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

IPR2023-01032
U.S. Patent No. 6,581,565

PETITIONER'S RESPONSE TO PATENT OWNER'S MOTION TO TERMINATE PROCEEDING

Pursuant to the Board's correspondence dated May 24, 2024 (EX-3001), Petitioner BMW of North America, LLC ("BMW") files this response to Patent Owner Michigan Motor Technologies, LLC's ("PO") Motion to Terminate Proceeding (Paper 24).

PO's statement that BMW "has not timely sought termination of the proceeding" is incorrect. *See* Paper 24. BMW has had, and continues to have, no duty to request termination because the parties have not yet settled their dispute.

Moreover, adverse Judgment is warranted if not mandated by 37 CFR 42.73(b) now that PO has filed a disclaimer of the involved patent (EX-2002) and indicated that it will not oppose adverse judgment. PO's act of filing a disclaimer is among the "[a]ctions construed to be a request for adverse judgment" under 37 CFR 42.73(b). Thus, the Board should construe PO's disclaimer as a request for adverse judgment. BMW does not oppose the Board entering adverse judgment.

Dated: June 7, 2024

Respectfully Submitted,

/Matthew S. Middleton/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petitioner's Response to Patent Owner's Motion to Terminate Proceeding has been served via Electronic Mail upon the following on June 7, 2024:

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Dated: June 7, 2024

Respectfully Submitted,

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