

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INOGEN, INC.,
Petitioner

v.

SEPARATION DESIGN GROUP IP HOLDINGS, LLC,
Patent Owner

Case IPR2017-00300
Patent 8,894,751

**JOINT REQUEST TO TERMINATE *INTER PARTES REVIEW*
PROCEEDING**

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74, Petitioner Inogen, Inc. and Patent Owner Separation Design Group IP Holdings, LLC jointly request termination of *inter partes* review IPR2017-00300 relating to U.S. Patent No. 8,894,751 (“the ‘751 Patent”), filed by Petitioner on November 18, 2016. The filing of this Joint Motion was authorized by the Board via an email response to the Parties dated November 6, 2017.

On October 31, 2017, Petitioner and Patent Owner signed a Settlement Agreement and Mutual Release (the “Settlement Agreement”) resolving the dispute in the above-captioned *inter partes* review. The Settlement Agreement also resolves the pending district court litigation, *Separation Design Group IP Holdings LLC v. Inogen, Inc.*, Case No. 2:15-cv-08323-JAK-JPR, U.S. District Court for the Central District of California (the “Litigation”), between Patent Owner and Petitioner. Patent Owner filed a notice of settlement for the Litigation on October 18, 2017 (Dkt. 286), and the district court dismissed the case without prejudice on October 19, 2017 (Dkt. 293). The parties then filed a stipulation of dismissal with prejudice for the Litigation on November 1, 2017, which does not require approval of the district court pursuant to Fed. R. Civ. P. 41 (Dkt. 294). The Litigation is the only other related matter involving the ‘751 Patent.

There are no other pending proceedings before the Board involving the ‘751 Patent. There is one pending related *inter partes* review proceeding before the

Board, IPR2017-00453, involving U.S. Patent No. 9,199,055 (“the ‘055 Patent”), which is related to the ‘751 Patent. A request to terminate the related *inter partes* review proceeding is also being submitted as a result of this settlement. No other petitioners remain in this *inter partes* review for the ‘751 Patent or the related *inter partes* review for the ‘055 Patent.

Termination is appropriate at this time for the following reasons. The *inter partes* review has been instituted by the Board and Patent Owner has filed its response to the petition, but Petitioner has not yet filed its reply and the Board has not reached a final decision on the merits. The parties have since settled all disputes regarding the ‘751 Patent and the related ‘055 Patent, the Litigation has been dismissed, and the Parties have reached agreement to terminate this *inter partes* review for the ‘751 Patent and the related *inter partes* review for the ‘055 Patent. Accordingly, Petitioner and Patent Owner jointly request that the *inter partes* review be terminated under 35 U.S.C. § 317(a) and 37 C.F.R. § 42.74(a).

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner filed separately herewith a true copy of the written Settlement Agreement resolving the dispute in this *inter partes* review. The parties request that the Settlement Agreement be treated as business confidential information, be kept separate from the files of this proceeding, and be made available only to

Federal Government agencies on written request or to other persons on written request and a showing of good cause, in accordance with 37 C.F.R. § 42.74(c).

Dated: November 6, 2017

Respectfully Submitted,

/s/ Brett M. Pinkus

/s/ Nicholas M. Zovko

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CERTIFICATE OF SERVICE

I hereby certify that on November 6, 2017, a true and correct copy of the foregoing *JOINT REQUEST TO TERMINATE INTER PARTES REVIEW PROCEEDING* was served via electronic mail upon counsel of record for Petitioners at the following addresses:

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