

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTERSECT ENT, INC.,

Petitioner,

v.

NEW AMSTERDAM, LLC

Patent Owner.

Case No. IPR2024-00713

U.S. Patent No. 6,916,483

**CORRECTED JOINT MOTION TO TERMINATE
PURSUANT TO 35 U.S.C. § 317 AND 37 C.F.R. §§ 42.72, 42.74**

PETITIONER’S EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent No. 6,916,483 (“’483 Patent”).
1002	Affidavit of Service in <i>New Amsterdam, LLC v. Medtronic, Inc.</i> , No. 1:23-cv-00460-RP (W.D. Tex. April 27, 2023).
1003	U.S. Patent No. 6,936,270 (“ <i>Watson</i> ”).
1004	U.S. Patent No. 5,769,899 (“ <i>Schwartz</i> ”).
1005	File History, Application No. 10/200,355
1006	Complaint in <i>New Amsterdam LLC v. Medtronic, Inc.</i> , No. 1:23-cv-00460-RP (W.D. Tex).
1007	Complaint in <i>New Amsterdam LLC v. Medtronic plc, et al.</i> , Case No. 2:23-cv-421-JRG-RSP (E.D. Tex.)
1008	Notice of Hearing: In-Person Scheduling/Case Management Conference Reset for March 25, 2024
1009	U.S. Pub. No. 2004/0013702A1 (“ <i>Glover</i> ”).
1010	U.S. Patent No. 5,916,584 (“ <i>O’Donoghue</i> ”).
1011	U.S. Patent No. 6,579,533 (“ <i>Tormala</i> ”).
1012	Waiver of Service for Intersect ENT, Inc. in <i>New Amsterdam LLC v. Medtronic plc, et al.</i> , Case No. 2:23-cv-421 (E.D. Tex.).

1013	Preliminary Infringement Contentions, <i>New Amsterdam LLC v. Medtronic plc, et al.</i> , Case No. 2:23-cv-421 (E.D. Tex. Mar. 11, 2024).
1014	Plaintiff's Preliminary Infringement Claim Chart, <i>New Amsterdam LLC v. Medtronic plc, et al.</i> , Case No. 2:23-cv-421 (E.D. Tex. Mar. 11, 2024).
1015	https://www.britannica.com/animal/mammal
1016	https://operonstrategist.com/orthopaedic-implants-manufacturing/
1017	Declaration of Bruce Beynnon, in Support of Intersect ENT, Inc.'s Petition for <i>Inter Partes</i> Review.
1018	<i>Curriculum Vitae</i> of Bruce Beynnon.
1019	Email authorizing the parties to file a joint motion to terminate the proceeding and a joint request to treat the settlement agreement as business confidential (Jun. 7, 2024).
1020	Non-Exclusive License and Settlement Agreement.

I. INTRODUCTION

Pursuant to 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72, 42.74, Petitioner Intersect ENT, Inc. (“Petitioner”) and Patent Owner New Amsterdam, LLC (“Patent Owner”) jointly move to terminate this *inter partes* review proceeding pursuant to a confidential settlement agreement related to U.S. Patent No. 6,916,483 (the “’483 Patent”), the patent subject to the instant proceeding.

The Board authorized the parties to file this joint motion on June 7, 2024. EX1019. The parties are submitting this joint motion to terminate, as well as a true copy of the Non-Exclusive License and Settlement Agreement (EX1020). Because Intersect ENT, Inc. is the only Petitioner in this *inter partes* review proceeding, the Non-Exclusive License and Settlement Agreement resolves all disputes related to the ’483 Patent, and this proceeding should be terminated as to both Petitioner and Patent Owner.

II. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

Patent Owner filed a patent-infringement lawsuit against real party in interest Medtronic, Inc. on April 22, 2023, in the United States District Court for the Western District of Texas (*New Amsterdam LLC v. Medtronic, Inc.*, Case No. 1:23-cv-460 (W.D. Tex.)) During the pendency of that case, Patent Owner filed a second patent-infringement against Petitioner and real parties in interest Medtronic plc, Medtronic, Inc., Medtronic USA, Inc., and Medtronic Xomed, Inc. on September 15, 2023, in

the United States District Court for the Eastern District of Texas (*New Amsterdam LLC v. Medtronic, plc, et al.*, Case No. 2:23-cv-421-JRG-RSP (E.D. Tex.)). Medtronic, Inc. filed a motion to dismiss for improper venue on July 20, 2023. Dkt. 12, *New Amsterdam LLC v. Medtronic, Inc.*, Case No. 1:23-cv-460 (W.D. Tex. Jul. 20, 2023). After supplemental briefing, Patent Owner requested that the court dismiss the Western District case without prejudice. Dkt. 22, *New Amsterdam LLC v. Medtronic, Inc.*, Case No. 1:23-cv-460 (W.D. Tex. Jan. 8, 2024). The court entered an order on January 29, 2024, dismissing all claims and counterclaims in the case without prejudice. Dkt. 23, *New Amsterdam LLC v. Medtronic, Inc.*, Case No. 1:23-cv-460 (W.D. Tex. Jan. 29, 2024).

Petitioner filed a petition for *inter partes* review in this proceeding on March 25, 2024. Paper 1. On April 26, 2024, Patent Owner and real party in interest Medtronic, Inc. entered into a Non-Exclusive License and Settlement Agreement that resolved the underlying dispute in this *inter partes* review proceeding and the pending case in the Eastern District of Texas. EX1020.

Termination of this proceeding is appropriate here because all disputes between Petitioner and Patent Owner regarding the '483 Patent have been resolved. Joint motions to terminate as a result of settlement are routinely granted. The case for termination is strong in the instant proceeding because only the petition was filed recently, Patent Owner has not filed a preliminary response, and the Board has not

issued a decision on institution. Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), a true copy of the Non-Exclusive License and Settlement Agreement resolving the dispute in this proceeding is being submitted as EX1020 by the parties, along with a request that the agreement is treated as business confidential information to be kept separate from the files of this proceeding under 37 C.F.R. § 42.74(c). The parties certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).

III. CONCLUSION

For the reasons set forth above, Petitioner and Patent Owner respectfully request that the Board terminate this *inter partes* review proceeding. Because this proceeding is being terminated regarding Petitioner, no estoppel pursuant to 35 U.S.C. § 315(e) shall attach to Petitioner. *See* 35 U.S.C. § 317(a).

Respectfully submitted,

June 17, 2024

/John Wittenzellner/
John Wittenzellner
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/M. Scott Fuller/
M. Scott Fuller
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, the undersigned certifies that on June 17, 2024, the foregoing document was served on counsel of record for Patent Owner by filing this document through the End-to-End System, as well as via electronic mail to counsel of record for Patent Owner at the following address:

M. Scott Fuller (sfuller@ghiplaw.com)

Rene A. Vazquez (rvazquez@singergialaw.com)

Dated: June 17, 2024

Respectfully submitted,

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