

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

H&S MANUFACTURING COMPANY, INC.

Petitioner,

v.

OXBO INTERNATIONAL CORPORATION

Patent Owner.

Case IPR2016-00950
Patent 8,166,739

JOINT MOTION TO TERMINATE PROCEEDING PURSUANT

TO

35 U.S.C. § 317(A)

JOINT NOTICE OF SETTLEMENT PURSUANT TO

35 U.S.C. § 317(B) AND 37 C.F.R. § 42.74

RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a-b), and as authorized by Paper 50, Petitioner H&S Manufacturing Company, Inc. (“H&S”) and Patent Owner Oxbo International Corporation (“Oxbo”) provide notice that they have settled their disputes regarding U.S. Patent No. 8,166,739 (“the ’739 patent”) and jointly request termination of Case No. IPR2016-00950.

This paper accompanies a joint request by the Parties that the Patent Trial and Appeal Board (“Board”) treat Exhibits 2023 and 2024 submitted herewith as confidential business information and keep those exhibits separate from the file of the involved patent.

STATEMENT OF REASONS FOR THE RELIEF REQUESTED

The Parties have reached a settlement agreement regarding their disputes relating to the ’739 Patent. In response to the requirements outlined in Paper 50, and pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, the Parties submit concurrently with this Motion the Binding Term Sheet for Settlement Agreement (the “Term Sheet”) entered on July 31, 2017, and the final Settlement Agreement entered on August 9, 2017 (the “Settlement Agreement”) between the parties (EX2023 and EX2024, respectively).

In support of this Motion, the Parties further provide notice as follows:

First, termination of this proceeding is appropriate. The Oral Hearing in this proceeding, scheduled for August 1, 2017, was canceled on July 31, 2017 at the Parties' request, before both parties completed filing of their respective demonstratives.¹ Thus, the Parties have not completed their submissions or fully argued their respective positions, and the Board has not issued a final written decision.

Second, the Parties represent that the current status of the litigation involving the '739 Patent identified in Patent Owner's Mandatory Notices (Paper 5), captioned *Oxbo Int'l Corp. v. H&S Mfg. Co.*, No. 15-cv-00292, (W.D. Wis.), is as follows: A final judgment and a permanent injunction involving four Oxbo patents including the '739 patent were entered by the district court on August 3, 2017, copies of which are submitted concurrently as EX2025 and EX2026, respectively. Furthermore, the Term Sheet and Settlement Agreement prohibit the Parties from bringing any post-trial motions or appealing any issues in the litigation. Thus, all patent issues between the Parties, including those relating to the

¹ Although Petitioner submitted its demonstratives on July 27, 2017 as EX1032, Patent Owner did not file its demonstratives due to cancellation of the August 1, 2017 Oral Hearing.

'739 patent, are resolved by the Term Sheet and Settlement Agreement.²

Accordingly, no district court litigation related to the '739 patent is currently pending, and the attached settlement documents fully resolve all underlying disputes between the parties.

In accordance with Paper 50, the undersigned counsel for both Parties hereby certify that the Term Sheet and Settlement Agreement represent a true copy of all current agreements and understandings between the parties that are made in connection with, or in contemplation of, the joint request for termination of this proceeding.

The Parties submit concurrently with this Motion a Request to Treat EX2023 and EX2024 as business confidential information.

Accordingly, the Parties jointly request that the Board terminate this IPR pursuant to 35 U.S.C. § 317(a).

² The Parties notified the Board of the settlement and requested cancellation of the Oral Hearing following execution of the Term Sheet, which required a Settlement Agreement containing all material conditions of the Term Sheet. The Term Sheet also provided that in the event a final Settlement Agreement could not be reached in the required timeframe, the Term Sheet would become binding.

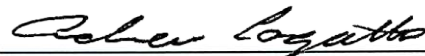
CONCLUSION

For the reasons stated above, the Parties respectfully request that the Board terminate *Inter Partes* Review of U.S. Patent No. 8,166,739, Case No. IPR2016-00950.

Respectfully submitted,

MERCHANT & GOULD, P.C.

Date: August 10, 2017



Andrew J. Lagatta, Reg. No. 62,529
Merchant & Gould P.C.
80 South 8th St., Suite 3200
Minneapolis, MN 55402
Telephone: (612) 332-5300
Fax: (612) 332-9081
alagatta@merchantgould.com
OxboIPR@merchantgould.com

(Trial No. IPR2016-00950)

ATTORNEYS FOR PATENT OWNER

PATTERSON THUENTE PEDERSEN,
P.A.

Date: August 10, 2017



Brad D. Pedersen (Reg. No. 32,432)
Eric H. Chadwick (Reg. No. 42,664)
PATTERSON THUENTE PEDERSEN,
P.A.
80 South Eighth Street, Suite 4800
Minneapolis, MN 55402
Phone: (612) 349-5740
Facsimile: (612) 349-9266
chadwick@ptslaw.com
pedersen@ptslaw.com

(Trial No. IPR2016-00950)

ATTORNEYS FOR PETITIONER

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.