

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC XOMED, INC.
Petitioner,

v.

NEUROVISION MEDICAL PRODUCTS, INC.
Patent Owner.

Case IPR2016-01405	Patent 8,634,894
Case IPR2016-01406	Patent 8,634,894
Case IPR2016-01847	Patent 8,467,844
Case IPR2017-00456	Patent 8,634,894

JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW

Patent Owner Neurovision Medical Products, Inc. and Petitioner Medtronic Xomed, Inc. have reached a settlement. Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. §§ 42.72 and 42.74, the parties jointly request termination of the *inter partes* reviews of U.S. Patent Nos. 8,634,894 (“’894 Patent”) and 8,467,844 (“’844 Patent”), Case Nos. IPR2016-01405, -01406, -01847, and IPR2017-00456. The parties were authorized to file this Joint Motion by the Board (via email) on May 8, 2017.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72(b), a true copy of the settlement agreement that resolves the disputes in the above-captioned *inter partes* reviews and all disputes between Neurovision and Medtronic (and all other defendants in the related district court litigation) relating to the ’894 and ’844 Patents is filed herewith as an exhibit.¹

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), the parties are also concurrently filing a Joint Request to Keep Separate, which asks the Board to treat the settlement agreement exhibit as business confidential information, and to keep it separate from the files of these proceedings and the files of the ’894 Patent and ’844 Patents.

¹ Exhibit 2058 in IPR2016-01405; Exhibit 2058 in IPR2016-01406; Exhibit 2026 in IPR2016-01847; Exhibit 2030 in IPR2017-00456.

I. Statement of Precise Relief Requested

The parties jointly request that the Board terminate the *inter partes* reviews of the '894 and '844 Patents, Case Nos. IPR2016-01405, -01406, -01847, and IPR2017-00456, with respect to both parties.

II. Reasons Why Termination Is Appropriate

Termination of these proceedings with respect to both parties is proper. These *inter partes* reviews are in their early stages. The institution dates (if any) and oral-argument dates for these proceedings are as follows:

Case No.	Institution Date	Oral-Argument Date
IPR2016-01405	December 29, 2016	September 21, 2017
IPR2016-01406	December 29, 2016	September 21, 2017
IPR2016-01847	March 23, 2017	December 6, 2017
IPR2017-00456	Institution Denied on May 5, 2017	N/A

Under 35 U.S.C. § 317(a), “[a]n *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.” Because both parties request termination, and the Board has not yet decided the merits of the proceeding, the Board must terminate the proceedings with respect to Medtronic.

When there are no petitioners remaining in the *inter partes* review, the Board may terminate the proceeding. 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

Medtronic is the only petitioner in these *inter partes* reviews. Both parties support termination of these proceedings. With no petitioners remaining in the proceedings and no final written decision on the merits, termination with respect to both parties is appropriate.

III. No Future Participation by Petitioner Medtronic

Medtronic will not be participating further in these proceedings.

IV. Conclusion

The parties have settled all disputes relating to the '894 and '844 Patents, these *inter partes* reviews are in their early stages, and the Board has not entered a final written decision on the merits in these proceedings. Accordingly, the parties respectfully request the Board to terminate these proceedings in their entirety.

Respectfully submitted,

Date: May 8, 2017

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Cases IPR2016-01405, -01406, -01847,
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