

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRUCTURAL WRAP, LLC,
Petitioner

v.

SYSTEM STORMSEAL PTY LTD, STORMSEAL USA, LLC,
Patent Owner

Case IPR2024-00084
Patent 11,168,484

**PATENT OWNER AND PETITIONER STRUCTURAL WRAP, LLC'S
JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317**

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a), Petitioner Structural Wrap Inc. (“Structural Wrap”) and Patent Owner, System Stormseal Pty Ltd and Stormseal USA LLC (collectively, “Stormseal”), jointly move the Patent Trial and Appeal Board (“Board”) to terminate this proceeding in its entirety.

The parties received authorization to file this Motion to Terminate on June 11, 2024.

II. STATEMENT OF FACTS

Structural Wrap filed its petition for *inter partes* review against U.S. Patent No. 11,168,484 (“’484 Patent”) on October 28, 2023, and Patent Owner filed a preliminary response on February 13, 2024. On May 9, 2024, the Board instituted this *inter partes* review.

Structural Wrap and Stormseal have agreed to move to terminate this *inter partes* review relating to the ’484 Patent and to narrow the pending related district court litigation so that all remaining disputes—including the validity of the ’484 Patent—can be determined in district court with trial scheduled for September 2024. The parties’ Joint Stipulation, filed with the district court, has been made in writing, and a true and correct copy will be concurrently filed as Exhibit 2013. There are no collateral agreements.

III. REASONS WHY TERMINATION IS APPROPRIATE

Case No. 9:22-cv-81726-AHS with the Southern District of Florida between Stormseal and Structural Wrap remains pending (the “Florida Litigation”) with trial set for September 23, 2024. Termination of this IPR proceeding is appropriate because the parties are jointly requesting termination, the IPR proceeding remains in its early stages with a decision still nearly one-year away, and the Board has not yet “decided the merits of the proceeding.” *Samsung Electronics Co., Ltd. et al v. Neodron Ltd.*, IPR2020-01682, Paper 14, 3 (February 18, 2021); *see also Samsung*

Electronics Co., Ltd. v. Fundamental Innovation Systems Int'l, IPR2018-00605, Paper 10, 2 (PTAB July 16, 2018). Accordingly, termination is appropriate here.

Specifically, the parties seek termination in light of their joint stipulation to narrow the claims and issues in dispute in the district court and to thus try all remaining issues between the parties in that forum. A copy of the stipulation, which was filed with the district court, is attached as Exhibit 2013. The stipulation was entered into in contemplation of terminating this IPR proceeding, and certain of its provisions are contingent upon the termination of the IPR proceeding. There are no collateral agreements or understanding made in connection with, or in contemplation of, the termination of the proceeding. *See* 37 C.F.R. § 42.74(b). Accordingly, the agreement, and termination of this proceeding, will permit the parties to resolve all of their disputes more quickly and efficiently.

Further, the Court in the Florida Litigation has denied a motion to stay the case pending the IPR decision. The Florida Litigation will go to trial (September 23, 2024) prior to a final decision (earliest 2025) being entered in this proceeding. Dismissal of this IPR proceeding would allow Structural Wrap to pursue its invalidity grounds in the Florida Litigation in defense to Stormseal's infringement claims relating to the '484 Patent.

The parties understand that if the Board terminates this IPR proceeding, no estoppel under 35 U.S.C. § 315(e) or 37 C.F.R. § 42.73(d)(1) will attach to Petitioner. The Parties understand that if the Board terminates the IPR proceeding before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

IV. CONCLUSION

Wherefore, Structural Wrap and Stormseal respectfully request that the Board grant the parties' Joint Motion to terminate IPR2024-00084.

Dated: June 11, 2024

Respectfully submitted,

/s/ Christian Sanchelima
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on June 11, 2024, the foregoing document is being served by email by agreement of the parties to all counsel of record.

/s/ Ryan Loveless
Ryan Loveless