

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

IPR2023-01234
U.S. PATENT NO. 6,588,260

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF
U.S. PATENT NO. 6,588,260 UNDER 37 C.F.R. § 42.72**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71(a) Petitioner BMW of North America, LLC and Patent Owner Michigan Motor Technologies, LLC jointly request termination of the *Inter Partes* Review of U.S. Patent No. 6,588,260 (the “’260 Patent”) in IPR2023-01234. On June 19, 2024, the Parties informed the Board of a settlement agreement between Petitioner and Patent Owner via email and requested authorization to file a Joint Motion to Terminate the proceeding with respect to both the Patent Owner and Petitioner. On June 20, 2024, the Board authorized the parties to file this Joint Motion to Terminate. The parties have reviewed 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 and believe they are in compliance with these requirements.

Additionally, the Board previously authorized Petitioner to file a response to Patent Owner’s separate motion to terminate (Paper 20). Due to the parties’ settlement agreement and this Joint Motion to Terminate, Petitioner believes its prior request to file a response to Patent Owner’s motion (Paper 20) is now moot. As such, Petitioner will not file a response as to not file unnecessary papers with the Board.

Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

II. ARGUMENT

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

A. Brief Explanation as to Why Termination Is Appropriate

Petitioner and Patent Owner have entered into a written confidential settlement agreement that fully resolves this matter. The Parties are concurrently filing a copy of the settlement agreement as Exhibit 1051 along with a request to treat it as business confidential information pursuant to 35 U.S.C. § 317(b). Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 1051 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1051 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

The Parties “may terminate the proceeding...unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, at 4 (November 2019). The Board has not yet decided the merits of the proceeding, and the Parties have now settled their dispute and have reached agreement to terminate the Petition.

Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Office Patent Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

The ’260 Patent is subject to the following action: *Michigan Motor Technologies, LLC v. Bayerische Motoren Werke AG et al.*, Case No. 1:22-cv-

03804 (N.D. Ill.), which was dismissed on March 26, 2024 pursuant to Patent Owner's Notice of Voluntary Dismissal.

C. Identification and Status of Related Proceedings Before the USPTO

Petitioner has not filed any further Petition for *Inter Partes* Review related to the '260 Patent.

Dated: June 20, 2024

Respectfully Submitted,

/Matthew S. Middleton/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.105, I hereby certify that I caused a true and correct copy of this **JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 6,588,260 UNDER 37 C.F.R. § 42.72** in connection with IPR2023-01233 to be served via e-mail on June 20, 2024, in its entirety on the following counsel of record for Patent Owner:

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Dated: June 20, 2024

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