

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HILTI AKTIENGESELLSCHAFT,
Petitioner,

v.

SPECIFIED TECHNOLOGIES INC.,
Patent Owner.

Case No. IPR2024-00193
Patent No. 10,143,868

**JOINT MOTION TO TERMINATE PROCEEDING
PURSUANT TO 37 C.F.R. § 42.72**

I. INTRODUCTION

Pursuant to 37 C.F.R. §§ 42.71(a) and 42.72, Petitioner Hilti Aktiengesellschaft (“Petitioner”) and Patent Owner Specified Technologies Inc. (“Patent Owner”) jointly request termination of the *Inter Partes* Review of U.S. Patent No. 10,143,868 (“the ’868 Patent”) in IPR2024-00193. On July 11, 2024, the Parties informed the Board of a settlement agreement reached between Petitioner and Patent Owner via email and requested authorization to file a Joint Motion to Terminate the proceeding with respect to both the Patent Owner and Petitioner. On July 12, 2024, the Board authorized the parties to file this Joint Motion to Terminate. The parties have reviewed 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 and believe they are in compliance with these requirements.

Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding.

II. ARGUMENT

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.”

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

A. Brief Explanation As to Why Termination Is Appropriate

Petitioner and Patent Owner have agreed to a confidential binding term sheet, intended to be memorialized in a formal settlement agreement, that fully resolves this matter.¹ The Parties are concurrently filing a copy of the binding term sheet as Exhibit 2008 along with a request to treat it as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Further, pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge, as of the filing of this Motion and the concurrent Motion to Keep Confidential, that Exhibit 2008 represents a binding agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 2008 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

Importantly, the Parties “may terminate the proceeding...unless the Board has already decided the merits of the proceeding.” Consolidated Office Patent Trial Practice Guide, at 4 (November 2019). Here, the Board has not yet decided the merits

¹ In the event the Parties are unable to agree on the form of a formal settlement agreement, the Parties have agreed that the binding term sheet will constitute the binding settlement document.

of the proceeding, and the Parties have now settled their dispute and have reached agreement to terminate the Petition. In fact, not a single Due Date outlined in the Scheduling Order, (Dkt. No. 16), has passed.

Termination is appropriate because public policy favors terminating the present petition for *inter partes* review. Congress and federal courts have expressed a strong interest in encouraging settlement in litigation. *Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Fed. R. Civ. P.] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Federal Circuit places a particularly strong emphasis on settlement. *Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility between parties). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Consolidated Office Patent Trial Practice Guide, at 86 (Nov. 2019).

B. Identification of Parties and Status of Litigation

The ’868 Patent is subject to the following action: *Hilti Aktiengesellschaft v. Specified Technologies, Inc.*, Case No. 1:22-cv-01248-CJB (D. Del.), which is currently stayed pending formal dismissal consistent with the terms of the binding term sheet.

C. Identification and Status of Related Proceedings Before the USPTO

Petitioner has not filed any further Petition for *Inter Partes* Review related to the '868 Patent.

III. CONCLUSION

In view of the above, the Parties respectfully request that the above-captioned *inter partes* review, IPR2024-00193, be terminated.

Dated: July 15, 2024

Respectfully submitted,

/s/ W. Cook Alciati

W. Cook Alciati (*Pro Hac Vice*)

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CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of July, 2024, a copy of the foregoing was served by electronic mail on Petitioner's counsel, lead and back-up, as follows:

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Dated: July 15, 2024

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