

Filed: January 3, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PREFERRED PROPPANTS, LLC, PREFERRED PIPELINE, LLC, PREFERRED
RESIN SALES, LLC, PREFERRED RESIN OF GENOA, LLC, AND
PREFERRED SANDS OF WISCONSIN, LLC,

Petitioners

v.

TRICAN WELL SERVICE LTD.,

Patent Owner

U.S. Patent No. 8,236,738 to Zhang

Inter Partes Review IPR2017-02100

Petitioners and Patent Owner's Joint Motion
to Terminate *Inter Partes* Review Proceedings Pursuant to 35 U.S.C. § 317(a)

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and the Board’s authorization of January 3, 2018, Preferred Proppants, LLC, Preferred Pipeline, LLC, Preferred Resin Sales, LLC, Preferred Resin of Genoa, LLC, and Preferred Sands of Wisconsin, LLC (“Petitioners”) and Trican Well Service Ltd. (“Patent Owner”) (collectively, “the Parties”) hereby provide notice that they have reached a settlement agreement and jointly request termination of the following *inter parties* reviews:

1. Case No. IPR2017-01807 challenging U.S. Patent No. 7,723,274 (“the ’274 patent”);
2. Case No. IPR2017-01815 challenging the ’274 patent
3. Case No. IPR2017-02099 challenging U.S. Patent No. 8,236,738 (“the ’738 patent”)
4. Case No. IPR2017-02100 challenging the ’738 patent (collectively, “the IPRs”)

Because none of the IPRs have been joined, this motion has been filed under separate caption in each proceeding.

I. Termination Is Appropriate

The basis for this Joint Motion is the settlement of all disputes between the parties relating to the ’274 patent and the ’738 patent. Pursuant to that settlement, the Parties have also entered into a mutual release. An *inter partes* review 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 proceedings before the request for termination is filed. 35 U.S.C. § 317(a). The IPRs concerning the '274 patent were accorded a filing date of August 8, 2017 and the IPRs concerning the '738 patent were accorded a filing date of September 30, 2017. While Patent Owner has filed a preliminary response in each of the two IPRs concerning the '274 patent, Patent Owner has not yet filed a preliminary response in either of the two IPRs concerning the '738 patent. Additionally, the Patent Trial and Appeal Board has not yet instituted any of the IPRs. The proceedings are thus each in the preliminary stage, the Board has not yet instituted any of the IPRs, the record lacks full briefing on the trial issues, and the Board has accordingly not decided the merits of the proceedings.

The settlement agreement also requires the dismissal of the only litigation matter related to the two challenged patents, *Trican Well Service Ltd. v. Preferred Proppant, LLC, et al.*; Civil Action No. 4:17-cv-01340, pending in the Southern District of Texas, Houston Division. Petitioners are the only defendants in that case. The Parties have filed dismissal papers in that suit. The Parties also represent that no additional district court litigation is currently pending and that there is no related proceeding in the U.S. Patent and Trademark Office at this time. Further, the Parties represent that no litigation or proceeding involving the subject patents is

contemplated in the foreseeable future. By granting the present motion, the Board and the Parties can conserve resources.

II. Agreement in Writing Submitted to the Board

As required by statute and consistent with the above-noted communications with the Board, the parties are filing concurrently herewith, as a separate submission, a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 36 U.S.C. § 317(b), along with a true and correct copy of the written Settlement and License Agreement (Ex. 1020) in connection with this matter. The Parties request that the Settlement and License Agreement be treated as business confidential information and be kept separate from the files of the '274 patent and '738 patent, pursuant to 37 C.F.R. 42.74(c). The Parties certify that there are no other collateral agreements or understandings, written or oral, made in connection with, or in contemplation of, the termination of the IPRs.

III. Conclusion

For the reasons stated above, the Parties respectfully request that the Board terminate Inter Partes Reviews IPR2017-01807, IPR2017-01815, IPR2017-02099, and IPR2017-02100. Because the parties jointly request termination as to Petitioner, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

DATED: January 3, 2018

/s/ J. David Cabello*

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**signed with permission*

Respectfully submitted,

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Lead Counsel for Petitioners

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of January, 2018, a copy of the foregoing document was served to the email addresses provided by Patent Owner pursuant to 37 C.F.R. §§ 42.6(e) and 42.8:

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