

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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IPR2020-00446  
Patent 6,763,804 B2

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Before NEIL T. POWELL, SCOTT B. HOWARD, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

TERMINATION  
Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

## I. INTRODUCTION

On March 19, 2021, with Board authorization, Petitioner and Patent Owner filed a joint motion to dismiss the petition and terminate the above-captioned proceeding. Paper 20. Along with the motion, the parties filed a copy of a Confidential Agreement (Ex. 1100), as well as a joint request to treat the Confidential Agreement as business confidential information (Paper 21). *See* 37 C.F.R. § 42.74(c) (2019) (“A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application.”).

## II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains, the Office may terminate the *inter partes* review.

In this case, the Board issued a decision to institute *inter partes* review. Paper 9. However, the Board has not yet decided the merits of the proceeding or entered a final written decision. In the joint motion, the parties state that they have settled their dispute and have reached an agreement to request termination of this *inter partes* review. Paper 20, 1. Accordingly, in the circumstances present here, we determine that it is appropriate to terminate the proceeding. 37 C.F.R. § 42.71(a). This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

The parties also ask that the Confidential Agreement be treated as business confidential information and be kept separate from the file of the challenged patent. Paper 21. We determine that it is appropriate to treat the Confidential Agreement as business confidential information, and to keep that document separate from the files of the challenged patent, pursuant to 37 C.F.R. § 42.74(c).

The parties further ask the Board to order that, “in the event a person or entity makes a written request, as stated in 37 C.F.R. § 42.74(c)(1)-(2), for access to the [Confidential Agreement], that any such written request be served upon the parties on the day the written request is provided to the Board.” Paper 21, 1. The statutory and regulatory provisions governing access to such settlement agreements stand on their own, and therefore, we deny the parties’ request here.

### III. ORDER

Accordingly, it is:

ORDERED that the joint motion is *granted* and this proceeding is terminated with respect to Petitioner and Patent Owner;

FURTHER ORDERED that the joint request that the Confidential Agreement (Ex. 1100) be treated as business confidential information, to be kept separate from the patent file, is *granted* in this proceeding; and

FURTHER ORDERED that the joint request that the Board order that, in the event a person or entity makes a written request for access to the Confidential Agreement, that any such written request be served upon the parties on the day the written request is provided to the Board, is *denied* in this proceeding.

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