

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW

Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC

Patent Owner

JOINT MOTION TO TERMINATE *INTER* PARTIES REVIEW

Case No. IPR2013-00604

Patent No. 7,087,073

This Motion is filed pursuant to the Board's Order dated January 8, 2014. (Paper 12). Pursuant to 35 U.S.C. § 317(a), The Petitioner and Patent Owner jointly request termination of this *inter parties* review, which is directed at U.S. Patent No. 7,087,073 ("073 patent").

Termination of this review is appropriate because the parties have settled their dispute with regard to the '073 patent and have reached an agreement to, among other things, terminate this review. Ex. 2001, Settlement Agreement (submitted as business confidential information pursuant to 35 U.S.C. § 317 (B) and 37 C.F.R. 42.74 (c)). The petition for this review was filed on September 24, 2013. The Board has not entered a decision whether to grant the petition. "Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement." Oracle Corp. v. Cmty. United IP, LLC, CBM2013-00015, Paper 13 (July 25, 2013) (citing Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48756-66 (Aug. 14, 2012)).

Further, Petitioner represents that it will no longer participate in this review even if the Board does not terminate this review.

Pursuant to the Board's January 8, 2014 Order, the parties identify the following litigations involving the '073 patent, along with their status:

(a) *Bonutti Skeletal Innovations LLC v. Smith & Nephew, Inc.*, Civil Action No. 12-1111-GMS (D. Del. 2012). On January 3, 2014, pursuant to Rule 41(a)(1)(A)(ii) of the Federal Rules of Civil Procedure, the parties jointly

submitted a Stipulation of Dismissal without prejudice. This litigation was dismissed on January 7, 2014. The Defendant in that litigation was the Petitioner, Smith & Nephew, Inc.

(b) *Bonutti Skeletal Innovations LLC v. Linvatec Corporation and ConMed Corporation*, Civil Action No. 6:2012cv01379 (M.D. Fla. 2012) and *Bonutti Skeletal Innovations LLC v. Linvatec Corporation and ConMed Corporation*, Civil Action No. 6:2012cv01709 (M.D. Fla. 2012): These litigations are consolidated and pending. These litigations involve a number of claims of the '073 patent in addition to claim 35, the only claim challenged in the instant *Inter Partes* Review. Neither Defendant has filed an *Inter Partes* Review for the '073 patent, and it has been more than one year since each Defendant was served with a Complaint alleging infringement of the '073 patent.

(c) *Bonutti Skeletal Innovations LLC v. Arthrex, Inc.*, Civil Action No. 6:2012 cv 01380 (M.D. Fla. 2012) and *Bonutti Skeletal Innovations LLC v. Arthrex, Inc.*, Civil Action No. 6:2013 cv 00620 (M.D. Fla. 2013). These litigations have been consolidated. These litigations are pending and involve a number of claims of the '073 patent in addition to claim 35, the only claim challenged in the instant *Inter Partes* Review. Arthrex, Inc. has not filed an *Inter Partes* Review for the '073 patent, and it has been more than one year since Arthrex, Inc. was served with a Complaint alleging infringement of the '073 patent.

(d) *Bonutti Skeletal Innovations v. DePuy Mitek, Inc.*, Civil Action No. 1:2012cv11667 (D. Mass 2012). This litigation is pending, and involves a number of claims of the '073 patent in addition to claim 35, the only claim challenged in the instant *Inter Partes* Review. DePuy Mitek, Inc. (“DePuy”) has not filed an *Inter Partes* Review for the '073 patent, and it has been more than one year since DePuy was served with a Complaint alleging infringement of the '073 patent.

(e) *Biomet Inc. v. Bonutti Skeletal Innovations LLC*, Civil Action No. 3:2013cv00176 (N.D. In. 2013). This litigation is pending. Biomet Inc. has not as not filed an *Inter Partes* Review for the '073 patent, and moreover, cannot file an *Inter Partes* Review for the '073 patent because it is the Plaintiff in the above-referenced litigation which seeks a declaratory judgment of invalidity of the '073 patent.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the parties’ written settlement agreement is being filed as Exhibit 2001 contemporaneously with this joint motion to terminate. The parties desire that the settlement agreement be maintained as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. 42.74 (c), and a separate joint request for such is being filed contemporaneously. In view of that request the settlement agreement has been filed for access by the “Parties and Board Only.”

Respectfully submitted,

Date: January 9, 2014

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CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of January 2014, a true and correct copy of the foregoing **JOINT MOTION TO TERMINATE *INTER* PARTIES REVIEW** was served by electronic mail and First-Class U.S. Mail, upon the following counsel of record for Petitioner Smith and Nephew, Inc.:

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