

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOIL BOARDING COMPANY, INC. and
BOMBARDIER RECREATIONAL PRODUCTS, INC.

Petitioner,

v.

MHL CUSTOM, INC.

Patent Owner.

IPR2024-00085 (Patent 9,586,659 B2)

JOINT MOTION TO TERMINATE PROCEEDING

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 9,586,659 (“’659 Patent”)
1002	Declaration of Stefan Brizzolara, Ph.D.
1003	Certified English Translation of Evolo slutrapport (“Evoloreport”)
1004	Affidavit of Bjorn Lofgren Regarding Translation of Evoloreport
1005	Swedish-Language Version of Evolo slutrapport
1006	YouTube.com, <i>Evolo prototype run</i> [https://www.youtube.com/watch?v=a-_OCN50aWo&t=10s] (“Evoloprototypelrun”)
1007	Screenshot of Evoloprototypelrun Page Information
1008	YouTube.com, <i>Evolo movie</i> [https://www.youtube.com/watch?v=zL9fO8tF118] (“Evolomovie”)
1009	Screenshot of Evolomovie Page Information
1010	YouTube.com, <i>Test run – the new Torqeedo 4.0 R installed on Evolo!!!</i> [https://www.youtube.com/watch?v=fKOQ0JwQnjc] (“Evolotorqeedo”)
1011	U.S. Patent No. 6,443,786 (“Woolley”)
1012	U.S. Patent No. 4,020,782 (“Gleason”)
1013	U.S. Patent No. 8,290,636 (“Manning”)
1014	Torqeedo Motor Operating Manual for Torqeedo Cruise 2.0 S/L
1015	U.S. Patent No. 9,586,659 (“’659 Patent”)
1016	Prosecution History of ‘044 Patent
1017	Prosecution History of ‘659 Patent
1018	Declaration of Jakob Kutenkeuler

Exhibit	Description
1019	Affidavit of Ingmarie Rohdin Regarding English Language Translation of Batnytt Magazine Article; Swedish Language Version of Batnytt; English Translation of Båtnytt Magazine Article (“Batnytt”)
1020	Affidavit of Ingmarie Rohdin Regarding Translation of Batnytt Magazine Viewership Information for 2009; Swedish Language Version of Batnytt Viewership Information; English Language Translation of Batnytt Viewership Information (“BatnyttViewership”)
1021	Internet Archive Declaration of Nathaniel E Frank-White
1022	Screenshot of EvoloTorqeedo Page Information
1023	Claim Construction Order from <i>MHL CUSTOM, INC. v. WAYDOO USA, INC. and SHENZHEN WAYDOO INTELLIGENCE TECHNOLOGY CO., LTD</i> , C.A. No. 21-0091-RGA
1024	Stipulation and Order Staying Proceedings from <i>MHL CUSTOM, INC. v. FOIL BOARDING COMPANY, INC.</i> , No. 3:22-cv-21258
1025	Confidential Settlement Agreement between Foil Boarding Company, Inc. and MHL Custom, Inc.

Petitioner Foil Boarding Company, Inc. (“Foil”) and Patent Owner MHL Custom, Inc. (“MHL”) (collectively, “the Parties”) have reached a settlement. Newly joined Petitioner Bombardier Recreational Products, Inc., is not a party to this settlement, nor are they joining in this motion. Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, the Parties’ joint request to the Board on January 10, 2025, and the Board’s authorization on January 15, 2025, Petitioner Foil and Patent Owner move to terminate the present *inter partes* review proceeding with respect to Foil’s participation only.

I. STATEMENT OF FACTS

Petitioner Foil and Patent Owner have reached agreement (the “Settlement Agreement”) to resolve their disputes.

Pursuant to 37 C.F.R. § 42.74(b), the Settlement Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 1025. The Settlement Agreement is being filed electronically with access to “Board Only.” A “*Joint Request to Treat Settlement Agreement as Business Confidential Information*” is being filed concurrently with this Joint Motion to Terminate Proceeding, to treat the Settlement Agreement as business confidential information and to keep it separate from the files of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. §42.74(c).

On January 15, 2025, the Board authorized the Parties to file a Joint Request to Terminate with respect to Foil's participation in the Trial only.

II. RELIEF REQUESTED

Termination of this *inter partes* review with respect to Foil is requested, and the Parties respectfully submit that such termination is justified. "There are strong public policy reasons to favor settlement between the parties to a proceeding."

Consolidated Trial Practice Guide 86 (Nov. 2019). "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id.* (citing 35 U.S.C. § 317 (a)).

The Board should terminate this proceeding as the Parties jointly request, for the following reasons.

First, the Parties have met the statutory requirement that they file a "joint request" to terminate before the Office "has decided the merits of the proceeding." 35 U.S.C. § 317(a). Under section 317(a) an *inter partes* review shall be terminated upon such joint request "unless the Office has decided the merits of the proceeding before the request for termination is filed." There are no other preconditions recited in 35 U.S.C. § 317(a).

Second, the Parties have reached a settlement as to all the disputes in this proceeding and as to the '044 Patent. A true copy of the Settlement Agreement is filed concurrently herewith. *See* Confidential Ex. 1025. The parties request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of this proceeding in accordance with 37 C.F.R. § 42.74(c). There are no other agreements, written or oral, between or among the parties made in connection with, or in contemplation of, the dismissal of the proceeding.

Third, termination would save significant further expenditure of resources by the Parties. Termination upon settlement, as requested, would also further the purpose of *inter partes* review proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Further, maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have strong disincentive to settle if they perceived that an *inter partes* review would continue regardless of settlement.

III. CONCLUSION

For the foregoing reasons, Petitioner Foil and Patent Owner respectfully request termination of this *inter partes* review.

Dated: January 16, 2025

Respectfully Submitted,

/Douglas L. Bridges/
Douglas L. Bridges

Hunter Adams
Reg. No. 69,994
Lead Counsel

Douglas L. Bridges
Reg. No. 54,730
Backup Counsel

ADAMS IP LLC
453 Dauphin Street
Mobile, AL 36602
Telephone: 251-289-9787
hunter@adamsiplaw.com
doug@adamsiplaw.com
ATTORNEYS FOR
PETITIONER FOIL
BOARDING COMPANY, INC.

Dated: January 16, 2025

Respectfully Submitted,
/Robert J. Theuerkauf/
Robert J. Theuerkauf
Reg. No. 55,843
Lead Counsel

Megan E. Gibson
Reg. No. 76,236
Eric S. Barr
Reg. No. 60,150
Backup Counsel

GRAY ICE HIGDON
3939 Shelbyville Road, Suite 201
Louisville, Kentucky 40207
Telephone: (502) 677-4729

Facsimile: (502) 561-0442

rjt@grayice.com

mgibson@grayice.com

cbarr@grayice.com

ATTORNEY FOR PATENT OWNER

MHL CUSTOM, INC.

CERTIFICATE OF SERVICE

I certify that on January 16, 2025, I caused a true and correct copy of the foregoing Joint Request to Terminate Proceedings to be served on the Patent Owner and the newly joined Petitioner via electronic mail to counsel of record below:

Robert Theuerkauf (rjt@grayice.com)

Meagan Gibson (mgibson@grayice.com)

Eric S. Barr (cbarr@grayice.com)

David L. Cavanaugh (david.cavanaugh@wilmerhale.com) (excluding Confidential EX1025)

Alex Nemtzow (alex.nemtzw@wilmerhale.com) (excluding Confidential EX1025)

/Douglas L. Bridges/

Douglas L. Bridges

ADAMS IP LLC

453 Dauphin Street

Mobile, AL 36602

Telephone: 251-289-9787

doug@adamsiplaw.com