**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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ZIMVIE, INC. AND ZIMMER BIOMET SPINE, LLC,
Petitioners

v.

ROGER P. JACKSON,
Patent Owner

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Case IPR2023-01431
U.S. Patent No. 10,548,641

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# JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, and the Board's email of April 30, 2024, Petitioners ZimVie, Inc. ("ZimVie") and Zimmer Biomet Spine, LLC ("ZBS") (collectively, "Petitioners") and Patent Owner Dr. Roger P. Jackson ("Patent Owner") (collectively, the "Parties") have reached a resolution and jointly agree to terminate the above-captioned proceeding.

## I. STATEMENT OF FACTS

ZBS and Patent Owner have reached an agreement (the "Agreement") to resolve all disputes between the Parties relating to U.S. Patent No. 10,548,641 (the "'641 Patent").

Pursuant to 37 C.F.R. § 42.74(b), the Agreement is in writing, and a true and correct copy is being filed as Confidential Exhibit 1045. The Agreement is being filed electronically, concurrently with this motion, with access to "Board and Parties Only." A *Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74* will be filed concurrently with this Joint Motion to Terminate and requests that the Agreement be treated as business confidential information and kept separate from the files of the involved patent, the '641 Patent, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

## II. RELIEF REQUESTED

Termination of this *inter partes* review, IPR2023-01431, is requested, and the Parties respectfully submit that such termination is justified.

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." Moreover, "[t]here are strong public policy reasons to favor settlement between the parties to a proceeding." Consolidated Trial Practice Guide 86 (Nov. 2019). "The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding." *Id*. (citing 35 U.S.C. § 317(a)).

Here, the Agreement settles all disputes between the Parties relating to the '641 Patent and have filed, concurrently with this motion, a true and correct copy of the Agreement as Confidential Exhibit 1045. The Board has not decided the merits of this proceeding. As such, the Parties respectfully submit that granting the Parties' Joint Motion to Terminate at this juncture would serve to preserve the Board's and Parties' resources and promote a speedy and inexpensive resolution. 37 C.F.R. § 42.1(b).

## III. CONCLUSION

In view of the above, the Parties respectfully request that the above-captioned *inter partes* review, IPR2023-01431, be terminated.

Respectfully submitted,

FAEGRE DRINKER BIDDLE & REATH LLP

Dated: May 1, 2024

By: *__/ Victor P. Jonas /_____*

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Dated: May 1, 2024

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***Attorney for Patent Owner***

## CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on May 1, 2024, I caused a true and accurate copy of the Joint Motion to Terminate to be served on counsel for Patent Owner via email, as follows:

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Dated: May 1, 2024

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