

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENDOLOGIX, INC.
Petitioner

v.

LIFEPORT SCIENCES LLC
Patent Owner

CASE IPR2015-01722

U.S. PATENT NO. 8,192,482 B2

**JOINT MOTION TO TERMINATE
UNDER 35 U.S.C. § 317 AND 37 CFR §§ 42.72 AND 42.74**

Mail Stop *Patent Board*
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 and 42.74, Petitioner and Patent Owner jointly request termination of *inter partes* review IPR2015-01722 of U.S. Patent No. 8,192,482 B2 (the “‘482 Patent”) with respect to both parties. The Board authorized this joint motion on March 31, 2016, by email to the parties. A joint request to treat the two agreements discussed below as business confidential information and to keep them separate from the files of the ‘482 Patent is being filed concurrently.

II. STATEMENT OF FACTS

On August 12, 2015, Petitioner filed the petition in this *inter partes* review.

On either September 27, 2014, or on September 1, 2015, the ‘482 Patent expired. *See* Paper No. 9 at 7.

On February 18, 2016, the Board instituted trial. *See* Paper No. 9. No discovery has been exchanged, no depositions have been noticed, and the Patent Owner has not responded substantively to the Petition.

On March 17, 2016, Petitioner and Patent Owner agreed to resolve their dispute and executed two written agreements in connection therewith.

On March 28, 2016, the Patent Owner and the Petitioner dismissed their respective claims and counterclaims with prejudice in the related litigation captioned, *LifePort Sciences, LLC v. Endologix, Inc.*, D. Del. No. 12-cv-1791.

There are no other pending litigations or any other proceedings between the Petitioner and Patent Owner.

Both parties advise the Board that no litigation or proceeding involving U.S. Patent No. 8,192,482 B2 is contemplated in the foreseeable future.

III. THE BOARD SHOULD TERMINATE IPR2015-01722

A. Termination of IPR2015-01722 Is Appropriate

The Board should terminate IPR2015-01722 because the review is still in its early stages, because the Board has not yet finally decided any of the merits, because no motions are outstanding, because the Petitioner and Patent Owner have ended the related district court litigation, because termination of the present *inter partes* review would resolve all presently pending disputes between the parties pertaining to the '482 Patent, because no litigation or other proceedings involving the '482 Patent are contemplated by either party, and because both Petitioner and Patent Owner agree that this *inter partes* review should be terminated.

The parties understand that if the Board terminates this *inter partes* review with respect to Petitioner under 35 U.S.C. § 317(a), no estoppel under section 315(e) will attach to Petitioner on the basis of the Petitioner's institution of this *inter partes* review. The parties also understand that if the Board terminates this *inter partes* review with respect to Petitioner before a final written decision on patentability, no estoppel will attach to Petitioner under 37 C.F.R. § 42.73(d)(1).

The parties understand that if the Board terminates this *inter partes* review before a final written decision on patentability, no preclusion will attach to Patent Owner under 37 C.F.R. § 42.73(d)(3).

B. True Copies of the Written Agreements Are Being Filed Herewith

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), true copies of the two written agreements made in connection with, or in contemplation of, the termination of this *inter partes* review are being contemporaneously filed herewith as Exhibits 1023 and 1024, respectively. There are no other collateral agreements or understandings made in connection with, or in contemplation of, the termination of this *inter partes* review. A joint request to treat these agreements as business confidential information and to keep them separate from the files of the '482 Patent is being filed concurrently.

IV. SUMMARY

For the foregoing reasons, Petitioner and Patent Owner respectfully request termination of *inter partes* review no. IPR2015-01722 involving U.S. Patent No. 8,192,482 B2.

The Patent and Trial Appeal Board is hereby authorized to charge any fees associated with the filing to Deposit Account 02-1818.

Date: April 4, 2016

Respectfully submitted,

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Lead Counsel for Patent Owner

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