

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION,

Petitioner,

v.

ENDOHEART AG,

Patent Owner.

Case IPR2016-00299

U.S. Patent No. 8,182,530

**JOINT MOTION OF PETITIONER AND PATENT OWNER
TO TERMINATE PROCEEDING
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. § 42.74**

STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317, 37 C.F.R. § 42.74, and the Board's authorization provided on June 9, 2016, Petitioner EDWARDS LIFESCIENCES CORPORATION ("Petitioner" or "Edwards") and Patent Owner ENDOHEART AG ("Patent Owner" or "Endoheart") (collectively the "Parties") jointly request termination of *Inter Partes* Review No. IPR2016-00299, which is directed to U.S. Patent No. 8,182,530 (the "'530 Patent"), pursuant to settlement. As there are no other petitioners in this proceeding and the proceeding is still pre-trial, the Parties respectfully submit that termination of this proceeding is appropriate.

STATEMENT OF FACTS

Petitioner filed their petition in this proceeding for *Inter Partes* Review of the '530 Patent on December 9, 2015. In turn, Patent Owner filed a Preliminary Response on March 15, 2016. Petitioner also filed another petition for *Inter Partes* review of the '530 Patent in IPR2016-00300 on December 9, 2015. No other petitions related to the '530 Patent are pending.

The deadline for entering a decision regarding institution by the Board is June 15, 2016. Petitioner and Patent Owner have reached a Settlement Agreement to end their disputes in this proceeding and the related litigation. Pursuant to 35 U.S.C. § 317(b) and 37 CFR § 42.74(b), the agreement between the Parties is in

writing, constitutes the entire understanding and agreement between the Parties, and a copy of the Settlement Agreement is submitted herewith as Exhibit 1046.

The Parties jointly request that the Settlement Agreement be treated as business confidential information and kept separate from the underlying patent file, as provided in 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to maintain confidentiality of the Settlement Agreement. A separate joint request to that effect is being filed concurrently herewith.

ARGUMENT

A joint motion to terminate generally “must (1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

The Board should terminate this case as the Parties jointly request, for the following reasons.

1. Brief Explanation As To Why Termination is Appropriate

The Parties have met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a). The proceeding is still at an early stage (pre-trial). No decision regarding institution has been entered by the Board. Further, no prior motions are pending in this proceeding.

The Parties have reached a settlement as to the ‘530 Patent to end this dispute. A copy of the confidential Settlement Agreement pertaining to this case is filed concurrently herewith. *See* Ex. 1046. The Parties jointly certify that there is no other agreement or understanding between them, including any collateral agreement, made in connection with, or in contemplation of, the termination of the instant proceeding as set forth in 35 U.S.C. § 317(b).

The Parties respectfully submit that termination of this proceeding is appropriate because

- (a) this proceeding is at an early stage (pre-trial) and no motions are outstanding;
- (b) the Parties have reached agreement to end their dispute concerning the ‘530 Patent;
- (c) the Parties have agreed to dismiss the related district court

litigation with respect to the '530 Patent;

(d) the Parties agree that this *Inter Partes* Review should be terminated; and

(e) termination of this proceeding will preserve the Board's resources and obviate the need for any more Board involvement in this matter.

2. Identity and Status of Parties in Related Litigation Involving the Patent

The '530 Patent is in dispute in *Endoheart AG v. Edwards Lifesciences Corporation*, Case No. 1:14-cv-01473 (D. Del.). The Parties have agreed to dismiss this litigation.

3. Identity and Status of Any Related Proceedings Before the Office

Petitioner filed another petition for *Inter Partes* Review of the '530 Patent in IPR2016-00300 on December 9, 2015. In turn, Patent Owner filed a Preliminary Response on March 15, 2016. No decision regarding institution has been entered by the Board. Petitioner is concurrently filing a Joint Motion to Terminate the Proceeding in IPR2016-00300.

No other proceedings related to the '530 Patent are pending.

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