

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 REQUEST TO KEEP AGREEMENTS CONFIDENTIAL AND
SEPARATE UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.74(c)**

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. § 42.74(c), Petitioner and Patent Owner jointly request that the two agreements discussed below and being filed herewith as Exhibits 1023 and 1024, (and being filed concurrently with the joint motion to terminate *inter partes* review IPR2015-01722 of U.S. Patent No. 8,192,482 B2) be: (a) treated as business confidential information, (b) kept separate from the files of the involved patent, and (c) made available only as permitted pursuant to the provisions of 35 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c). The Board authorized this joint request on March 31, 2016, by email to the parties.

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, U.S. Patent No. 8,192,482 B2 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. These two confidential agreements are included with the joint motion to terminate *inter partes*

review IPR2015-01722 of U.S. Patent No. 8,192,482 B2. *See* Exs. 1023 and 1024.

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.

III. THE BOARD SHOULD TREAT THE PARTIES' AGREEMENTS AS CONFIDENTIAL AND KEEP THEM SEPARATE

Petitioner and Patent Owner jointly request that their two agreements being filed herewith as Exhibits 1023 and 1024 (concurrently with the joint motion to terminate *inter partes* review IPR2015-01722 of U.S. Patent No. 8,192,482 B2) be: (a) treated as business confidential information, (b) kept separate from the files of the involved patent, and (c) not be made available except as permitted by the provisions of 35 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c). These agreements have not been publicly disclosed, nor will they be in connection with the related litigation.

The public disclosure of the two agreements may provide competitors and/or licensees or licensors of one or both parties with an unfair advantage in future competition or license negotiations, by revealing non-public information about one or both of the parties' strategies or tactics for negotiation, litigation, and/or conducting business.

IV. SUMMARY

For the foregoing reasons, Petitioner and Patent Owner respectfully request

that the parties' agreements filed as Exhibits 1023 and 1024 be treated as business confidential information and be kept separate from the files of 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,

By: /Katherine L. Hoffee/
Katherine L. Hoffee
Reg. No. 72,691
K&L GATES LLP
e-mail: katy.hoffee@klgates.com
70 W. Madison Street, Suite 3100
Chicago, IL 60602

Backup Counsel for Petitioner

By: /Robert W. Ashbrook Jr./
Reg. No. 52,572
Robert W. Ashbrook Jr.
Dechert LLP
robert.ashbrook@dechert.com
Cira Centre, 2929 Arch Street
Philadelphia, PA 19104

Lead Counsel for Patent Owner

Certification of Service Under 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that the foregoing Joint Request to Keep Agreements Confidential and Separate was electronically served via e-mail on April 4, 2016 in its entirety on:

Robert W. Ashbrook Jr.
robert.ashbrook@dechert.com

Kevin M. Flannery
kevin.flannery@dechert.com

Lead and Back-up Counsel for Patent Owner

By: /Katherine L. Hoffee/
Katherine L. Hoffee
Reg. No. 72,691
K&L GATES LLP
e-mail: katy.hoffee@klgates.com
70 W. Madison Street, Suite 3100
Chicago, IL 60602

Backup Counsel for Petitioner