Patent Owner") filed Joint Motions to Terminate as to Mercedes-Benz in the above captioned proceedings. Paper 8 ("Joint Motions").[3] In support of the Joint Motions, Mercedes-Benz and Patent Owner filed copies of a Settlement and Patent License Agreement (Ex. 1050 ("Settlement Agreement")), as well as Joint Requests to Maintain Confidentiality Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (Paper 9 ("Joint Requests")).

II. DISCUSSION

In the Joint Motions, Mercedes-Benz and Patent Owner represent that they have reached an agreement to jointly seek termination of the above captioned *inter partes* review proceedings as to Mercedes-Benz, and that the filed copies of the Settlement Agreement are true and correct copies. Paper 8, 2–3. Mercedes-Benz and Patent Owner further represent that their Settlement Agreement resolves the disputes between Mercedes-Benz and Patent Owner involving the above captioned patents at issue. *Id.* at 3. Additionally, Mercedes-Benz and Patent Owner represent that "[t]here are no collateral agreements or understandings in connection with, or in contemplation of, the termination of th[ese] proceeding[s]." *Id.*

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[3] IPR2023-01031, IPR2023-01032, IPR2023-01233, and IPR2023-01234 include similar papers and exhibits. Unless otherwise noted, all citations are to papers and exhibits in IPR2023-01031 as representative. This Order applies equally to all captioned proceedings.

These proceedings are at an early stage, and we have not yet decided whether to institute a trial in the proceedings. In view of the early stage of the proceedings and the settlement between Mercedes-Benz and Patent Owner, we agree with Mercedes-Benz and Patent Owner and determine that good cause exists to terminate the proceedings with respect to Mercedes-Benz. *See* Paper 8, 4.

Mercedes-Benz and Patent Owner also filed Joint Requests that the Settlement Agreement be treated as business confidential information, including as to Petitioner BMW of North America, LLC, and be kept separate from the file of the patents involved in these *inter partes* proceedings. Paper 9. After reviewing the Settlement Agreement between Mercedes-Benz and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Mercedes-Benz and Patent Owner as business confidential information pursuant to 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 Joint Motions to Terminate as to Mercedes-Benz USA, LLC are *granted*, and each of IPR2023-01031, IPR2023-01032, IPR2023-01233, and IPR2023-01234 are *terminated* with respect to Mercedes-Benz USA, LLC;

IPR2023-01031 (Patent 8,909,482 B2)
IPR2023-01032 (Patent 6,581,565 B2)
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IPR2023-01234 (Patent 6,588,260 B1)

FURTHER ORDERED that BMW of North America, LLC will remain as Petitioner in each of these proceedings, and each of the above captioned cases will continue to proceed;

FURTHER ORDERED that, in each of IPR2023-01031, IPR2023-01032, IPR2023-01233, and IPR2023-01234, the Joint Request to Maintain Confidentiality Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 is *granted*, and the Settlement Agreement shall remain designated as "Board only" in the Board's filing system, shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause, and shall be kept separate from the files of Patent Nos. 8,909,482 B2, 6,581,565 B2, 6,581,574 B1, and 6,588,260 B1 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that, in each of these proceedings, the caption of the case is modified to eliminate the reference to "MERCEDES-BENZ USA, LLC" as set forth in the attached Exhibit which is an example for IPR2023-01031. The remaining parties are directed to use this caption in all further filings.

EXHIBIT: Sample Case Caption

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IPR2023-01031
Patent 8,909,482 B2

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FOR PETITIONER:

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

Edward Sikorski
Matthew Middleton
DLA Piper LLP (US)
ed.sikorski@us.dlapiper.com
matthew.middleton@us.dlapiper.com

FOR PATENT OWNER:

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