

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.

Case IPR2023-01031
U.S. Patent 8,909,482

PATENT OWNER'S RESPONSE TO SHOW CAUSE ORDER

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Patent Trial and Appeal Board
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Board's Order to Show Cause entered on May 16, 2024 (Paper 22), Patent Owner, Michigan Motor Technologies LLC, contends that there is good cause not to enter adverse judgment under 37 C.F.R. § 42.73(b)(4) for the following reasons.

As noted in Patent Owner's Preliminary Response (Paper 11), Patent Owner had been in discussions with Petitioner to dismiss the pending lawsuit which included U.S. Patent No. 8,909,482 ("the '482 patent"). Relying on representations by Petitioner, Patent Owner voluntarily dismissed the pending lawsuit, believing that Petitioner would seek timely dismissal of the above-captioned *Inter Partes Review* of the '482 patent. *See* Exhibit 2004. However, Petitioner has not done so despite repeated requests.

Since Petitioner has not timely sought termination of the proceeding, rather than further burdening the Board, Patent Owner has elected not to file a Patent Owner Response and has also disclaimed all of the challenged claims in the above-captioned *Inter Partes Review* of U.S. Patent 8,909,482. *See* Exhibit 2005. Accordingly, the above-captioned *Inter Partes Review* of U.S. Patent 8,909,482 is now moot.

In view of the foregoing, Patent Owner avers that there is good cause not to enter adverse judgment and respectfully requests that the Board instead

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exercise its discretion to terminate this proceeding without adverse judgment. However, if the Board declines to exercise its discretion as requested, Patent Owner will not oppose adverse judgment under 37 C.F.R. § 42.73(b).

Should the Board require any further information, the Board is encouraged to contact the Patent Owner's undersigned representative at the telephone number listed below.

Dated: May 30, 2024

Respectfully submitted,

DEVLIN LAW FIRM LLC

/ Timothy Devlin /
Timothy Devlin
Reg. No. 41706
1526 Gilpin Ave.
Wilmington, DE 19806
Phone: (302) 449-9010
tdevlin@devlinlawfirm.com

Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 30, 2024, the foregoing document is being served via electronic mail upon the following counsel of record for Petitioner:

LEAD COUNSEL	BACKUP COUNSEL
Edward H. Sikorski Reg. No. 39,478 DLA Piper LLP (US) 4365 Executive Drive, Suite 1100 San Diego, CA 92121-2133 Phone: 619.699.2645 Fax: 858.677.1401 ed.sikorski@us.dlapiper.com	Brian Biggs (<i>pro hac vice</i>) DLA Piper LLP (US) 1201 N. Market St., Suite 2100 Wilmington, DE 19801-1147 Phone: 302.468.5661 Fax: 302.778.7935 brian.biggs@us.dlapiper.com Matthew S. Middleton Reg. No. 77,117 DLA Piper LLP (US) 1201 N. Market St., Suite 2100 Wilmington, DE 19801-1147 Phone: 302.468.5675 Fax: 302.778.7935 matthew.middleton@us.dlapiper.com
Additional email(s) for service: MMT-BMWNA-IPR@us.dlapiper.com	

/s/ Timothy Devlin
Timothy Devlin