

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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McCLINTON ENERGY GROUP, LLC, JAYCAR ENERGY GROUP LLC, SURF  
FRAC WELLHEAD EQUIPMENT CO., MOTOR MILLS SNUBBING LLC,  
STAN KEELING, and TONY D. McCLINTON,  
Petitioner,

v.

MAGNUM OIL TOOLS INTERNATIONAL, LTD.,  
Patent Owner.

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Case No. IPR2014-00993  
Patent No. 8,459,346 B1

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**JOINT MOTION TO TERMINATE  
UNDER 35 U.S.C. § 317**

**JOINT REQUEST TO KEEP AGREEMENT CONFIDENTIAL  
UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

## STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and the Board's December 9, 2014 Order authorizing the parties to file this motion (*see* Paper No. 16), Petitioner and Patent Owner jointly request termination of *Inter Partes* Review IPR2014-00993 of U.S. Patent No. 8,459,346 B1 and request that the agreement discussed below (a) be treated as business confidential information, (b) be kept separate from the file of the involved patent, and (c) be made available only as permitted pursuant to the provisions of 35 C.F.R. § 317(b) and 37 C.F.R. § 42.72(c).

## STATEMENT OF FACTS

This review was just recently instituted on December 1, 2014 (*see* Paper No. 14) and therefore is still in the early stages of the trial. The parties have settled their disputes and have reached an agreement, in writing, to dismiss the related district court litigation, and terminate this *inter partes* review proceeding. On December 8, 2014, Petitioner and Patent Owner entered into a confidential Settlement Agreement, which is being filed herewith as Exhibit 1029. There is no other pending litigation between the Petitioner and Patent Owner that addresses U.S. Patent No. 8,459,346 B1. Therefore, termination of the present *Inter Partes* Review would resolve all presently pending disputes between the parties pertaining to U.S. Patent No. 8,459,346 B1.

## ARGUMENT

### **I. Termination of IPR2014-00993 is Appropriate**

The Board should terminate IPR2014-00993 because the review is still in its early stages, the Board has not yet finally decided any of the merits, no motions are outstanding, the Petitioner and Patent Owner have agreed to end the related district court litigation, and both Petitioner and Patent Owner agree that this *inter partes* review should be terminated.

### **II. A True Copy of the Written Settlement Agreement is Attached**

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the written Settlement Agreement resolving the dispute underlying this review has been made in writing, and is contemporaneously filed herewith as Exhibit 1029.

### **III. Request that Agreement Be Treated as Confidential and Kept Separate**

Petitioner and Patent Owner jointly request that this Settlement Agreement (Ex. 1029): (a) be treated as business confidential information, (b) be kept separate from the file of the involved patent, and (c) be made available only as permitted, pursuant to the provisions of 35 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c).

#### IV. Summary

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of *Inter Partes* Review No. IPR2014-00993 involving U.S. Patent No. 8,459,346 B1, and jointly request that the Settlement Agreement (Ex. 1029) be kept confidential and separate. Should this review be terminated, as jointly requested by the parties, no estoppel under § 315(e) shall attach to Petitioner. 35 U.S.C. § 317(a).

The Patent and Trial Appeal Board is hereby authorized to charge any fees associated with the filing to Deposit Account 02-1818.

Date: December 9, 2014

Respectfully submitted,

By: /Jason A. Engel/  
Reg. No. 51,654  
Jason A. Engel  
K&L GATES LLP  
e-mail: jason.engel@klgates.com  
70 W. Madison St., Suite 3100  
Chicago, Illinois 60602

*Lead Counsel for Petitioner*

By: /Robb D. Edmonds/  
Reg. No. 46,681  
Robb D. Edmonds  
EDMONDS & NOLTE, P.C.  
e-mail: redmonds@edmondsnolte.com  
2625 Bay Area Blvd., Suite 530  
Houston, Texas 77058

*Lead Counsel for Patent Owner*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that the foregoing Joint Motion to Terminate and Joint Request to Keep Separate were electronically served via e-mail on December 9, 2014 in its entirety on:

Robb D. Edmonds  
[redmonds@edmondsnolte.com](mailto:redmonds@edmondsnolte.com)

N. Alexander Nolte  
[anolte@edmondsnolte.com](mailto:anolte@edmondsnolte.com)

*Lead and Back-up Counsel for Patent Owner*

By:  /Jason A. Engel/  
Reg. No. 51,654  
Jason A. Engel  
K&L GATES LLP  
e-mail: [jason.engel@klgates.com](mailto:jason.engel@klgates.com)  
70 W. Madison St., Suite 3100  
Chicago, IL 60602

*Lead Counsel for Petitioner*