IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

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

SO ORDERED this 10th day of October 2024.

The Honorable Jennifer L. Hall
United States District Court Judge