

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLVENTUM CORPORATION,

PETITIONER

V.

WOUND HEALING TECHNOLOGIES, CORP.

PATENT OWNER

IPR2025-01042

U.S. PATENT NO. 10,639,404

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF
U.S. PATENT NO. 10,639,404**

LIST OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 10,639,404 (the “’404 Patent”)
1002	Declaration of Dr. Morten O. Jensen, Ph.D., DrMed
1003	Morten Jensen <i>curriculum vitae</i>
1004	U.S. Publication No. 2008/0208147 (“Argenta”)
1005	U.S. Publication No. 2010/0042021 (“Hu”)
1006	U.S. Patent No. 10,639,404 File History
1007	U.S. Patent No. 6,071,267 (“Zamierowski”)
1008	U.S. Patent No. 7,520,872 (“Biggie”)
1009	U.S. Publication No. 2005/0131327 (“Lockwood”)
1010	U.S. Publication No. 2010/0137775 (“Hu775”)
1011	U.S. Publication 2007/0027414 (“Hoffman”)
1012	RESERVED
1013	Okan D., et al., <i>The Role of Moisture Balance in Wound Healing</i> , Advances in Skin and Wound Care, Vol. 20, No. 1 at 39 (Jan. 2007)
1014	U.S. Publication No. 2009/0234306 (“Vitaris”)
1015	U.S. Publication No. 2004/0073151 (“Weston”)
1016	Chariker, M.E., et al., <i>Effective management of incisional and cutaneous fistulae with closed suction wound drainage</i> , Contemporary Surgery, Vol. 34 at 59 (June 1989)
1017	Jerome, D., <i>Advances in Negative Pressure Wound Therapy The VAC Instill</i> , J. of Wound, Ostomy and Continence Nursing, 34(2) at 191 (March 2007)
1018	Thomas, S., <i>Hydrocolloid Dressings in the Management of Acute Wounds: a review of the literature</i> , Int’l. Wound J., 5(5) at 602 (2008)

1019	Bui, T.D., et al., <i>Negative Pressure Wound Therapy with Off-The-Shelf components</i> , Am. J. of Surgery, 192 at 235 (2006)
1020	Reserved
1021	Orgill D.P., et al., <i>The Mechanism of Action of Vacuum Assisted Closure: More to Learn</i> , Surgery 146(1) at 40 (2009)
1022	Miller-Mikolajczyk C., et al. <i>The Evolution of Commercial Negative Pressure Wound Therapy Systems over the Past Three Decades</i> , Adv. In Wound Care, 13(8) at 375 (2024)
1023	Argenta L.C. & Morykwas, M.J., <i>Vacuum-assisted Closure: A New Method for Wound Control and Treatment: Clinical Experience</i> , Annals Plastic Surgery, 38(6) at 563-576 (1997)
1024	Morykwas, M.J., et. al., <i>Vacuum-assisted Closure: A New Method for Wound Control and Treatment: Animal Studies and Basic Foundation</i> , Annals Plastic Surgery, 38(6) at 553 (1997)
1025	The Theory and Practice of Vacuum Therapy (Christian Willy, ed.) (2006)
1026	Williams, C. <i>Granuflex</i> , Br. J. Nurs., 3(14) at 730 (1994)
1027	Williams, C. <i>Hydrocoll: A 'New Breed' of Hydrocolloid Wound Dressing</i> , Br. J. Nurs., 7(21) at 1337 (1998)
1028	RESERVED
1029	Gabriel, A., et al., <i>A Clinical Review of Infected Wound Treatment with Vacuum Assisted Closure® (V.A.C.®) Therapy: Experience and Case Series</i> , Int'l Wound J., 6 (suppl. 2) at 1 (2009)
1030	Eaglestein, W.H., <i>Moist Wound Healing with Occlusive Dressings: A Clinical Focus</i> , Dermatologic Surgery 27 at 175-181 (2001)
1031	Field, C.K. & Kerstein, M.D., <i>Overview of Wound Healing in a Moist Environment</i> , Am. J. of Surgery, 167(1A(Suppl)) at 1S (Jan. 1994)
1032	<i>Wound Healing Technologies Corp. v. Solventum Corp.</i> , No. 6:24-cv-589 (W.D. Tex filed Nov. 15, 2024)
1033	Assignment of U.S. Application No. 13/152,446 from Isaac Lichtenstein to Wound Healing Technologies, LLC (June 3, 2011)
1034	Declaration of Michael P. Kahn in Support of Petitioner Solventum's Notice of Intent to Designate Michael P. Kahn as a Provisionally

	Recognized PTAB Attorney Eligible for Automatic <i>Pro Hac Vice</i> Admission as Backup Counsel Pursuant to 37 C.F.R. § 42.10
1035	Declaration of Caitlin Olwell, Esq. in Support of Petitioner's Opposition to Patent Owner's Request for Discretionary Denial of Institution
1036	December 30, 2021 Letter from FDA to Lightstone Medical Products (Ningbo) Co. Ltd. <i>available at</i> : https://www.accessdata.fda.gov/cdrh_docs/pdf20/K202898.pdf
1037	<i>Wound Healing Techs. Corp. v. Solvendum Corp.</i> , No 6:24-cv-589 (W.D. Tex) (Dkt. 30) (Order granting motion to stay)
1038	June 11, 2010, 510(k) Summary: Prevena™ Incision Management System, <i>available at</i> https://www.accessdata.fda.gov/cdrh_docs/pdf10/K100821.pdf
1039	September 16, 2025 PTO Memorandum Regarding PTAB Consideration of Prior Findings of Fact and Conclusions of Law
1040	3M United States Securities and Exchange Commission Form 10 (Jan. 26, 2024), <i>available at</i> https://www.sec.gov/Archives/edgar/data/1964738/000162827924000036/filename1.htm
1041	3M United States Securities and Exchange Commission Form 10 Exhibit 99.1 (Jan. 26, 2024), <i>available at</i> https://www.sec.gov/Archives/edgar/data/1964738/000162827924000036/filename14.htm
1042	Settlement Agreement

I. INTRODUCTION AND STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72, Petitioner, Solventum Corporation, and Patent Owner, Wound Healing Technologies, LLC, (together, the “Parties”) jointly request termination of the Inter Partes Review of U.S. Patent No. 10,639,404 (“the ’404 Patent”) in IPR2025-01042. On June 23, 2026, the Parties informed the Board of a settlement agreement between Petitioner and Patent Owner via email and requested authorization to file a Joint Motion to Terminate the proceedings with respect to both the Petitioner and the Patent Owner. In an email dated June 24, 2026, the Board authorized the filing of the requested Joint Motion to Terminate. Accordingly, Petitioner and Patent Owner jointly request termination of the present proceeding. The parties are concurrently filing a true copy of their settlement agreement along with the Parties’ Joint Request to Keep Confidential and Separate and the Parties ask the Board to treat the settlement agreement as business confidential information and to keep it separate from the files of the involved patent.

II. STATEMENT OF FACTS

On November 15, 2024, in a case captioned *Wound Healing Technologies Corp. v. Solventum Corp.*, No. 6:24-cv-00589 (W.D. Tex. 2024), Patent Owner filed a patent infringement action against Petitioner in the Western District of Texas alleging that several of Petitioner’s products infringed one or more claims of the ’404 Patent (the “Litigation”). EX1032. The parties currently involved in that

litigation are Petitioner, Solventum Corp., and Patent Owner, Wound Healing Technologies Corp.

Petitioner filed its petition for *inter partes* review in this matter on June 13, 2025 (Paper 1), and the Board issued a Notice of Filing Date Accorded on July 3, 2025 (Paper 3). The Board entered institution on December 11, 2025 (Paper 13). Patent Owner filed its Response on March 5, 2026 (Paper 17). Petitioner has not yet filed its Reply and the Board has not yet entered a final written decision. There are no other related proceedings involving the '404 Patent currently before the Office. On May 28, 2026, the parties entered into a settlement agreement resolving their disputes regarding the '404 Patent, including an agreement to terminate this *inter partes* review and an agreement to terminate the co-pending Litigation. *See* Exhibit 1042. Upon finalizing the settlement agreement, the Parties informed the Board, seeking permission to file this motion and a corresponding request to treat the settlement agreement as business confidential information. The Board authorized these filings in a responsive email on June 24, 2026.

III. ARGUMENT

Under 35 U.S.C. § 317(a), an *inter partes* review “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.” 35 U.S.C. § 317(a). A joint motion to terminate must generally

“(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Mylan Pharmaceuticals Inc. v. Biogen MA Inc.*, IPR2018-01403, Paper 90 at 2 (PTAB Nov. 18, 2019).

Termination of this proceeding is appropriate because (i) all pending disputes between the Parties have been resolved by the settlement agreement; (ii) the Board has not yet decided the merits of this proceeding; and (iii) termination would save significant further expenditure of resources by the Parties and the Board.

In addition to the current proceeding, the '404 Patent was at issue in the Litigation. On June 17, 2026, the court overseeing the Litigation issued an order closing the case in view of the parties' dismissal of all claims with prejudice by joint stipulation. *Wound Healing Techs. Corp. v. Solvatum Corp.*, No. 6:24-cv-00589 (W.D. Tex. June 17, 2026) (Dkt. 42 order closing case). There are no other proceedings involving the '404 Patent currently before the Office and no other parties are involved in any related litigation involving the '404 Patent.

The Parties are concurrently filing a copy of the settlement agreement as Exhibit 1042 along with a request to treat it as business confidential information pursuant to 35 U.S.C. § 317(b). Pursuant to 37 C.F.R. § 42.74(b), the Parties

acknowledge, as of the filing of this Motion and the concurrent Request to Keep Confidential and Separate, that Exhibit 1042 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1042 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. There are no other collateral agreements, whether written or oral, between the Parties made in connection with, or in contemplation of, the termination sought by the settlement agreement. The Parties agree that neither Patent Owner nor Petitioner will be prejudiced by termination of this proceeding.

Motions to terminate based on a joint request are routinely granted before substantive briefing has been completed or an oral hearing has been held.¹ Here, the Parties have not yet completed substantive briefing, an oral hearing has not been held, a final written decision has not issued, and thus termination upon the settlement of the Parties' dispute is appropriate. Public policy also favors terminating the present petition for *inter partes* review. Both federal courts and the Board have

¹ See, e.g., *OnePlus Technology (Shenzhen) Co. v. Pantech Corp.*, IPR2025-00756, Paper 24 at 2-3 (PTAB June 12, 2026); *Amazon.com v. NL Giken Inc.*, IPR2025-00050, Paper 17 at 2-3 (PTAB June 10, 2025); *United Services Automobile Ass'n v. Auto Telematics Ltd.*, IPR2025-00812, Paper 26 at 2 (PTAB May 26, 2026); *Intas Pharms. Ltd. v. Atossa Therapeutics, Inc.*, IPR2025-00799 (PTAB May 11, 2026) (Paper 46 at 2–3).

expressed a strong interest in encouraging settlement in litigation. *See Bergh v. Dept. of Transp.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986), *cert. denied*, 479 U.S. 950 (1986) (“The law favors settlement of cases.”); Patent Trial and Appeal Board Consolidated Trial Practice Guide (November 2019) at 86 (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”). Accordingly, 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.* The Parties have also met the statutory requirement that they file a “joint request” to terminate before the Office “has decided the merits of the proceeding.” 35 U.S.C. § 317(a).

Finally, termination upon settlement would also further the purpose of IPR proceedings, which seek to provide an efficient and less costly alternative forum for patent disputes. Maintaining the proceeding would discourage further settlements, as patent owners in similar situations would have a strong disincentive to settle if they perceived that an IPR would continue regardless of a settlement.

IV. CONCLUSION

Termination is appropriate under 35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 as the issues in this proceeding have not been fully briefed, no oral hearing has been held, no other parties are involved in litigation concerning the ’404 Patent, and the Parties jointly request that the Board terminate this proceeding. As provided by 35

U.S.C. § 317(a) and 37 C.F.R. § 42.73(d), and because the Parties jointly request this termination, no estoppel under 35 U.S.C. § 315(e) shall attach to Petitioner.

Dated: June 25, 2026

Respectfully submitted,

/s/Daniel L. Moffett

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of this Joint Motion to Terminate *Inter Partes* Review of U.S. Patent No. 10,639,404 was served on counsel of record on June 25, 2026, by filing this document through the Patent Trial and Appeal Case Tracking System (P-TACTS) as well as delivering a copy via electronic mail to the counsel of record for the Patent Owner at the following addresses:

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