

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ENERCOP SAND SOLUTIONS INC.  
Petitioner,

v.

SPECIALIZED DESANDERS INC.,  
Patent Owner

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Case IPR2018-01748  
Patent No. 8,945,256

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**PARTIES' JOINT MOTION TO TERMINATE PROCEEDINGS  
PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Enercorp Sand Solutions Inc. (“Petitioner”) and Specialized Desanders Inc. (“Patent Owner”) (collectively, “the Parties”) hereby provide notice that they have settled their disputes and jointly request termination of the following proceedings:

- (1) Case No. IPR2018-01748 challenging U.S. Patent No. 8,945,256 (the “’256 IPR”); and
- (2) Case No. IPR2019-01582 challenging U.S. Patent No. 9,861,921 (the “’921 IPR”).

This Joint Motion was authorized by the Board pursuant to email correspondence on October 15, 2019. Because the ’256 IPR and the ’921 IPR are not joined or consolidated, this motion has been filed under separate caption in each proceeding.

The Parties have settled all disputes between them, including those relating to the ’256 IPR and the ’921 IPR. Pursuant to the Parties’ settlement agreement, if this Motion to Terminate is not granted as to one or both proceedings, Petitioner will not participate further in either proceeding, but Patent Owner will continue to participate. Pursuant to 37 C.F.R. § 42.74, a true copy of the Parties’ settlement agreement has been filed as Exhibit 1015.

*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 proceeding before the request for termination is filed. 35 U.S.C. § 317(a). “There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). Further, the Board is authorized to “dismiss any petition or motion, and may enter any appropriate order.” 37 C.F.R. § 42.71.

Trial in the ’256 IPR was instituted on February 25, 2019. Patent Owner has filed a response to the Petition (Paper 10) and a Sur-Reply (Paper 16) to the Petitioner’s Reply (Paper 14). However, the parties have not filed any motions to exclude, and have not conducted an oral argument, which if requested is scheduled for November 20, 2019 (Paper 8). The parties settled their disputes before the deadline for filing such motions or requesting oral argument was reached. Accordingly, the Board has not yet decided the merits of the proceeding.

The ’921 IPR petition was filed on September 6, 2019. Trial has not been instituted, nor has Patent Owner filed a preliminary response. The proceeding is therefore in a preliminary stage and the Board has not decided the merits of the proceeding.

Accordingly, as the Board has not yet decided their merits, it is appropriate for the Board to exercise its authority pursuant to 37 C.F.R. § 42.71 to terminate both

proceedings in response to the settlement entered into between Petitioner and Patent Owner. By granting the present motion, the Board and the Parties can conserve resources. Terminating these proceedings in view of the Parties' settlement also serves to encourage settlement in future cases.

As required by statute and as directed by 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 the true copy of the written settlement agreement (Ex. 1015). The Parties request that the settlement agreement be treated as business confidential information and be kept separate from the files of the involved patents pursuant to 37 C.F.R. 42.74(c). The Parties certify that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the '256 IPR or the '921 IPR.

Furthermore, the Parties certify that they are unaware of any other planned or pending trials or proceedings involving the involved patents, or any other matters before the Office or any other tribunal, that would be affected by the termination of these proceedings.

Accordingly, the Parties respectfully request that that the Board grant the Parties' Joint Motion to Terminate. The Parties also request that the Board grant the Parties' joint request to treat the settlement agreement as business confidential

information and keep it separate from the file of the involved patents.

Dated: October 16, 2019

Respectfully submitted,

/James H. Hall/

James H. Hall

Registration No. 66,317

*Counsel for Petitioner*

## **CERTIFICATE OF SERVICE**

I hereby certify that on this 16th day of October 2019, a copy of this Joint Motion to Terminate was served via e-mail to Patent Owner's counsel at the addresses below as authorized by Patent Owner pursuant to 37 C.F.R. §§ 42.6(e) and 42.8(b)(4):

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/James H. Hall/

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