

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLIANCE NORTH AMERICA, INC.
Petitioner

v.

MULTIQUIP INC.
Patent Owner

Case IPR2024-00211
Patent 8,816,651

**JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

LIST OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 8,816,651
1002	File History of U.S. Patent No. 8,816,651
1003	Declaration of Mr. Michael Nranian
1004	U.S. Patent Application Publication 2014/0150407 to Van Niekerk et al. (Van Niekerk)
1005	U.S. Patent 9,221,016 to Van Niekerk et al. (Van Niekerk 2)
1006	U.S. Patent Application Publication 2003/0224833 to Egan et al. (Egan)
1007	U.S. Patent 6,701,221 to Eaton et al. (Eaton)
1008	Deep Sea Electronics DSE720/7300 Series Operators Manual, Document Number 057-074, Issue 7 (February 4, 2011)(DSE Manual 7)
1009	U.S. Patent Application Publication 2006/0262807 to Aoki et al. (Aoki)
1010	U.S. Patent No. 6,422,001 to Sherman et al. (Sherman)
1011	Ultimate Service Association Information Sheet “Wet Stacking of Generator Sets and How to Avoid It (2012)
1012	Avtron Load Bank Article (July 29, 2008
1013	Volt Master America Engine Driven Generator Set Owner’s Manual Excerpt (May 2009)
1014	US Environmental Protection Agency, Technical Bulletin EPA -420-F-10-029, <i>Diesel Particulate Filter General Information</i> , (May 2010)
1015	US Environmental Protection Agency, Technical Bulletin EPA -452/F-03-031, <i>Diesel Oxidation Catalyst General Information</i> , (May 2020)
1016	US Environmental Protection Agency, Fact Sheet EPA -452/F-03-032, <i>Air Pollution Control Technology, Selective Catalytic Reduction (SCR)</i> , (2003)
1017	Power Engineering Article, Tier IV
1018	SAE J1939 Standards Collection
1019	U.S. Patent Application Publication 2004/0010349 to Perez et al. (Perez)
1020	U.S. Patent No. 8,209,962 to Sun et al. (Sun)
1021	Assignment of Van Niekerk Pat. Pub. 2014/0150407 to Cummins Cal Pacific, LLC
1022	Van Niekerk Original Application Drawings
1023	Van Niekerk Original Application Claims

1024	Excerpt of Multiquip Inc. Responses to Defendant's First Set of Requests for Production (1-50), Civil Action No. 3:22-cv-2599 (N.D. Tex.), Responses 11-13, 17, 21-22, 25-34, 44, 47-50.
1025	Multiquip Inc. Responses to Defendant's First Set of Interrogatories (1-10)
1026	U.S. Patent No. 5,583,440 to Bisher (Bisher)
1027	Declaration of John Ruddock
1028	JP Pat. Publication No. JP2000-162291 to Miyoshi, published June 16, 2000, together with certified translation.
1029	Document Update Checklist for 057-074_D128 for Deep Sea Electronics DSE72/7300 Series Operators Manual, Updating from Issue 6 to Issue 7.
1030	Document Update Checklist for 057-074_D128 for Deep Sea Electronics DSE72/7300 Series Operators Manual, Updating from Issue 7 to Issue 8.
1031	Document Update Checklist for 057-074_D128 for Deep Sea Electronics DSE72/7300 Series Operators Manual, Updating from Issue 8 to Issue 9.
1032	Deep Sea Electronics DSE720/7300 Series Operators Manual, Document Number 057-074, Issue 9 (May 30, 2012) (DSE Manual 9)
1033	Terex Tech Tips No. 87
1034	Declaration of Terence J. Linn
1035	Settlement Agreement

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.74, and the Board’s authorization of March 8, 2024, Petitioner Alliance North America, Inc. (“Petitioner”) and Patent Owner Multiquip Inc. (“Patent Owner”) jointly move to terminate the present *inter partes* review proceeding in light of Patent Owner’s and Petitioner’s settlement of their dispute regarding U.S. Patent No. 8,816,651 (“the ‘651 Patent”).

Petitioner and Patent Owner are concurrently filing a true copy of their written Settlement Agreement (**Confidential Exhibit 1035**) in connection with this matter as required by regulation. Petitioner and Patent Owner certify that there are no other agreements or understandings, oral or written, between the parties, including any collateral agreements, made in connection with, or in contemplation of, the termination of the present proceeding. A joint request to treat the Settlement Agreement as business confidential information kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is being filed concurrently.

LEGAL STANDARD

“An 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.” 35 U.S.C. § 317(a). “The parties may agree to

settle any issue in a proceeding, but the Board is not a party to the settlement and may independently determine any question of jurisdiction, patentability, or Office practice.” 37 C.F.R. § 42.74(a). 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 proceedings.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper No. 26, at 2 (P.T.A.B. July 28, 2014).

The Board has consistently granted a request to terminate a proceeding for both the Petitioner and Patent Owner when the request is filed before briefing has completed, which is the case here. *See, e.g., Itron, Inc. v. Certified Measurement, LLC*, IPR2015-00570, Paper 28, at 2-3 (P.T.A.B. February 16, 2016) (terminating the proceedings for both Patent Owner and Petitioner while noting that since “Petitioner has not yet filed a Reply in any of the cases, ... if we do not terminate these proceedings with respect to Patent Owner, ... [the Board] will be required to determine patentability on less than a full record”); *CB Distributors, Inc. and DR Distributors, LLC v. Fontem Holdings 1 B.V.*, IPR2014-01529, Paper 41, at 4 (P.T.A.B. December 7, 2015) (terminating the proceedings for both Patent Owner and Petitioner where a reply to the Patent Owner Response had yet to be filed).

ARGUMENT

Termination of the present *inter partes* review proceeding is appropriate because (1) Petitioner and Patent Owner have resolved their dispute regarding the '651 Patent and have agreed to terminate this proceeding, (2) the Office has not yet issued its Institution Decision in the proceeding and has not yet decided the merits of the proceeding, and (3) public policy favors the termination.

The Board has not yet instituted trial and a decision is not expected for some time. The early stage of the proceeding strongly favors termination. *See, e.g., Amazon.com, Inc. v. Lightguide, Inc.*, IPR2023-01423, Paper 15, at p. 2 (P.T.A.B. March 1, 2024); *Itron, Inc.*, IPR2015-00570, Paper 28, at 2-3; *CB Distributors*, IPR2014-01529, Paper 41, at 4.

Public policy also favors the termination. As recognized by the rules of practice before the Board:

There are strong public policy reasons to favor settlement between the parties to a proceeding. The Board will be available to facilitate settlement discussions, and where appropriate, may require a settlement discussion as part of the proceeding. 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.

Patent Office Trial Practice Guide, Fed. Register, Vol. 77, No. 157 at 48768 (Aug. 14, 2012); Consolidated Trial Practice Guide (Nov. 2019), 86. Moreover, no public interest or other factors militate against termination of this proceeding.

As to the remaining *Heartland Tanning* requirements regarding the identification and status of related proceedings, Petitioner and Patent Owner represent that there are not any other proceedings before the Board on the '651 Patent. There was one related district court litigation, in which Petitioner and Patent Owner were both parties, as identified in the Mandatory Notices. The parties to this related litigation jointly filed an Agreed Stipulation of Dismissal with Prejudice, pursuant to which the related litigation was terminated by entry of dismissal with prejudice of the action in its entirety on March 6, 2024, including all claims regarding the '651 Patent. As such, there are no parties that would obtain any benefit by the continuance of this proceeding.

Additionally, neither Petitioner nor Patent Owner are parties to any other IPR proceedings which concern a patent or patents which were also at issue in the district court litigation.

CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly and respectfully request that the instant proceeding be terminated.

Respectfully submitted,

/s/Terence J. Linn
Terence J. Linn, Reg. 30283
Lead Counsel for Petitioner

CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R § 42.6 and 42.105, I hereby certify that the foregoing
JOINT MOTION TO TERMINATE was served via electronic mail on the
following counsel of record for Patent Owner:

Burdick Patents
Attn: Sean Burdick, Reg. No. 51,513
2537 State Street, Suite 220
Boise, ID 83702
sean@burdickpatents.com

Date: March 8, 2024

/s/Terence J. Linn
Terence J. Linn
Lead Counsel for Petitioner