

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

SANDVIK MINING AND	)	
CONSTRUCTION USA LLC and	)	
SANDVIK INTELLECTUAL	)	
PROPERTY AB,	)	
	)	C.A. No. 24-481-JLH
Plaintiffs,	)	
	)	
v.	)	
	)	
CMS CEP COR LIMITED AND	)	
CMS CEP COR AMERICAS LLC,	)	
	)	
Defendants.	)	

STIPULATION TO STAY PENDING *INTER PARTES* REVIEW

WHEREAS, the Complaint in this action was served in July, 2024 asserting claims of patent infringement for U.S. Patent No. 9,827,568 (“568 Patent”) and U.S. Patent No. 11,014,090 (“090 Patent”) (collectively “Asserted Patents”), and the time for CMS Cepcor Limited and CMS Cepcor Americas LLC (“Defendants”) to answer, move or respond has not yet expired and is currently October 7, 2024; and

WHEREAS, on September 6, 2024, Defendants filed petitions for *inter partes* review (“IPRs”) of all asserted claims of both the patents-in-suit in this litigation; and

WHEREAS, all claims of the asserted patents are challenged by Defendants’ petitions in the IPRs; and

WHEREAS, the Patent Trial & Appeal Board (“PTAB”) has not yet decided whether to institute the IPR petitions; and

WHEREAS, Sandvik Mining and Construction USA LLC and Sandvik Intellectual Property AB (“Plaintiffs”) and Defendants met and conferred, and subject to the Court’s approval,

agreed to stipulate to staying this litigation, and any deadlines occurring in the action, at least pending the issuance of the PTAB's institution decisions for the following good cause; and

WHEREAS, the parties have agreed, subject to the Court's approval, that in the interests of judicial economy, and other considerations of efficiencies between the parties, and without admitting any other issue that may be pending in this action, to file this joint stipulation seeking to stay the entirety of the litigation pending at least the PTAB's institution decisions;

WHEREAS, the parties have agreed, subject to the Court's approval of this stipulated stay:

1. Defendants have agreed to have the decision of the PTAB be determinative of the validity of all claims before this Court;
2. Even though Defendants have other defenses that might have been raised in this action (e.g., noninfringement, Section 112 invalidity defenses, or any other defense), if the decision of the PTAB is against the Defendants on the IPRs, the Defendants will not assert other defenses in this action;
3. To avoid further burden on the Court and to facilitate the stay of this action, Defendants, without conceding any issue agree to not make, sell, offer to sell nor import in the United States the mainshaft or sleeve products associated with the Part Numbers listed in Exhibit A (attached hereto) as currently offered by Plaintiffs (the "Exhibit A Products") until the IPR proceedings before the PTAB are completed;
4. Should the PTAB cancel one or more claims of the Asserted Patents, then the Defendants would be free to sell and offer to sell those Exhibit A and the Exhibit B Products (Exhibit B also attached hereto) again in the United States that are not covered by any claim of the Asserted Patents whose validity has been

confirmed by the PTAB, whether by denying institution of one or both IPRs or by issuing a final written decision;

5. Should the PTAB not cancel all claims of the Asserted Patents in the IPRs, then Defendants will agree to a judgment prohibiting the manufacture, sale, offer to sell, or importation of those Exhibit A and Exhibit B Products in the United States that are covered by any claims of the Asserted Patents whose validity has been confirmed by the PTAB, whether by denying institution of one or both IPRs or by issuing a final written decision, for as long as the patents exist and any such claim continue to be valid.
6. Based on the determination of the PTAB in the IPRs, should less than every claim of the Asserted Patents overcome the validity challenge in the IPRs, the parties will consult in good faith to determine which of the Exhibit A Products and Exhibit B products may be covered by any claim of the Asserted Patents that remains valid following the PTAB's determination in the IPRs;
7. The PTAB determination will effectively then resolve all issues between the parties that may be before this Court and there will be no remaining issues for the Court to decide; and

WHEREAS, the parties have further agreed that, if one or more of the IPR petitions are instituted by the PTAB, the stay of this case should continue until the PTAB has issued a final written decision on each instituted IPR.

THE PARTIES HEREBY STIPULATE AND AGREE, subject to the approval of the Court, that this matter should be stayed pending resolution of the IPRs. The parties shall file a joint status report within seven (7) calendar days the PTAB's resolution of the last to resolve IPR

setting forth their joint or competing proposal(s) for resolving this litigation in accordance with the parties' agreements set forth above.

/s/ Karen E. Keller

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Dated: October 7, 2024

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SO ORDERED this _____ day of _____ 2024.

United States District Court Judge

EXHIBIT A

Exhibit A

Model	Mainshaft Sleeve	Mainshaft	Cone crusher/Assembly ID
CH420	BG00325408	BG00325122	BG00471187
CH420	BG00325408	BG00327481	BG01611007
CH420	BG00325408	BG00327481	BG01613324
CS420	BG00325408	BG00325124	BG00471605
CS420	BG00325408	BG00327202	BG01613425
CS420	BG00325408	BG00327202	BG01613410
CH430	BG00215626	BG00215620	BG00485738
CH430	BG00215626	BG00269155	BG01613697
CH430	BG00215626	BG00269155	BG01614517
CS430	BG00215626	BG00215645	BG00485892
CS430	BG00215626	BG00324305	BG01614221
CS430	BG00215626	BG00324305	BG01614548
CH440	BG00213813	BG00215580	BG00489622
CH440	BG00213813	BG00237768	BG01615628
CH440	BG00213813	BG00237768	BG01616013
CS440	BG00213813	BG00322597	BG00648939
CS440	BG00213813	BG00326329	BG01615949
CS440	BG00213813	BG00326329	BG01616001
CH660	BG00325390	BG00324843	BG01421270
CH660	BG00325390	BG00328277	BG01616808
CH660	BG00325390	BG00328277	BG01618707
CS660	BG00325390	BG00323462	BG01430566
CS660	BG00325390	BG00328879	BG01617667
CS660	BG00325390	BG00328879	BG01618710
CH840i	BG00475833	BG01079787	BG01572222
CH840i	BG00475833	BG01079807	BG01121677
CH840i	BG00475833	BG01079807	BG01179908
CS840i	BG00475833	BG01100004	BG01572433
CS840i	BG00475833	BG01099984	BG01121747
CS840i	BG00475833	BG01099984	BG01180341

EXHIBIT B

Exhibit B

Model	Mainshaft Sleeve	Mainshaft	Cone crusher/Assembly ID
CH830i	BG01398838	BG01086486	BG01550281
CH830i	BG01398838	BG01086494	BG01121954
CH830i	BG01398838	BG01086494	BG01180252
CH860i	452.7598-001	BG00133384	BG00143076
CH860i	BG01045677	BG01100977	BG01101266
CH860i	BG01045677	BG01045665	BG0XXXXXX
CH860i	BG01045677	BG01100977	BG01999807
CH860i	BG01045677	BG01100977	BG01999762
CH865i	452.7598-001	BG00133384	BG00136009
CH865i	BG01045677	BG01100977	BG01101266
CH865i	BG01045677	BG01045665	BG0XXXXXX
CH865i	BG01045677	BG01100977	BG01999807
CH865i	BG01045677	BG01100977	BG01999762
CH870i	452.0505-001	BG00433457	BG00519392
CH870i	452.0505-001	BG00433471	BG00568048
CH870i	452.0505-001	BG00433471	BG00568076
CH870i	BG01044591	BG01044580	BG01101421
CH870i	BG01044591	BG01044576	BG02024732
CH870i	BG01044591	BG01044580	BG01996589
CH870i	BG01044591	BG01044580	BG01996771
CH880	442.9294-01	452.6195-901	BG00488370
CH880	442.9294-01	452.6195-901	BG00488841
CH880	BG01004353	BG01042448	BG01044288
CH890i	442.9294-01	452.6422-001	BG00604394
CH890i	442.9294-01	452.6421-901	BG00504841
CH890i	442.9294-01	452.6421-901	BG00505358
CH890i	BG01004353	BG01042053	BG01043283
CH890i	BG01004353	BG01008372	BG0XXXXXX
CH890i	BG01004353	BG01042053	BG02003025
CH890i	BG01004353	BG01042053	BG02003205
CH895i	442.9294-01	452.6422-001	BG00627662
CH895i	442.9294-01	452.6421-901	BG00504841
CH895i	442.9294-01	452.6421-901	BG00505358
CH895i	BG01004353	BG01042053	BG01043283
CH895i	BG01004353	BG01008372	BG0XXXXXX

CH895i	BG01004353	BG01042053	BG02003025
CH895i	BG01004353	BG01042053	BG02003205