

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIZION, LLC d/b/a VULCAN INDUSTRIAL MANUFACTURING,
Petitioner

v.

KERR MACHINE CO.,
Patent Owner

Case PGR2020-00065
Patent 10,591,070

AMENDED JOINT MOTION TO TERMINATE PROCEEDING

Pursuant to 35 U.S.C. § 327(a), Petitioner Cizion, LLC d/b/a Vulcan Industrial Manufacturing (“Vulcan”) and Patent Owner Kerr Machine, Co. (“Kerr”) (collectively, the “Parties”), through their respective counsel of record, jointly request termination of this PGR proceeding directed to U.S. Patent No. 10,591,070 (“the ’070 Patent”). The Board authorized the filing of this Amended Joint Motion to Terminate via e-mail dated May 10, 2021.

The parties have reached a confidential settlement of their dispute with respect to the ’070 Patent, which includes an agreement to terminate this PGR proceeding and the underlying district court litigation. The confidential Settlement Agreements between Vulcan and Kerr have been made in writing, and true and correct copies of the Settlement Agreements between the Parties were previously filed and are filed concurrently with this motion as Exhibits 1075 and Exhibit 1076, respectively (which are submitted as “CONFIDENTIAL - Parties and Board Only”), pursuant to 35 U.S.C. § 327(b), along with an Amended Joint Request to Keep Settlement Agreements Confidential and Separate, pursuant to 35 U.S.C. § 327(b). The Parties request that the Settlement Agreements be treated as business confidential information and be kept separate from the files of the involved patent, and be made available only pursuant to 35 U.S.C. § 327 and 37 C.F.R. § 42.74(c).

Pursuant to 37 C.F.R. §§ 42.5 and 42.72, the Board may terminate a trial without rendering a final written decision, where appropriate, including pursuant to

a joint request under 35 U.S.C. §§ 317(a) or 327(a). *See Winplus N. Am., Inc. v. Pilot, Inc.*, IPR2018-00488, Paper 12 (PTAB Oct. 24, 2018). “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.” PTAB Consolidated Trial Practice Guide at 86 (November 2019).

This proceeding was instituted on December 3, 2020. Paper 10. Patent Owner filed a response on March 3, 2021. Paper 14. No subsequent briefing has occurred, and oral argument is set for September 1, 2021. Paper 11 at 10. As such, the Board has not already decided the merits, making termination appropriate under 34 C.F.R. § 42.72. Moreover, the underlying district court litigation involving the '070 Patent has already been dismissed pursuant to the parties' settlement agreement. *Kerr Machine Co. v. Vulcan Industrial Holdings, LLC*, C.A. No. 6-20-cv-00200, Dkt. 80 (W.D. Tex. May 10, 2021).

Therefore, for the foregoing reasons, Petitioner and Patent Owner respectfully request termination of Post Grant Review Case No. PGR2020-00065.

Respectfully submitted,

Dated: May 24, 2021

/s/ Brenton R. Babcock
Brenton R. Babcock
Lead Counsel for Petitioner
Registration No. 39,592

Case No. PGR2020-00065

Patent No. 10,591,070

/s/ James Hall _____

James H. Hall

Lead Counsel for Patent Owner

Registration No. 66,317

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that a true and correct copy of the foregoing was served on Patent Owner via filing through the PTAB E2E System.

Respectfully Submitted,

Dated: May 24, 2021

/s/ Brenton R. Babcock
Brenton R. Babcock (Reg. No. 39,592)
Lead Counsel for Petitioner