

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

ROGER P. JACKSON,
Patent Owner

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

AMENDED JOINT MOTION TO TERMINATE

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.74, the Board’s email of April 30, 2024, and the Board’s May 3, 2024 Order, 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 was filed as Confidential Exhibit 1045. The Parties certify that there are no other agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding.

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 the Parties have filed a true and correct copy of the Agreement as Confidential Exhibit 1045. The Parties certify that there are no other agreements or understandings, oral or written, between the Parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding. The Board has not decided the merits of this proceeding. As such, the Parties respectfully submit that granting the Parties’ Amended 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 7, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on May 7, 2024, I caused a true and accurate copy of the Amended Joint Motion to Terminate to be served on counsel for Patent Owner via email, as follows:

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