

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENSIGN US SOUTHERN DRILLING LLC
Petitioner

v.

C&M OILFIELD RENTALS, LLC
D/B/A C-MOR ENERGY SERVICES
Patent Owner of Record

Case No. IPR2023-00804

Patent No. 10,976,016

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

JOINT MOTION TO TERMINATE PROCEEDING

Pursuant to 35 U.S.C. § 317, Patent Owner C&M Oilfield Rentals, LLC d/b/a C-MOR Energy Services and Petitioner Ensign US Southern Drilling LLC (collectively, the “Parties”) jointly request termination of this proceeding, IPR2023-00804 directed to U.S. Patent No. 10,976,016 (“’016 Patent”). In accordance with 37 C.F.R. 42.20(b), the Parties sought authorization to file this motion, and the Board provided such authorization by email on April 25, 2024.

Inter partes review of the ’016 Patent was instituted on October 26, 2023. *See* Paper No. 8. Oral argument is not set to occur until July 30, 2024. Paper No. 9. There has been no final written decision.

Petitioner and Patent Owner have executed a confidential settlement agreement, which settled their dispute regarding the ’016 Patent, including this proceeding and Patent Owner’s assertion of the ’016 Patent in the related district court litigation, *C&M Oilfield Rentals, LLC d/b/a C-MOR Energy Services v. Ensign US Southern Drilling LLC*, Case No. 4:22-CV-00965 (S.D. Tex.). In accordance with the Parties’ agreement, the related district court litigation will be dismissed.

Termination is proper under 35 U.S.C. § 317(a) because the Parties are jointly requesting termination, and the Office has not yet “decided the merits of the proceeding before the request for termination is filed.” *See* 35 U.S.C. § 317(a); Consolidated Trial Practice Guide, 86 (Nov. 2019) (“There are strong

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public policy reasons to favor settlement between the parties to a proceeding.”).

The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by the termination of this proceeding. The Parties further confirm that the grant of this Joint Motion to Terminate will fully dispose of IPR2023-00804.

In accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the Parties’ settlement agreement has been made in writing, and a true copy of the agreement is being filed as Exhibit 1057, along with a joint motion under 37 C.F.R. § 42.74(c) to treat the settlement agreement as business confidential information and for it to be kept separate from the files of the involved patent in this proceeding.

The Parties certify that there are no other collateral agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.

For the foregoing reasons, the Parties jointly request termination of this *inter partes* review proceeding.

Dated: April 30, 2024

Respectfully Submitted,

/Gregory L. Porter/

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JOINT MOTION TO TERMINATE PROCEEDING
CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.6

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on April 30, 2024 the foregoing:

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was served via electronic filing with the Board and via Electronic Mail at the designated email for the practitioners of record for Patent Owner:

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Gregory L. Porter, Reg. No. 40,131

ATTORNEY FOR PETITIONER