

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.

IPR2023-01233 (Patent 6,581,574 B1)
IPR2023-01234 (Patent 6,588,260 B1)¹

Before NEIL T. POWELL, BARBARA A. PARVIS, MICHAEL L.
WOODS, and STEPHENE. BELISLE, *Administrative Patent Judges*.²

BELISLE, *Administrative Patent Judge*.

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

¹ This Order addresses issues that are the same in both of the above-listed proceedings. We exercise our discretion to issue one Order to be filed in each proceeding. The parties are not authorized to use this style heading in subsequent papers.

² This is not an Order from an expanded panel of the Board. Rather, we exercise our discretion to issue one Order for both of the above-listed proceedings.

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IPR2023-01234 (Patent 6,588,260 B1)

BMW of North America, LLC (“Petitioner”) and Michigan Motor Technologies LLC (“Patent Owner”) filed in both of the above-listed proceedings a Joint Motion to Terminate *Inter Partes* Review (Paper 21³ (“Motion(s)”) 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 22 (“Request(s)”⁴)). Petitioner and Patent Owner represent that they have reached settlement as evidenced by their written “settlement agreement” (Ex. 1051 (“Agreement(s)”), filing a true copy of the same as required under 37 C.F.R. § 42.74(b). Motion 2. For the reasons discussed below, the Motions and Requests are *granted*.

In the Motions, Petitioner and Patent Owner represent that they have reached an agreement to jointly seek termination of the above-identified *inter partes* review proceedings, and that the filed copies of the Agreements are true and accurate copies. Motion 2. Petitioner and Patent Owner further represent that each Agreement “represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

We instituted *inter partes* review in IPR2023-01233 on February 9, 2024 (Paper 11) and in IPR2023-01234 on January 26, 2024 (Paper 11), and have not yet reached a final written determination as to the patentability of any challenged claim in either case. Additionally, prior to filing the Motions, Patent Owner informed the Board that it has “disclaimed all of the

³ Paper and exhibit numbers refer to IPR2023-01234 unless otherwise noted. Corresponding papers and exhibits were filed in IPR2023-01233.

⁴ We treat the parties’ “Joint Motion to Keep Confidential and Separate” as the “request” set forth in Rule 42.74(c) (“Request to keep separate”).

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challenged claims” in both proceedings.⁵ Paper 20 (citing Ex. 2005⁶).

Petitioner and Patent Owner further explain that the related district court case concerning the same patents at issue here was dismissed pursuant to Patent Owner’s Notice of Voluntary Dismissal. Motion 3–4. In view of the stage of these proceedings and the settlement between Petitioner and Patent Owner, we determine that good cause exists to terminate these *inter partes* reviews.

After reviewing the Agreements between Petitioner and Patent Owner, we find that the Agreements contain confidential business information regarding the terms of settlement. We determine that it is appropriate to treat the Agreements as business confidential information and keep them separate from the files of U.S. Patent Nos. 6,581,574 B1 and 6,588,260 B1. *See* 37 C.F.R. § 42.74(c).

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

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Motions to terminate in IPR2023-01233 and IPR2023-01234 (Paper 21 in both) are *granted*;

FURTHER ORDERED that Patent Owner’s motions to terminate in IPR2023-01233 and IPR2023-01234 (Paper 20 in both) are *dismissed*;

⁵ Patent Owner informed the Board of its Disclaimer in conjunction with earlier motions to terminate unilaterally filed by Patent Owner in each case (Paper 20 in both), which we dismiss as moot in light of our determination here to grant the Motions.

⁶ In IPR2023-01234, Patent Owner erroneously cited to “Exhibit 1002” in its paper. In IPR2023-01233, Patent Owner correctly cited to “Exhibit 2002.”

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FURTHER ORDERED that these proceedings are *terminated*; and

FURTHER ORDERED that the Requests in IPR2023-01233 and IPR2023-01234 (Paper 22 in both) are *granted* to the extent that the parties' settlement agreement(s) (Exhibit 1010 (-01233); Exhibit 1051 (-01234)) shall be treated as business confidential information and be kept separate from the files of U.S. Patent Nos. 6,581,574 B1 and 6,588,260 B1, respectively, and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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