Trial@uspto.gov
571-272-7822

Paper No. 74
Entered: April 15, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATRIUM MEDICAL CORPORATION
Petitioner

v.

DAVOL INC.
Patent Owner

Case IPR2013-00187
Patent 7,785,334 B1

Before JAMESON LEE, SCOTT E. KAMHOLZ, GEORGIANNA W. BRADEN, and JENNIFER M. MEYER, *Administrative Patent Judges*.

MEYER, *Administrative Patent Judge.*

JUDGMENT
Termination of the Proceeding
35 U.S.C. § 317(a) and *37 C.F.R. § 42.72*

On April 3, 2014, the parties filed a joint motion (Paper No. 70) to terminate this *inter partes* review. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. With the motion, the parties filed a copy of a document they described as the written settlement agreement (Ex. 2148), and jointly requested the settlement agreement be treated as business confidential information under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

In their joint motion, the parties state that they have settled all of their disputes involving the 7,785,334 B1 Patent ("the '334 Patent"), and foreign counterparts of the '334 Patent, including all litigation and patent office proceedings (U.S. and foreign) related thereto. Paper No. 70 at 1, 4.

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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed." Per 37 C.F.R. § 42.74(b), "[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before termination of the trial." The requirements for termination with respect to the petitioner ("Atrium") have been met.

Under 35 U.S.C. § 317(a), "[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a)." Atrium is the sole petitioner. The Board has discretion to terminate this review with respect to the patent owner ("Davol").

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.,* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The Board has not yet decided the merits of

the instant proceeding. Furthermore, no dispute remains between Atrium and Davol involving the ’334 Patent, or foreign counterparts of the ’334 Patent. Therefore, the Board determines that, in the circumstances of this case, it is appropriate to terminate the trial without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

On April 3, 2014, the parties also filed a joint motion (Paper No. 71) to: (1) withdraw pending Motions to Seal; and (2) expunge certain documents from the record. The parties specifically request withdrawal of Davol’s Motions to Seal filed as Paper Nos. 34 and 61, as well as Atrium’s Motions to Seal filed as Paper Nos. 50 and 67. Paper No. 71 at 1. The parties further request that unredacted versions of confidential documents be expunged from the record. These unredacted documents are the subject of the Motions to Seal that the parties now seek to withdraw. Specifically, the parties move to expunge the following documents:

- Paper 39, Patent Owner’s Response (unredacted version);
- Paper 49, Petitioner’s Reply (Confidential) (unredacted version);
- Paper 59, Patent Owner’s Motion for Observations on the Cross Examination of Mr. Theodore Karwoski (unredacted version);
- Paper 65, Petitioner’s Response to Patent Owner’s Motion for Observations on Cross Examination of Mr. Theodore Karwoski (unredacted version);
- Exhibit 1133, Transcript of Deposition of Michael Lee (Confidential) (unredacted version);
- Exhibit 1134, Transcript of Deposition of Donna S. Torres (Confidential) (unredacted version);
- Exhibit 1135, Transcript of Deposition of Valerie Grahn, née Vadorro (Confidential) (unredacted version);

- Exhibit 1136, Transcript of Deposition of James Mello (Confidential) (unredacted version);
- Exhibit 2109, Declaration of Donna S. Torres (unredacted version);
- Exhibit 2110, Project Initiation Memorandum (unredacted version);
- Exhibit 2111, Torres Lab Notebook 1 (unredacted version);
- Exhibit 2112, Pig Study Results (unredacted version);
- Exhibit 2113, Torres Lab Notebook 2 (unredacted version);
- Exhibit 2114, Summary of Pig Study Results (unredacted version);
- Exhibit 2115, Declaration of Valerie Grahn, née Vadurro (unredacted version);
- Exhibit 2116, Declaration of James Mello (unredacted version);
- Exhibit 2117, Declaration of Michael Lee (unredacted version);
- Exhibit 2121, Ventralex Sales Revenue (unredacted version); and
- Exhibit 2147, Transcript of Deposition of Theodore Karwoski (unredacted version).

The documents to be expunged were submitted after institution of trial and were not considered by the Board in instituting trial. Furthermore, redacted versions of these confidential documents remain a part of the record; the parties do not seek to expunge the corresponding redacted documents.

Based on the facts in this case and the termination of the proceedings, we hereby grant the parties' joint motion to withdrawn their Motions to Seal and to expunge specific exhibits from the record.

It is, therefore,

ORDERED that the joint motion to terminate the *inter partes* review captioned IPR2013-00187 is GRANTED and the proceeding is hereby terminated;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 2148) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED;

FURTHER ORDERED that the parties' joint motion to withdraw Davol's Motions to Seal filed as Paper Nos. 34 and 61, and Atrium's Motions to Seal filed as Paper Nos. 50 and 67 is GRANTED; and

FURTHER ORDERED that the parties' joint motion to expunge Paper 39 (unredacted version), Paper 49 (unredacted version), Paper 59 (unredacted version), Paper 65 (unredacted version), Exhibit 1133 (unredacted version), Exhibit 1134 (unredacted version), Exhibit 1135 (unredacted version), Exhibit 1136 (unredacted version), Exhibit 2109 (unredacted version), Exhibit 2110 (unredacted version), Exhibit 2111 (unredacted version), Exhibit 2112 (unredacted version), Exhibit 2113 (unredacted version), Exhibit 2114 (unredacted version), Exhibit 2115 (unredacted version), Exhibit 2116 (unredacted version), Exhibit 2117 (unredacted version), Exhibit 2121 (unredacted version), and Exhibit 2147 (unredacted version) is GRANTED; and upon entry of this decision, those exhibits will be expunged from the record of the instant proceedings.

For PETITIONER:

David L. Cavanaugh
David.Cavanaugh@wilmerhale.com

Larissa B. Park
Larissa.Park@wilmerhale.com

For PATENT OWNER:

Jason M. Honeyman
JHoneyman-PTAB@wolfgreenfield.com

Richard F. Giunta
RGiunta-PTAB@wolfgreenfield.com