

Filed on behalf of:

Petitioners Boston Scientific Corp. and Boston Scientific Scimed, Inc.

By: David R. Marsh, Ph.D.
Kristan L. Lansbery, Ph.D.
ARNOLD & PORTER LLP
555 12th Street, N.W.
Washington, DC 20004
Tel: (202) 942-5068
Fax: (202) 942-5999

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BOSTON SCIENTIFIC CORP. and
BOSTON SCIENTIFIC SCIMED, INC.,

Petitioners,

v.

VASCULAR SOLUTIONS, INC.,

Patent Owner.

Case IPR2014-00759
Patent 8,142,413

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW
PURSUANT TO 35 U.S.C. § 317(a) AND 37 C.F.R. §§ 42.72 AND 42.74**

Pursuant to the Board’s Order of August 6, 2014 (*see* Paper 6), 35 U.S.C. § 317(a), and 37 C.F.R. §§ 42.72 and 42.74, Petitioners Boston Scientific Corporation and Boston Scientific Scimed, Inc. (collectively, “Petitioners”) and Patent Owner Vascular Solutions, Inc. (“Patent Owner”) jointly and respectfully request termination by operation of settlement of IPR2014-00759, which is directed to U.S. Patent No. 8,142,413.

Petitioners and Patent Owner respectfully submit that termination is appropriate in the instant proceeding because the parties have (1) reached a settlement agreement (i) to terminate the instant proceeding and (ii) resolving the disputes concerning the involved patents of the instant proceeding and related proceedings: U.S. Patent Nos. 8,048,032, 8,142,413, and 8,292,850 and (2) moved to terminate the instant proceeding prior to (i) Patent Owner’s preliminary response and (ii) institution of trial.

The statuses of other matters concerning the involved patents are as follows:

Case	Status
Related Proceeding: IPR2014-00760 (U.S. Patent No. 8,048,032)	A Joint Motion to Terminate is being filed concurrently herewith.
Related Proceeding: IPR2014-00761 (U.S. Patent No. 8,048,032)	A Joint Motion to Terminate is being filed concurrently herewith.
Related Proceeding: IPR2014-00762 (U.S. Patent No. 8,292,850)	A Joint Motion to Terminate is being filed concurrently herewith.
Related Proceeding: IPR2014-00763 (U.S. Patent No. 8,292,850)	A Joint Motion to Terminate is being filed concurrently herewith.
Related Litigation in the U.S. District Court for the District of Minnesota:	The Settlement Agreement provides for dismissal of this litigation. A joint

<i>Vascular Solutions, Inc. v. Boston Scientific Corp.</i> , No. 12-1172 (JRT/SER) (May 16, 2013)	stipulation of dismissal was filed with the U.S. District Court for the District of Minnesota on August 8, 2014.
Reissue Application for U.S. Patent No. 8,292,850: Serial No. 14/070161	Pending
Reissue Continuation Application for U.S. Patent No. 8,292,850: Serial No. 14/195385	Pending
Reissue Continuation Application for U.S. Patent No. 8,292,850: Serial No. 14/195413	Pending
Reissue Continuation Application for U.S. Patent No. 8,292,850: Serial No. 14/195435	Pending

Filed concurrently herewith as Exhibit 1041 is a true and complete copy of the parties' Settlement Agreement resolving the dispute in the instant proceeding, the four related *Inter Partes* Reviews, and the related district court litigation. The parties request that the Settlement Agreement be treated as business confidential information, kept separate from the files of involved U.S. Patent Nos. 8,048,032, 8,142,413, and 8,292,850, and made available only to Federal Government agencies on written request to the Board or to any person on a showing of good cause. Filed concurrently herewith is the parties' Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In accordance with 35 U.S.C. § 317(a), because Petitioners and Patent Owner jointly request this termination as to Petitioners, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioners.

The parties respectfully and jointly request termination of the instant proceeding because of the foregoing reasons.

Dated: August 8, 2014

Respectfully submitted,

By: /David R. Marsh/
David R. Marsh, Ph.D.
Kristan L. Lansbery, Ph.D.
ARNOLD & PORTER LLP
555 12th Street, N.W.
Washington, DC 20004
Tel: (202) 942-5068
Fax: (202) 942-5999

Attorneys for Petitioners

/Kenneth E. Levitt/
Kenneth E. Levitt
DORSEY & WHITNEY LLP
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402
Tel: (612) 340-2600
Fax: (612) 340-2868

Attorney for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that copies of the foregoing Joint Motion to Terminate *Inter Partes* Review Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, Exhibit 1041, and Petitioners' August 8, 2014 Updated Exhibit List were served on August 8, 2014 to the following Counsel for Patent Owner via e-mail, pursuant to the parties' agreement concerning service:

Kenneth E. Levitt, Lead Counsel
DORSEY & WHITNEY LLP
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402
VSI-BSC-IPR@dorsey.com

- and -

Brad D. Pedersen
PATTERSON THUENTE PEDERSEN, P.A.
4800 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
PRPS@ptslaw.com

Attorneys for Patent Owner

/David R. Marsh/
David R. Marsh (Atty. Reg. No. 41,408)
ARNOLD & PORTER LLP
555 12th Street, N.W.
Washington, D.C. 20004
Tel: (202) 942-5068
Fax: (202) 942-5999