

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VOLKSWAGEN GROUP OF AMERICA, INC.,  
Petitioner

v.

MICHIGAN MOTOR TECHNOLOGIES LLC,  
Patent Owner

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Case IPR2020-00446  
U.S. Patent No. 6,763,804

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**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW**

***Mail Stop "PATENT BOARD"***

Patent Trial and Appeal Board

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

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**PETITIONER’S UPDATED EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
<b>1001</b>	U.S. Patent No. 6,763,804 to Pursifull (“’804 patent”)
<b>1002</b>	Prosecution File History of U.S. Patent No. 6,763,804 B2 (“’804 history”)
<b>1003</b>	Declaration of Gerald Micklow, Ph.D. (“Micklow Decl.”)
<b>1004</b>	<i>Curriculum Vitae</i> (CV) of Gerald Micklow, Ph.D. (“Micklow CV”)
<b>1005</b>	U.S. Patent No. 4,850,319 to Imoehl, titled “Electronic Throttle Actuator,” issued July 25, 1989 (“Imoehl”)
<b>1006</b>	U.S. Patent No. 4,656,407 to Burney, titled “Electric Motor Servo Control System and Method,” issued April 7, 1987 (“Burney”)
<b>1007</b>	U.S. Patent No. 6,329,777 to Itabashi et al., titled “Motor Drive Control Apparatus and Method Having Motor Current Limit Function Upon Motor Lock,” filed Sept. 7, 1999 (“Itabashi”)
<b>1008</b>	U.S. Patent No. 6,073,610 A to Matsumoto et al., titled “Control Apparatus of Internal Combustion Engine Equipped with Electronic Throttle Control Device,” issued June 13, 2000 (“Matsumoto”)
<b>1009</b>	European Patent Pub. No. 0121938 B1 to Murakami, titled “Throttle Control System for Automotive Vehicle,” published Dec. 30, 1986 (“Murakami”)
<b>1010</b>	European Patent Application No. EP 0874148 A2 to Matsumoto et al., titled “Control Apparatus for a Vehicle,” published Oct. 28, 1998 (“Matsumoto II”)
<b>1011</b>	UK Patent Application No. GB 2339850 to Pursifull, titled “A Throttle Valve for an Internal Combustion Engine with a Limp Home Position,” published Feb. 9, 2000 (“Pursifull”)
<b>1012</b>	U.S. Patent No. 4,313,408 to Collonia, titled “Device for the Control of the Traveling Speed of a Motor Vehicle,” issued Feb. 2, 1982 (“Collonia”)
<b>1013</b>	U.S. Patent No. 5,078,110 A to Rodefled, titled “Method and Arrangement for Detecting and Loosening Jammed Actuators,” issued January 7, 1992 (“Rodefled”)
<b>1014</b>	U.S. Patent No. 4,854,283 to Kiyono et al., titled “Throttle Valve Control Apparatus,” issued Aug. 8, 1989 (“Kiyono”)
<b>1015</b>	U.S. Patent No. 6,286,481 to Bos et al., titled “Electronic Throttle Return Mechanism with a Two Spring and One Lever Default Mechanism,” issued Sept. 11, 2001 (“Bos”)

<b>Exhibit No.</b>	<b>Description</b>
<b>1016</b>	U.S. Patent No. 4,771,850 to Matsuda, titled “Automotive Traction Control System with Feature of Enabling and Disabling Control Depending Upon Vehicle Speed,” issued September 20, 1988 (“Matsuda”)
<b>1017</b>	U.S. Patent No. 5,712,550 to Boll et al., titled “Apparatus for Controlling a Power Control Element of a Drive Unit of a Motor Vehicle,” issued Jan. 27, 1998 (“Boll”)
<b>1018</b>	U.S. Patent No. 5,749,343 to Nichols et al., titled “Adaptive Electronic Throttle Control,” issued May 12, 1998 (“Nichols”)
<b>1019</b>	William M. Erickson, Protecting Servomotors from Self Destruction, Machine Design (Sept. 1, 2000) (“Erickson”)
<b>1020</b>	U.S. Patent No. 4,982,710 to Ohta et al., titled “Electronic Throttle Valve Opening Control Method and System Therefor,” issued Jan. 8, 1991 (“Ohta”)
<b>1021</b>	Snap-On, BMW Reference Manual (Aug. 2001, 1st ed.) (“BMW Manual”)
<b>1022</b>	William L. Husselbee, Automotive Computer Control Systems, Harcourt Brace (1989) (“Husselbee”)
<b>1023</b>	Snap-On, General Motors Reference Manual (Apr. 1995, 7th ed.) (“GM Manual”)
<b>1024</b>	Chrysler Front Wheel Drive 1981-92 Repair Manual (1992) (“Chrysler Manual”)
<b>1025</b>	Declaration of Sylvia D. Hall-Ellis, Ph.D. (“Hall-Ellis Decl.”)
<b>1026</b>	<i>Curriculum Vitae</i> (CV) of Sylvia D. Hall-Ellis, Ph.D. (“Hall-Ellis CV”)
<b>1027</b>	U.S. Patent No. 4,645,992 to Ritenour, titled “Electronically Controlled Servomotor Limit Stop,” issued Feb. 24, 1987 (“Ritenour”)
<b>1028</b>	U.S. Patent No. 4,364,111 to Jocz, titled “Electronically Controlled Valve Actuator,” issued Dec. 14, 1982 (“Jocz”)
<b>1029</b>	Amended Complaint for Patent Infringement, <i>Michigan Motor Technologies LLC v. Volkswagen AG</i> , Case No. 2:19-cv-10485 (E.D. Mich.), filed April 30, 2019
<b>1030</b>	Second Amended Complaint for Patent Infringement, <i>Michigan Motor Technologies LLC v. Volkswagen AG</i> , Case No. 2:19-cv-10485 (E.D. Mich.), filed January 6, 2020

<b>Exhibit No.</b>	<b>Description</b>
<b>1031</b>	Milestones on the Automotive Information Super-Highway, Snap-on Diagnostics (Apr. 13, 2001), <i>available at</i> <a href="https://web.archive.org/web/20010413220224/http://www.snapondia.com/mileston.htm">https://web.archive.org/web/20010413220224/http://www.snapondia.com/mileston.htm</a>
<b>1032</b>	MT2500 Scanner Home, Snap-on Diagnostics (June 11, 2001), <i>available at</i> <a href="https://web.archive.org/web/20010611023000/http://www.snapondia.com:80/scanner.htm">https://web.archive.org/web/20010611023000/http://www.snapondia.com:80/scanner.htm</a>
<b>1033</b>	Domestic Combo Primary Cartridge, Snap-on Diagnostics (April 11, 2001), <i>available at</i> <a href="https://web.archive.org/web/20010411032033/http://www.snapondia.com/99combo.htm">https://web.archive.org/web/20010411032033/http://www.snapondia.com/99combo.htm</a>
<b>1034</b>	Declaration of Gerald Micklow, Ph.D. in support of Petitioner's Reply and Petitioner's Opposition to Patent Owner's Motion to Amend ("Micklow Second Decl.")
<b>1035-1099</b>	<i>Intentionally Left Blank</i>
<b>1100</b>	Agreement (CONFIDENTIAL)

## **I. STATEMENT OF RELIEF REQUESTED**

Petitioner Volkswagen Group of America, Inc. (“VWGoA” or “Petitioner”) and Patent Owner Michigan Motor Technologies LLC (“MMT” or “Patent Owner”) have entered into a confidential agreement that resolves all underlying disputes between Petitioner and Patent Owner with respect to U.S. Patent No. 7,763,804 (“the ’804 patent”). A copy of the parties’ agreement is being filed with this motion as Exhibit 1100 (the “Agreement”). The parties are concurrently filing a separate request that the Agreement be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Accordingly, the parties jointly move the Board to terminate this *inter partes* review (IPR) proceeding in its entirety, without rendering a final written decision. The Board authorized the parties to file this joint motion to terminate in an email of March 17, 2021.

## **II. STATEMENT OF FACTS**

On March 16, 2021, Petitioner and Patent Owner entered into a confidential Agreement. *See* EX1100 (Confidential). Under the terms of the Agreement, Petitioner and Patent Owner agreed to jointly seek termination of this proceeding.

### III. ARGUMENT

37 C.F.R. § 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a).” Termination of the present *inter partes* review proceeding in its entirety is in the interest of justice.

#### A. The Board should terminate this IPR in its entirety.

Public policy favors terminating the present *inter partes* review proceeding. The federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Bergh v. Dept. of Trans.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Additionally, termination of the proceeding at this stage, in view of the Agreement, is appropriate. The USPTO can conserve significant administrative and judicial resources by terminating the proceeding now, removing the need for the Board to render a final written decision. The Board has terminated entire proceedings based on joint motions to terminate, even after the merits had been fully briefed and oral argument had occurred. *See Apex Med. Corp. v. Resmed Ltd.*,

IPR2013-00512, Paper 39, at 2-3 (P.T.A.B. Sept. 12, 2014) (granting joint motion to terminate after the parties had fully briefed the matter because the Board “has not yet decided the merits of this proceeding, and the record is not yet closed.”); *Lam Research Corp. v. Flamm*, IPR2015-01764, Paper 27, at 5 (P.T.A.B. Dec. 15, 2016) (granting motion to terminate after all briefing and oral argument when statutory deadline for rendering final written decision is within two months of motion).

Finally, because the Board has not decided the merits of the proceeding, the expected normal course is to terminate the proceeding. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768 (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”).

## **B. Written Agreement**

The parties represent that their entire agreement in connection with the termination of this proceeding is embodied in the Agreement, which has been made in writing. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review. The Agreement has been filed for access by the “Parties and Board Only” due to the highly sensitive business confidential information it contains. The parties desire that the Agreement be maintained as business confidential information under 35



U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), and a separate joint request for such is being filed concurrently.

#### **IV. CONCLUSION**

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate this proceeding in its entirety.

Respectfully submitted,

/Jason A. Fitzsimmons/

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Date: March 19, 2021

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Respectfully submitted,

/Timothy Devlin/

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Date: March 18, 2021

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**CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))**

The undersigned hereby certifies that true and correct copies of the foregoing **JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW** and **Exhibit 1100** were served electronically via e-mail on March 19, 2021, on the following counsel for Patent Owner:

Timothy Devlin (Lead Counsel)  
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