

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.

IPR2023-00804 (Patent 10,976,016 B2)
IPR2024-00005 (Patent 10,900,626 B2)¹

Before BRIAN J. McNAMARA, NORMAN H. BEAMER,
KEVIN C. TROCK, and JULIA HEANEY, *Administrative Patent Judges*.²

HEANEY, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ The Board is entering the same Order in both captioned cases. The parties are not authorized to use this combined case caption.

² This is not an expanded panel. Three of the listed judges are on each case.

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With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed Joint Motions to Terminate in the above-identified proceedings. IPR2023-00804, Paper 37; IPR2024-00005, Paper 11 (collectively, “Joint Motion”). In support of the Motions, the Parties filed a copy of a Settlement Agreement (IPR2023-00804, Ex. 1057; IPR2024-00005, Ex. 1061), as well as Joint Requests to Treat the Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). IPR2023-00804, Paper 38; IPR2024-00005, Paper 13 (collectively, “Joint Request”).

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

In the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of the above-identified proceedings, and that the filed copy of the Settlement Agreement is a true and complete copy. Joint Motion, 2–3.³ The Parties further represent that their settlement agreement resolves all currently pending Patent Office and District Court proceedings between the Parties involving the above-identified patents. *Id.* at 2.

We have not yet decided the merits of the above-identified proceeding, and final written decisions have not been entered.

³ For convenience, we cite solely to the papers in IPR2023-00804.

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Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also filed Joint Requests that the Settlement Agreement be treated as business confidential information and be kept separate from the file of the respective patents involved in these proceedings. Joint Request, 2. After reviewing the Settlement Agreement between Petitioner and Patent Owner, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement between Petitioner and Patent Owner as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

The Parties further request that “should a third party submit a written request to the Board for a copy of the settlement agreement,” the Parties receive “notification of the request and an opportunity to respond thereto.” Joint Request, 2. We have no such procedure to serve upon the Parties a request for access to the Settlement Agreement, and, further, our regulations do not require us to do so. Accordingly, we *deny* this portion of the Parties’ Joint Requests.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

Accordingly, it is:

ORDERED that the Joint Motions to Terminate are *granted*;

FUTHER ORDERED that IPR2023-00804 and IPR2024-00005 are *terminated*; and

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FURTHER ORDERED that the Joint Requests are *granted-in-part*, and the Settlement Agreement (IPR2023-00804, Ex. 1057; IPR2024-00005, Ex. 1061) shall be treated as business confidential information, shall be kept separate from the files of the challenged patents and made available only under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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