

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WEATHERFORD INTERNATIONAL, LLC

Petitioner,

v.

BAKER HUGHES OILFIELD OPERATIONS, LLC

Patent Owner.

Case IPR2019-00768

Patent RE46,137

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Weatherford International, LLC (“Weatherford”) and Patent Owner Baker Hughes Oilfield Operations, LLC (“Baker Hughes”) jointly move to terminate this *inter partes* review (IPR). The Board authorized the filing of this Joint Motion in an email dated August 25, 2020.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

A. The Parties Settled the Underlying Dispute

The parties settled their underlying dispute and reached agreement to terminate this IPR in a written settlement agreement. A true copy of the settlement agreement is submitted as Exhibit 1050 in accordance with 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(b). The parties request that the settlement agreement be treated as business confidential information, to be kept separate from the file of the involved patent, and to be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). There are no collateral agreements or understandings made in connection with the termination of this IPR.

Termination of this proceeding is being requested concurrently with a similar request in IPR2019-00708, a second proceeding involving the same U.S. Patent No. RE46,137. Additionally, the parties are jointly requesting dismissal of *Baker*

Weatherford International v. Baker Hughes
Patent No. RE46,137 - IPR2019-00768

Hughes Oilfield Operations, LLC v. Weatherford International, LLC, No. 4-18-cv-4797 (S.D. Tex. 2018) (“Court Action”), which also involves U.S. Patent No. RE46,137. Other than IPR2019-00708, IPR2019-00768, and the Court Action, there are no litigation matters or proceedings between the parties involving U.S. Patent No. RE46,137.

No other petitioners remain in this IPR. Thus, the parties respectfully submit that termination of the IPR is appropriate under 35 U.S.C. § 317 and 37 C.F.R. § 42.74(a).

B. The Co-pending Ex Parte Reexamination Preserves the Public’s Interest in the Status of the Challenged Claims

In *ex parte* reexamination app. no. 90/014,418, the Office is considering the patentability of each of the challenged claims (Order Granting Request for *Ex Parte* Reexamination at 10), and it will do so in view of this IPR’s record (*see* 35 U.S.C. § 303(a) (“On his own initiative ... the Director may determine whether a substantial new question of patentability is raised”)), which has been or will be submitted in an information disclosure statement. Thus, the status of the challenged claims will be decided with or without a final written decision in this IPR.

Weatherford International v. Baker Hughes
Patent No. RE46,137 - IPR2019-00768

ARMOND WILSON LLP

Dated: August 25, 2020

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Dated: August 25, 2020

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), true copies of this **JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW** and **EXHIBIT 1050** are being served electronically on August 25, 2020 to the following lead and back-up counsel for Patent Owner at the following email addresses:

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