

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIM MAINTENANCE INC.,

Petitioner,

v.

P&RO SOLUTIONS GROUP, INC.

Patent Owner.

Case IPR2017-00516

Patent 8,209,205

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW
OF CLAIMS 1-20 OF U.S. PATENT NO. 8,209,205 PURSUANT TO 35
U.S.C. § 317 AND 37 C.F.R. § 42.74**

130733.00110/106332858

Pursuant to 37 C.F.R. § 42.74, Patent Owner P&RO Solutions Group, Inc. (“P&RO”) and Petitioner CiM Maintenance Inc. (“CiM”) jointly request termination of Case IPR2017-00516, which is directed to claims 1-20 of U.S. Patent No. 8,209,205 (“the ‘205 Patent”).

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317, P&RO and CiM jointly request termination of this *inter partes* review.

II. EXPLANATION OF WHY TERMINATION IS APPROPRIATE

The parties have reached a written agreement to terminate this IPR proceeding. A “Request That Agreement Be Treated as Business Confidential Information and Kept Separate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74” is being filed concurrently with this Joint Motion to Terminate. *See* 35 U.S.C. § 317(b) (requiring parties to file agreements in writing with the Office).

The Board previously provided authorization to file this motion on November 13, 2017.

The patent involved in this proceeding, the ‘205 Patent, was held invalid under 35 U.S.C. § 101 by Judge Schroder in the Eastern District of Texas on

March 31, 2017, and the underlying lawsuit was dismissed. *P&RO Solutions Group, Inc. v. CiM Maintenance Inc.*, C.A. No. 6:16-cv-00095-RWS (E.D. Tex.).

The parties involved in this proceeding believe that termination of this review is appropriate because the written agreement includes the P&RO's agreement not to sue CiM for infringement of any claims of the '205 Patent or appeal the final judgment of the district court in the corresponding litigation in exchange for CiM agreeing to move to terminate these *inter partes* review proceedings.

Therefore, termination of this case is appropriate because (1) final judgment has been entered in the corresponding district court litigation; (2) the written covenant not to sue between the parties settles all material disputes related to the '205 Patent between the parties; and (3) the parties to this case agree that this *inter partes* review should be terminated.

III. IDENTIFICATION OF ALL PARTIES IN RELATED LITIGATION

P&RO and CiM are the only parties in the district court action referenced above. There are no other pending litigations between the parties.

IV. IDENTIFICATION OF RELATED PROCEEDINGS BEFORE THE OFFICE

There are currently no other proceedings before the Office concerning the

'205 Patent, nor are there any other proceedings before the Office involving both P&RO and CiM.

V. CONCLUSION

For the foregoing reasons, P&RO and CiM respectfully request termination of the *inter partes* review of claims 1-20 of the '205 Patent.

Respectfully submitted,

Dated: November 17, 2017

By: /Michael C. Greenbaum/

Michael C. Greenbaum (Reg. No. 28,419)
BLANK ROME LLP
1825 Eye Street NW
Washington, DC 20006
Phone: (202) 772-5836
Greenbaum@BlankRome.com

Counsel for Patent Owner

/Abran J. Kean/

Abran J. Kean (Reg. No. 58,540)
ERISE IP, P.A.
5600 Greenwood Plaza Blvd., Suite 200
Greenwood Village, CO 80111
T: 913.777.5600
F: 913.777.5600
abran.kean@eriseip.com

Counsel for Petitioner CiM Maintenance Inc.

CERTIFICATE OF SERVICE

I hereby certify that on November 17, 2017, the foregoing **JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF CLAIMS 1-20 OF U.S. PATENT NO. 8,209,205 PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74** was electronically filed with the Patent and Appeal Board using the PRPS system, which will send notification of such filing to all counsel of record, and mailed to counsel of record through Priority Mail Express.

Abran J. Kean, abran.kean@eriseip.com
ERISE IP, P.A.
5600 Greenwood Plaza Blvd., Suite 200
Greenwood Village, CO 80111

Eric A. Buresh, eric.buresh@eriseip.com
ERISE IP, P.A.
6201 College Blvd., Suite 300
Overland Park, KS 66211

/Michael C. Greenbaum/
Michael C. Greenbaum (Reg. No. 28,419)
BLANK ROME LLP
1825 Eye Street NW
Washington, DC 20006
Phone: (202) 772-5836
Greenbaum@BlankRome.com
Counsel for Patent Owner