

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRICAM INDUSTRIES, INC.

Petitioner,

v.

WING ENTERPRISES, INC.

Patent Owner.

Case No.: IPR2018-01070

Patent No. 7,364,017

**JOINT MOTION TO TERMINATE
UNDER 35 U.S.C. § 317(a) AND 37 C.F.R. § 42.71(a)**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.71(a), Petitioner Tricam Industries, Inc. and Patent Owner Wing Enterprises, Inc., jointly request termination of the *inter partes* review of U.S. Patent 7,364,017 in IPR2018-01070.

Petitioner and Patent Owner (“the Parties”) have executed a written confidential settlement agreement that fully resolves this matter. On July 30, 2018 the Parties informed the Board of the settlement via e-mail and requested authorization to file a joint motion to terminate the proceeding with respect to both the Patent Owner and the Petitioner. As set forth in an e-mail dated July 31, 2018, the Board authorized the filing of the requested joint motion to terminate this proceeding as to both parties. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

The Parties are concurrently filing a copy of the settlement agreement as EX 1010, along with a request to treat the settlement agreement as confidential business information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The undersigned represents that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of the present proceeding and that EX 1010 represents a true and accurate copy of the agreement between the parties that resolves the present proceeding.

The e-mail dated July 31, 2018 from the Board further requested an update “concerning the status of any district court action or other administrative

proceeding involving the patent at issue in this proceeding.” The only other proceeding involving the patent at issue in this proceeding is the district court action identified in the Parties’ respective mandatory notices: *Wing Enterprises, Inc. dba Little Giant Ladder Systems v. Tricam Industries, Inc.*, Case No. 0:17-CV-01769-WMW-LIB, (D. Minn.) The Parties represent that the current status of that action is as follows: all patent-related claims and counterclaims were dismissed with prejudice in an Order dated July 30, 2018. That case is still pending with respect to other, non-patent causes of action.

Termination of this IPR is appropriate as the Board has not reached a decision on institution, and it has not yet “decided the merits of the proceeding.” *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). The parties have now settled their dispute, and have reached agreement to terminate this *inter partes* review. The USPTO can conserve its resources through terminating the proceedings now, removing the need for the Board to further consider the arguments, to issue an Institution Decision, or to render a Final Decision. Furthermore, no other party’s rights will be prejudiced by the termination of this proceeding.

Therefore, the Parties jointly request termination of this *inter partes* review of U.S. Patent 7,364,017 (IPR2018-01070).

Dated: August 2, 2018

Respectfully submitted,

/Mike P. Gates/

Mike P. Gates
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Attorney for Petitioner
Tricam Industries, Inc.

Dated: August 2, 2018

Respectfully submitted,

/Mark M. Miller/

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Wing Enterprises, Inc.

CERTIFICATION OF SERVICE

The undersigned hereby certifies that “JOINT MOTION TO TERMINATE UNDER 35 U.S.C. § 317(A) AND 37 C.F.R. § 42.71(a)” for the above-captioned matter was served in its entirety on August 2, 2018, upon the following parties via e-mail:

Mark Miller - miller.mark@dorsey.com

Bradley Jensen - jensen.brad@dorsey.com

Dated: August 2, 2018

/Mike P. Gates/

Mike P. Gates

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