

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LEE SPECIALTIES INC.,  
Petitioner,

v.

FHE USA LLC,  
Patent Owner

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Case IPR2019-01366  
U.S. Patent No. 10,030,461

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**JOINT MOTION TO TERMINATE PROCEEDINGS**

Pursuant to 35 U.S.C. § 317(a), Petitioner Lee Specialties Inc. (“Lee Specialties”) and Patent Owner FHE USA, LLC (“FHE USA”) (collectively, the “Parties”) jointly request termination of the instant *Inter Partes* Review of U.S. Patent No. 10,030,461 (“the ’461 Patent”). The filing of this request was authorized by the Board via e-mail dated February 14, 2020.

The Parties have settled their dispute with respect to the ’461 Patent and have reached agreement to terminate this *Inter Partes* Review. The Settlement Agreement between Lee Specialties and FHE USA has been made in writing, and a true and correct copy shall be filed with this Office pursuant to 35 U.S.C. § 317(b). *See* Exhibit LSI-1038. There are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding.

Therefore, Petitioner and Patent Owner respectfully request termination of *Inter Partes* Review Case No. IPR2019-01366.

Respectfully submitted,

Date: February 17, 2020

/Gregory P. Webb/

Gregory P. Webb  
Lead Counsel for Petitioner  
Registration No. 59,859

/s/ Douglas R. Nemec

Douglas R. Nemec  
Lead Counsel for Patent Owner  
Registration No. 41,219

**PETITIONER'S UPDATED EXHIBIT LIST**

**FEBRUARY 17, 2020**

<b>Exhibit Description</b>	<b>Exhibit #</b>
U.S. Patent No. 10,030,461 to Johansen <i>et al.</i> (the "'461 Patent")	LSI-1001
Prosecution History of the '461 Patent	LSI-1002
Declaration of Benton F. Baugh, Ph.D., P.E.	LSI-1003
Curriculum <i>Vitae</i> of Benton F. Baugh, Ph.D., P.E.	LSI-1004
U.S. Patent No. 3,096,999 to Ahlstone <i>et al.</i> ("Ahlstone")	LSI-1005
U.S. Patent No. 7,159,652 to McGuire <i>et al.</i> ("McGuire")	LSI-1006
U.S. Patent No. 8,272,444 to Baugh ("Baugh")	LSI-1007
Declaration of Andrew M. Nelson	LSI-1008
ANSI/API Specification 16A (3d edition), Specification for Drill-Through Equipment (2004) ("API 16A")	LSI-1009
Declaration of Dr. Ingrid Hsieh-Yee	LSI-1010
U.S. Patent No. 4,225,160 to Ortloff ("Ortloff")	LSI-1011
Section 4: Pressure Control Equipment of Elmar's Wireline Equipment Catalog 2003 ("Elmar PCE")	LSI-1012
Affidavit of Chris Butler	LSI-1013
U.S. Patent Application Publication No. 2012/0012341 ("White")	LSI-1014
U.S. Patent 8,746,345 to Kotrala <i>et al.</i> ("Kotrala")	LSI-1015
U.S. Patent Application Publication No. 2014/0034337 to Van Wijk ("Van Wijk")	LSI-1016
Joint Claim Construction Chart, Dkt. No. 36, Case No. 5:18-cv-00715-OLG (W.D. Tex. March 25, 2019)	LSI-1017
Defendant LSI's Opening Claim Construction Brief, Dkt. No. 38	LSI-1018
Exhibit 2 to LSI's Opening Claim Construction Brief – Baugh Declaration, Dkt. No. 38	LSI-1019
Exhibit 2B to LSI's Opening Claim Construction Brief – Merriam-Webster's Collegiate Dictionary (11th Edition)	LSI-1020

Exhibit C to LSI's Opening Claim Construction Brief – <i>McGraw-Hill Dictionary of Engineering</i> (2nd edition)	LSI-1021
Plaintiff's Opening Claim Construction Brief, Dkt. No. 39	LSI-1022
Plaintiff's Initial Proposed Claim Constructions	LSI-1023
Plaintiff's Amended Modified Claim Constructions	LSI-1024
Defendant Lee Specialties Inc.'s Responsive Claim-Construction Brief, Dkt. No. 41	LSI-1025
Plaintiff's Responsive Claim Construction Brief, Dkt. No. 42	LSI-1026
Plaintiff FHE's Supplemental Responses and Objections to Defendant's First Set of Interrogatories	LSI-1027
Supplemental Exhibit A to FHE's Responses and Objections to Defendant's First Set of Interrogatories	LSI-1028
Second Amended Complaint for Patent Infringement	LSI-1029
Defendant Lee Specialties Inc.'s Supplemental Objections and Responses to Plaintiff FHE USA LLC's First Set of Interrogatories (Nos. 4-7)	LSI-1030
Joint Motion to Amend Schedule, Dkt. No. 34 in FHE USA LLC v. Express Supply & Rental, LLC (W.D. La.)	LSI-1031
Defendant Lee Specialties Inc.'s Supplemental Opening Claim-Construction Brief, Dkt. No. 55	LSI-1032
Exhibit 11 to Defendant Lee Specialties Inc.'s Supplemental Opening Claim-Construction Brief – Baugh Supplemental Declaration, Dkt. No. 55-2	LSI-1033
Defendant Lee Specialties Inc.'s Supplemental Responsive Claim-Construction Brief, Dkt. No. 60	LSI-1034
FHE's Unopposed Motion for Leave to File Second Amended Complaint and to Amend Schedule, Dkt. No. 46	LSI-1035
Order on FHE USA LLC and Express Supply & Rental LLC's Joint Motion to Dismiss With Prejudice; Case No. 6:18-cv-0913-RRS-CBW; Dkt. No. 37	LSI-1036
Order Cancelling Markman Hearing; Case No. 5:18-cv-00715-ADA; Dkt. No. 63	LSI-1037
Settlement Agreement	LSI-1038

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Lee Specialties Inc.                    § Petition for *Inter Partes* Review  
Petitioner                                §  
   § IPR2019-01366  
   § U.S. Patent No. 10,030,461  
   §

**CERTIFICATE OF SERVICE**

The undersigned certifies, in accordance with 37 C.F.R. § 42.6, that service was made on the Patent Owner as detailed below.

*Date of service*   February 17, 2020

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*Documents served*   Joint Motion to Terminate Proceedings  
Exhibit LSI-1038

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