

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

NUVASIVE, INC.,
Patent Owner.

Case IPR2013-00506
Patent 8,361,156

**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**

I. Relief Requested

Pursuant to 35 U.S.C. § 317(a) and (b), and as authorized by the Board in an email dated April 14, 2017, Patent Owner NuVasive, Inc. and Petitioner Medtronic, Inc., provide notice that they have reached a settlement and jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,361,156 (“the ’156 patent”), Case No. IPR2013-00506. 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 ’156 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 in a decision dated December 7, 2016. But it is unnecessary for the Board to reach a decision on the remanded 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 ’156 patent.

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As indicated in Medtronic's Petition for *Inter Partes* Review dated August 14, 2013 and NuVasive's Mandatory Notices dated September 4, 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)). Medtronic's related corporate entities, Warsaw Orthopedic, Inc., Medtronic Sofamor Danek USA, Inc., Medtronic Puerto Rico Operations Co., Medtronic Sofamor Danek Deggendorf, GMBH, and Osteotech, Inc. were parties to the underlying litigation. As part of the Settlement Agreement, the underlying litigation was also settled with respect to these related corporate entities.

NuVasive represents that no district court litigation is currently pending involving the '156 patent.

U.S. Patent No. 8,187,334 is in the same family as the '156 patent, was also at issue in the underlying litigation, and was reviewed in Case Nos. IPR2013-00508. U.S. Patent No. 8,251,997 is owned by a Medtronic-related entity and was also at issue in the underlying litigation and was reviewed in Case No. IPR2013-00206. Although otherwise unrelated, similar joint motions to terminate are being filed in Cases Nos. IPR2013-00206 and -00508 to effectuate the Parties' settlement.

IV. Submission of the Settlement Agreement

Submitted concurrently with this Motion is a true copy of the Settlement

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Agreement between the Parties (Ex. 2041), 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. 2041 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. 2041) be made available only to Federal Government agencies on written request or to any person only on a showing of good cause.

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V. Conclusion

For the reasons stated above, the Parties respectfully request that the Board terminate *Inter Partes* Review of U.S. Patent No. 8,361,156, Case No. IPR2013-00506.

Dated: April 26, 2017

Respectfully submitted,

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