

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 IPR2023-01224
U.S. Patent 6,557,540

PATENT OWNER'S MOTION TO TERMINATE PROCEEDING

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

TABLE OF EXHIBITS

Exhibit No.	Description
2001	August 16, 2023, email from Neil A. Benchell to Brian Biggs
2002	November 2, 2023, email from Neil A. Benchell to Brian Biggs
2003	November 16, 2023, email from Brian Biggs to Jason Wejnert and Neil A. Benchell
2004	Notice of Voluntary Dismissal with Prejudice (MMT v BMW, No. 1:22-cv-03804, Dkt No. 112)
2005	Statutory Disclaimer of Claims 1, 2, 7, 10, 11, and 14 of US Patent 6,557,540

Pursuant to 37 C.F.R. § 42.71 and 42.72, Patent Owner, Michigan Motor Technologies LLC hereby moves to have the above-captioned *Inter Partes* Review of U.S. Patent No. 6,557,540 (“the ’540 patent”) terminated without adverse judgment for the following reasons.

Patent Owner has been in discussions with Petitioner to dismiss the pending lawsuit which included the ’540 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 ’540 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 the ’540 patent. *See* Exhibit 2005. Accordingly, the above-captioned *Inter Partes* Review of the ’540 patent is now moot.

In view of the foregoing, Patent Owner respectfully requests that the Board 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.

Respectfully submitted,

Dated: June 10, 2024

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 June 10, 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 emails for service: MMT-BMWNA-IPR@us.dlapiper.com	

/ Timothy Devlin /
Timothy Devlin