

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EURAMAX INTERNATIONAL, INC.,
Petitioner,

v.

INVISAFLOW, LLC,
Patent Owner.

Case No. IPR2016-00423
Patent 8,556,195

Filed: June 16, 2016

JOINT MOTION TO TERMINATE FOR SETTLEMENT
PURSUANT TO 35 U.S.C. § 317

I. PRECISE RELIEF REQUESTED

Petitioner Euramax International, Inc., and Patent Owner Invisaflo, LLC (collectively, “the Parties”), by and through their respective counsel, jointly request termination of the above-captioned *inter partes* review proceeding of U.S. Patent No. 8,556,195 (“the ‘195 patent”) pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74. The parties have fully and finally resolved the dispute between them and entered into a Settlement Agreement effective May 31, 2016 (“Agreement”) formally settling the dispute.

On June 3, 2016, the Parties emailed the Board to request the Board’s authorization to file a joint motion to terminate the above-captioned *inter partes* review proceeding. The Parties also sought the Board’s authorization to file with the motion to terminate a request to treat the written Agreement as business confidential information. On June 7, 2016, the Board authorized the Parties to file both a motion to terminate and a request to treat the agreement as business confidential information.

II. REASONS FOR GRANTING THE MOTION

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board authorized filing of the instant motion on June 7, 2016. Guidance as to the content of a motion to terminate is

provided in IPR2013-00428, Paper No. 56. There, the Board indicated that a joint motion, such as this one, should (a) include a brief explanation as to why termination is appropriate; (b) identify all parties in any related litigation involving the patent at issue; (c) identify any related proceedings currently before the Office; and (d) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding. *Id.* at 2. This motion satisfies each of the above requirements and is accompanied by the Agreement made in connection with termination of this proceeding, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 (b).

A. Brief Explanation of Why Termination is Appropriate

Termination is appropriate because this proceeding is in its very early stages: Patent Owner has not filed its Response to the Petition or any Motion to Amend the Claims, Petitioner has not filed its Reply to the Patent Owner's Response, the Parties have not filed motions to exclude, oral argument has not been held, the Board has not decided the merits of the proceeding, and a final written decision has not been issued. By virtue of the Agreement, the dispute between the Parties has been resolved, including the Parties' related litigation regarding the '195 patent: *Invisaflo, LLC v. Euramax International, Inc. et al.*, 1:14-cv-03026-MHC (N.D. Ga). Per the Agreement, the Parties filed a Stipulation of Dismissal with Prejudice of the related litigation on June 2, 2016 and the Court approved entry of the

stipulated dismissal with prejudice on June 3, 2016. There are no other pending cases involving the '195 patent.

B. All Parties in Any Pending Related Litigation Involving the Patent at Issue

In addition to Petitioner, Euramax Holdings, Inc. was named as a defendant in the above-identified litigation. That litigation has been dismissed as to Euramax Holdings, Inc. as well as to Petitioner. No future litigation amongst the Parties or their affiliates involving the '195 patent is contemplated under the terms of the Agreement.

C. Related Proceedings Currently Before the Office

There are no related proceedings pending before the Office.

D. Current Status of Each Such Related Litigation or Proceeding

With respect to each party in any related litigation or proceeding, Sections II.B and II.C above indicate the status of each related litigation or proceeding with respect to each party to the litigation or proceeding. The related litigation has been dismissed with prejudice as to all parties and there are no related proceedings before the Office.

III. AGREEMENT

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Agreement is in writing, and a true and correct copy is being filed concurrently herewith as

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Exhibit A.¹ The Parties are also filing concurrently herewith a joint request under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) to treat the Agreement as business confidential information to be kept separate from the file of the involved patents. As stated in 35 U.S.C. § 317(a), because Petitioners and Patent Owner request this termination as to Petitioner, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner or to a real party in interest or privity of the Petitioner.

IV. CONCLUSION

For all these reasons, the Parties respectfully request termination of the *Inter Partes* Review of U.S. Patent No. 8,556,195, Case No. IPR2016-00423.

Respectfully submitted, this 16th day of June, 2016.

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Lead Counsel for Petitioner

By: /Andrew R. Shores/
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Back-up Counsel for Patent Owner

¹ The Agreement is being filed via the Patent Review Processing System (PRPS) with access to the “Parties and Board only.”

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