

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESPIRONICS, INC.
Petitioner

v.

ZOLL MEDICAL CORPORATION
Patent Owner

Case IPR2013-00322
Patent 6,681,003

Before BRYAN F. MOORE, BRIAN J. MCNAMARA, and
GARTH D. BAER, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER
Termination of Proceeding
35 U.S.C. § 317; 37 C.F.R. § 42.72

On February 17, 2016, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceedings (“Joint Motion”) (Paper 52), a Joint Motion to File Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (“Joint Request”) (Paper 53), and an agreement made in contemplation of termination of this proceeding (“Agreement”) (Exhibit 2015).

The Board entered a Final Written Decision on September 17, 2014. Paper 46. The case was appealed by Petitioner to the Federal Circuit. On appeal, the Federal Circuit vacated the September 17, 2014, final written decision as to claims 2, 4, 5, 8, 9, 16, 19, and 20, and remanded to the Board for further consideration. *Respironics, Inc., v. Zoll Medical Corp.*, No. 2015-1485. slip op. at 11 (Fed. Cir. July 29, 2016). Petitioner did not appeal, and the Federal Circuit did not disturb, the Board’s Final Written Decision as to claim 1. Patent Owner has filed a statutory disclaimer under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming claim 1. Ex. 3001. The Board has not issued a Decision on Remand. Thus, the Board has not finally decided the merits of the proceeding as to remaining claims 2, 4, 5, 8, 9, 16, 19, and 20. In the Joint Motion, the parties represent that the settlement “resolves all underlying disputes between the parties” but is contingent on the Board terminating this *inter partes* review. Paper 52, 1–2.

Under 35 U.S.C. § 317(b), any agreement or understanding between Patent Owner and Petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. In the Joint Motion, the parties indicate they have “entered into a Confidential Settlement Agreement and an amendment thereto,” and state that “there are no other collateral agreements

between Petitioner and Patent Owner and . . . Exhibit 2015 represents a true and accurate copy of the Amended Confidential Settlement Agreement between the parties.” Paper 52, 1.

The Joint Request seeks to have Exhibit 2015 treated as business confidential information under 37 C.F.R. § 42.74(c).

Upon consideration of the Joint Motion, we grant the Joint Motion and terminate this proceeding as to both Petitioner and Patent Owner. 37 C.F.R. § 42.72. We also grant the parties’ Joint Request to maintain Exhibits 2011 and 2012 as business confidential information in accordance with 37 C.F.R. § 42.74(c).

ORDER

It is

ORDERED that the Joint Motion to Terminate Proceedings (Paper 52) is *granted* and that this proceeding is hereby *terminated*; and

FURTHER ORDERED that the Joint Motion to File Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 (Paper 53) is *granted*, and that Exhibits 2011 and 2012 are regarded as business confidential information under 37 C.F.R. § 42.74(c) and will be kept separate from the file of U.S. Patent No. 6,681,003.

Case IPR2013-00322
Patent 6,681,003

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