

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.

Petitioner

v.

WARSAW ORTHOPEDIC, INC.

Patent Owner

Case IPR2013-00206

Patent No. 8,251,997

**JOINT MOTION TO TERMINATE PROCEEDING PURSUANT
TO 35 U.S.C § 317(A)**

**JOINT NOTICE OF SETTLEMENT PURSUANT TO
35 U.S.C. § 317(B) AND 37 C.F.R. § 42.74**

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I. Relief Requested.

Pursuant to 35 U.S.C. § 317(a) and (b), and as authorized by the Board in an email dated April 4, 2017, Patent Owner, Warsaw Orthopedic, Inc. and Petitioner, Nuvasive, Inc., provide notice that they have reached a settlement and jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,251,997 (“’997 patent”), Case No. IPR2013-00206. The Parties request that the Board treat the Settlement Agreement as business confidential information and keep it separate from the file of the involved patent.

II. Statement of Reasons for the Relief Requested.

The Parties have reached a Settlement Agreement regarding their disputes relating to the ‘997 patent. Because the underlying dispute has been resolved, the Parties submit that the present *Inter Partes* Review is ripe for termination. The present *Inter Partes* Review is also at a procedural stage affording termination. The present *Inter Partes* Review has been remanded to the Board from the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) in a Decision dated August 9, 2016. Patent Owner has already briefed the Board on the issues forming the basis of the remand. However, it is unnecessary for the Board to reach a decision on these issues in view of the requested termination. Termination will at the very least conserve the resources of the Board in considering these issues.

III. Related Litigation and PTAB Proceedings.

The Parties have settled the underlying litigation involving the '997 patent. As indicated in Petitioner's Petition for *Inter Partes* Review dated March 22, 2013 and Patent Owner's Mandatory Notices dated May 12, 2013, the underlying litigation was styled *Warsaw Orthopedic, Inc. et al. v. NuVasive, Inc.* (originally filed in N.D. Ind. as Case No. 3:12-cv-00438-JD-CAN on Aug. 17, 2012, and transferred to S.D. Cal. on Nov. 8, 2012, as Case No. 3:12-cv-02738-CAB (MDD)). Patent Owner's related corporate entities, Medtronic Sofamor Danek USA, Inc., Medtronic Puerto Rico Operations Co., and Medtronic Sofamor Danek Deggendorf, GMBH, were subject to the underlying litigation as counterclaim defendants. As part of the Settlement Agreement, Patent Owner submits that the underlying litigation was also settled with respect to these related corporate entities.

In addition to Case No. IPR2013-00206, the '997 patent was also subject to Case No. IPR2013-00208. Case No. IPR2013-00208 was also subject to the Decision dated August 9, 2016, and Patent Owner did not appeal the corresponding findings of the Federal Circuit.

Patent Owner represents that no additional district court litigation is currently pending involving the '997 patent.

IV. Submission of the Settlement Agreement.

Submitted concurrently with this Motion is a true copy of the Settlement Agreement between the Parties (Ex. 2069), as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

The Parties jointly request that this Settlement Agreement be treated as business confidential information and be 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). Ex. 2069 is being submitted concurrently having “availability” in the PTAB E2E system of “Parties and Board Only” as advised in FAQ G2. The Parties jointly request that this Settlement Agreement (Ex. 2069) be made available only to Federal Government agencies on written request or to any person only on a showing of good cause.

V. Conclusion.

For the reasons stated above, the Parties respectfully request that the Board terminate *Inter Partes* Review of U.S. Patent No. 8,251,997, Case No. IPR2013-00206.

Dated: April 19, 2017

Respectfully submitted,

/Thomas H. Martin/

Thomas H. Martin
Registration No. 34,383
Attorney for Patent Owner
MARTIN & FERRARO, LLP
1557 Lake O’Pines Street, NE
Hartville, Ohio 44632
Telephone: (330) 877-0700
Facsimile: (330) 877-2030

Dated: April 19, 2017

Respectfully submitted,

/Michael T. Rosato/

Michael T. Rosato
Registration No. 52,182
Attorney for Petitioner
WILSON SONSINI
GOODRICH & ROSATI
701 Fifth Avenue, Suite 5100
Seattle, WA 98104
Telephone: (206) 883-2529
Facsimile: (206) 883-2699
Email: mrosato@wsgr.com

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