

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.,

Petitioner

v.

ACANTHA LLC,

Patent Owner.

Case IPR2020-00706

Patent RE43,008 E

JOINT MOTION TO TERMINATE PROCEEDING

I. INTRODUCTION

Petitioner NuVasive, Inc. and Patent Owner Acantha LLC (“the Parties”) have fully executed a settlement agreement in writing that resolves all underlying disputes between the Parties, including this proceeding. *See* Exhibit 2019. In an email dated September 23, 2020, the Board authorized the parties to file a joint motion to terminate this *inter partes* review. The Parties agree that each Party will bear its own fees and costs.

As required by the Board and by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), the parties jointly certify that they are submitting herewith a true, fully executed copy of the settlement agreement (Exhibit 2019) along with a joint request to file that settlement agreement as business confidential information designated “Parties and Board Only,” as authorized by the Board in its September 23, 2020 email and by 37 C.F.R. § 42.74(c). The parties also jointly certify that aside from the settlement agreement filed herewith, there are no collateral agreement or understandings made in connection with, or in contemplation of, the termination of this proceeding.

II. STATUS OF PROCEEDINGS

This IPR is in its early stages. A Decision Granting Institution was only just issued in the present proceeding on August 25, 2020, Paper No. 11.

The following are the only proceedings between the parties in the United States, or that involve the subject patent:

District Court Case	Status
<i>Acantha LLC v. NuVasive, Inc.</i> , Case No. 4:19-CV-10656-MFL-EAS (E.D. Michigan)	Joint motion to dismiss proceeding with prejudice granted on September 29, 2020

USPTO Action	Status
IPR2020-00684	Joint motion to terminate filed concurrently with this motion
IPR2020-00706	Subject of this joint motion to terminate

III. **RELIEF REQUESTED**

Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety. Termination is appropriate, especially in view of the early stage of the proceedings, because of the settlement agreement the parties are filing herewith, which ends all patent disputes between the parties, including this proceeding.

Congress and the federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Delta Air Lines, Inc. v. August*, 450 U.S. 346, 352 (1981) (“The purpose of [Federal Rule of Civil Procedure] 68 is to encourage the settlement of litigation.”); *Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), cert. denied, 479 U.S. 950 (1986). The Federal Circuit also places a particularly strong emphasis on settlement. *See Cheyenne River Sioux Tribe v. U.S.*, 806 F.2d 1046, 1050 (Fed. Cir. 1986) (noting that the law favors settlement to reduce antagonism and hostility

between parties). Moreover, the Board generally expects that a proceeding will terminate after the filing of a settlement. *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

This is especially true for a proceeding in its early stages, like this IPR. The Board can conserve significant administrative and judicial resources by terminating the proceeding now, removing the need for the Board to review any additional briefing by the Parties, hold oral argument, or render a final written decision. The Board has terminated entire IPR proceedings even after the merits had been fully briefed and the matter was ready for oral argument, and even after a final written decision and appeal. *See, e.g., Toyota Motor Corp. v. Blitzsafe Tex. LLC*, IPR2016-00421, Paper 28, at 2-3 (P.T.A.B. Feb. 21, 2017) (granting motion to terminate even after all substantive papers were filed, “particularly in light of the fact that a final written decision is not due until more than four months from now”); *Samsung Elecs. Co., Ltd. v. Image Processing Techs. LLC*, IPR2017-00353, Paper 51 (P.T.A.B. Sept. 9, 2020) (granting motion to terminate even after remand from the Federal Circuit following final written decisions). The case for termination is all the stronger here, where the proceeding has only just begun and the Parties have not yet filed any post-Institution briefing.

IV. CONCLUSION

For the foregoing reasons, Petitioner and Patent Owner jointly request that the Board terminate this proceeding in its entirety.

Dated: September 29, 2020

Respectfully submitted,

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CERTIFICATE OF SERVICE UNDER 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that a copy of the foregoing **JOINT MOTION TO TERMINATE PROCEEDING, JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317(b), and EXHIBIT 2019** has been served via Electronic Mail on September 29, 2020 upon the following:

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