

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE SHERWIN-WILLIAMS COMPANY,  
Petitioner,

v.

ARCH CHEMICALS, INC.,  
Patent Owner

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Case: IPR2019-01497, IPR2019-01498  
U.S. Patent No. 9,723,842

Case: IPR2019-01499  
U.S. Patent No: 9,717,250

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**AUTHORIZED JOINT MOTION TO TERMINATE THE PROCEEDINGS**

## **I. INTRODUCTION**

Pursuant to the Board’s authorization provided during a teleconference on February 10, 2020, Petitioner The Sherwin-Williams Company (“Sherwin-Williams”) and Patent Owner Arch Chemicals, Inc. (“Arch”), jointly file this Motion to Terminate proceedings IPR2019-01497, IPR2019-01498, and IPR2019-01499 (the “Proceedings”).

The parties have resolved the underlying claims of infringement that were pending in the United States District Court for the District of Delaware, in *Arch Chemicals, Inc. v. The Sherwin-Williams Company and The Valspar Corporation*, Case No. 1:18-cv-2037-LPS. These Proceedings are also at an early stage: Patent Owner Arch did not file a Preliminary Response in any of the Proceedings, and the Board has not issued any decisions on institution. To preserve the Board’s resources and to achieve a just, speedy, and inexpensive resolution of this dispute, Patent Owner and Petitioner jointly request that the Board terminate proceedings IPR2019-01497, IPR2019-01498, and IPR2019-01499.

## **II. BACKGROUND AND PROCEDURAL HISTORY**

Petitioner filed three Petitions for *inter partes* review, each accorded filing date August 15, 2019. IPR2019-01497 and IPR2019-01498 sought *inter partes* review of U.S. Patent 9,723,842 (the “’842 Patent”). IPR2019-01499 sought *inter partes* review

IPR2019-01497, IPR2019-01498, IPR2019-01499  
Patent 9,717,250, U.S. Patent 9,723,842

of a divisional of the '842 Patent, U.S. Patent 9,717,250 (the "'250 Patent"). Patent Owner did not file a Preliminary Response in any of these proceedings. The Board has not yet issued an institution decision in any of the proceedings.

Petitioner's Petitions stemmed from Patent Owner's allegations that Petitioner infringed the '842 and '250 Patents, in cases titled *Arch Chemicals, Inc. v. The Sherwin-Williams Company*, no. 1:18-cv-00986 (D. Del.) and *Arch Chemicals, Inc. v. The Sherwin-Williams Company and The Valspar Corporation*, no. 1:18-cv-02037-LPS (D. Del.). On February 4, 2020, Patent Owner granted Petitioner an irrevocable covenant not to sue on, *inter alia*, the '842 and '250 Patents and thereby resolved their infringement dispute.

### **III. ARGUMENT**

The Board "may terminate a trial without rendering a final written decision, where appropriate." 37 C.F.R. § 42.72. Further, the rules governing IPR proceedings "shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding." *Id.* § 42.1(b).

Good cause is present to grant this Joint Motion and terminate IPR2019-01497, IPR2019-01498, and IPR2019-01499. Termination would preserve the Board's resources and would expeditiously resolve these Proceedings. 37 C.F.R. § 42.1(b). The Proceedings are in their preliminary stages, as the Board has not yet issued any institution decisions. There would be no prejudice to either Petitioner or Patent

Owner, as this request is joint. Termination is just, as Petitioner and Patent Owner have resolved the infringement allegations that gave rise to Petitioner's Petitions.

In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner provide a copy of the agreement between them resolving Patent Owner's infringement allegations against Petitioner, which is filed as IPR2019-01497, Paper 13; IPR2019-01498, Paper 13; and IPR2019-01499, Paper 9. Petitioner and Patent Owner respectfully request pursuant to 42 C.F.R. § 42.74(c) that the agreement be "treated as business confidential information," be "kept separate from the file of the involved patent[s]," and "be made available only to a Government agency on written request to the Board," and only be made available to "any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause." 42 C.F.R. § 42.74(c). Good cause is present to keep the agreement as business confidential information. The agreement contains a confidentiality clause that restricts disclosure to particular identified parties, unless required by law. In accordance with that provision and 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, the agreement should be kept as business confidential information and restricted as provided in 37 C.F.R. § 42.74(c).

#### **IV. CONCLUSION**

For all the reasons stated above, Petitioner and Patent Owner respectfully and

IPR2019-01497, IPR2019-01498, IPR2019-01499  
Patent 9,717,250, U.S. Patent 9,723,842

jointly request that the Board terminate IPR2019-01497, IPR2019-01498, and  
IPR2019-01499.

Petitioner and Patent Owner further respectfully and jointly request that  
pursuant to 35 U.S.C. § 371(b) and 42 U.S.C. § 42.74(c), the agreement filed as  
IPR2019-01497, Paper 13; IPR2019-01498, Paper 13; and IPR2019-01499, Paper 9,  
be:

- (1) treated as business confidential information,
- (2) kept separate from the file of the involved patents,
- (3) made available only to a federal Government agency only upon  
written request; and
- (4) made available to any other person only upon written request to the  
Board to make the settlement agreement available, along with the fee  
specified in § 42.15(d) and on a showing of good cause.

Dated: February 11, 2020

Respectfully submitted,

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IPR2019-01497, IPR2019-01498, IPR2019-01499  
Patent 9,717,250, U.S. Patent 9,723,842

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on February 11, 2020, a copy of AUTHORIZED JOINT MOTION TO TERMINATE THE PROCEEDINGS was served in its entirety by electronic mail on Patent Owner as indicated on their mandatory notice:

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