

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.

IPR2024-00084
Patent 11,168,484 B2

Before DONNA M. PRAISS, KRISTINA M. KALAN, and
JULIA HEANEY, *Administrative Patent Judges*.

PRAISS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Structural Wrap, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–3 of U.S. Patent No. 11,168,484 B2 (Ex. 1001, “the ’484 patent”). Paper 2. System Stormseal Pty Ltd. and Stormseal USA, LLC (“Patent Owner”) filed a Preliminary Response. Paper 8.

On May 9, 2024, the Board instituted an *inter partes* review of claims 1–3 in the ’484 patent. Paper 13.

On June 11, 2024, after receiving Board authorization, Petitioner and Patent Owner filed a Joint Motion to Terminate this proceeding under 35 U.S.C. § 317(a). Paper 15 (“Mot.”). Along with the Joint Motion, the Parties filed a copy of a Joint Stipulation. Ex. 2013 (“Joint Stip.”).

II. DISCUSSION

The parties represent that they “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.” Mot. 2.¹ The parties represent that the Joint Stipulation has been filed in District Court in “Case No. 9:22-cv-81726-AHS with the Southern District of Florida between Stormseal and Structural Wrap.” *Id.* The parties also represent that the Joint Stipulation is “a true and correct copy” (*id.*) and that “[t]here are no collateral agreements or understanding made in connection with, or in contemplation of, the termination of the proceeding.” *Id.* at 3; *see* Joint Stip. 1.

Further, the parties assert that termination of this *inter partes* review is appropriate because: (1) “[d]ismissal of this IPR proceeding would allow Structural Wrap to pursue its invalidity grounds in” the district court litigation (Paper 15, 3) and (2) “the IPR proceeding remains in its early stages with a decision still nearly one-year away.” *Id.* at 1.

¹ Citations herein to the Joint Motion refer to the sequential pages in the Joint Motion, which is not paginated.

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.

We have not yet decided the merits of the proceeding, and no final written decision has been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, the parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the above-captioned *inter partes* review proceeding with respect to the parties.

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

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate IPR2024-00084 is *granted*, and

FURTHER ORDERED that IPR2024-00084 is *terminated* with respect to Petitioner and Patent Owner.

IPR2024-00084
Patent 11,168,484 B2

For PETITIONER:

Megan Raymond
Jon Baughman
GROOMBRIDGE, WU BAUGHMAN & STONE LLP
Megan.raymond@groombridgewu.com
Steve.baughman@groombridgewu.com

Christian Sanchelima
Jesus Sanchelima
SANCHELIMA & ASSOCIATES, P.A.
chris@sanchelima.com
jesus@sanchelima.com

For PATENT OWNER:

Ryan Loveless
Travis Lee Richins
LOVELESS LAW GROUP
ryan@lovelesslawgroup.com
travis@lovelesslawgroup.com