

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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VISIONSENSE CORP.,  
Petitioner,

v.

NOVADAQ TECHNOLOGIES INC.,  
Patent Owner.

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Case IPR2017-01426  
Patent 8,892,190 B2

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Before HYUN J. JUNG, MICHAEL L. WOODS, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

ORDER  
The Record  
*37 C.F.R. § 42.7*

Termination  
*35 U.S.C. § 317 and 37 C.F.R. § 42.74*

## I. THE RECORD

As discussed in our Order (Paper 8), Paper 1 appears to be only a caption page for an attempted filing of a petition. Also, pursuant to the same Order, Petitioner has refiled Exhibits 1001–1016 in accordance with 37 C.F.R. § 42.63 and refiled a “Declaration of David J. Langer, M.D.” (Paper 2) as Exhibit 1017. Petitioner certifies that the declaration and exhibits have been refiled with no changes other than those required by applicable rules. Paper 10.

Further, pursuant to our Decision instituting *inter partes* review in this proceeding (Paper 12), Petitioner has filed the original application related to Exhibit 1004 and an affidavit attesting to the accuracy of Exhibit 1004. Paper 14.

Accordingly, Papers 1 and 2 and originally filed Exhibits 1001–1016 will be expunged.

## II. TERMINATION

After obtaining authorization from the Board, the parties filed a Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317(a). Paper 23. The parties indicate that they “have since settled their dispute, and agreed to terminate this *inter partes* review of the ’190 Patent.” *Id.* at 1. The parties also represent that “a true copy of the Settlement Agreement is being submitted concurrently herewith as Exhibit 2006,” and the “parties certify that there are no other agreements, oral or written, between the parties made

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in connection with, or in contemplation of, the termination of this *inter partes* review.” *Id.*

Concurrent with the filing of the joint motion and Exhibit 2006, the parties filed a Joint Request that the Settlement Agreement Filed Separately as Exhibit 2006 Be Treated as Business Confidential Information and Be Kept Separate from the Files. Paper 24; *see also* Paper 23, 2 (identifying the joint request). The parties understand that the settlement agreement can be made available only to Federal Government agencies upon written request or to any person on a showing of good cause pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 23, 2; Paper 24, 1.

“An *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” 35 U.S.C. § 317(a). A decision on the merits of the proceeding has not yet been made, and thus, under these circumstances, we determine it is appropriate to terminate the *inter partes* review in IPR2017-01426 and grant the parties’ joint motion. Also, we grant the parties’ joint request, and the agreement filed will be treated as business confidential information and be kept separate from the patent file. 37 C.F.R. § 42.74(c).

### III. ORDER

It is

ORDERED that Papers 1 and 2 be expunged;

FURTHER ORDERED that originally submitted Exhibits 1001–1016, filed on May 11, 2017, be expunged;

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FURTHER ORDERED that the parties' Joint Request that the Settlement Agreement Filed Separately as Exhibit 2006 Be Treated as Business Confidential Information and Be Kept Separate from the Files (Paper 24) is *granted*; and

FURTHER ORDERED that the parties' Joint Motion to Terminate Proceeding Pursuant to 35 U.S.C. § 317(a) (Paper 23) is *granted*.

PETITIONER:

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