

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERMAX COMPANY,
Petitioner,

v.

ILLINOIS TOOL WORKS INC.,
Patent Owner.

Case IPR2024-00072
U.S. Patent 11,578,740

**JOINT MOTION TO TERMINATE PROCEEDING
IN VIEW OF SETTLEMENT**

35 U.S.C. § 317

Joint Motion to Terminate In View of Settlement
IPR2024-00072

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, and as authorized by the Board, Petitioner Termax Company (“Petitioner”) and Patent Owner Illinois Tool Works Inc. (“Patent Owner”) jointly request termination of this proceeding, IPR2024-00072, directed to U.S. Patent No. 11,578,740.

Petitioner and Patent Owner have settled their dispute regarding the ‘740 patent, including both this proceeding and Patent Owner’s assertion of the ‘740 patent in the related district court litigation, *Illinois Tool Works Inc. v. Termax Company*, Case No. 1:20-cv-05416 (N.D. Ill.). The parties do not anticipate further litigation between them concerning the ‘740 patent. A true and accurate copy of the parties’ settlement agreement is being filed as Exhibit 1017 as required by 37 C.F.R. § 42.74(b), along with a joint request 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). 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.

With respect to the stage of the proceeding, the Petition was filed on October 19, 2023 and was accorded a filing date on October 26, 2023. A trial has not yet been instituted, and a Patent Owner Preliminary Response would be due January 26, 2024.

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Accordingly, good cause exists to terminate this proceeding because the parties have settled their dispute regarding the '740 patent and the Board has not decided the merits of the proceeding. See 35 U.S.C. § 317; Consolidated Trial Practice Guide, 86 (Nov. 2019). Terminating the proceeding now would thus serve the interests of judicial economy as well as the mutual interest of the parties. See Consolidated Trial Practice Guide, 86 (Nov. 2019) (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”).

Dated: January 2, 2024

Respectfully submitted,

By: /Raymond Ricordati, III/
Raymond Ricordati, III
Reg. No. 62,856
Counsel for Petitioner

By: /Eligio C. Pimentel/
Eligio C. Pimentel
Reg. No. 42,076
Counsel for Patent Owner

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Joint Motion to Terminate In View of Settlement** was served on January 2, 2024, via email to the Petitioner as indicated below:

Eligio C. Pimentel – epimentel@mcandrews-ip.com
Christopher M. Scharff – cscharff@mcandrews-ip.com

/Raymond R. Ricordati, III /
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