Trials@uspto.gov
Tel: 571-272-7822

Paper No. 29
Filed: September 12, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APEX MEDICAL CORP.,
Petitioner,

v.

RESMED LIMITED,
Patent Owner.

Case IPR2013-00516
Patent 7,997,267

Before SCOTT E. KAMHOLZ, BARRY L. GROSSMAN, and CARL M. DEFRANCO, *Administrative Patent Judges.*

KAMHOLZ, *Administrative Patent Judge.*

JUDGMENT
Termination of the Proceeding
37 C.F.R. § 42.74

The parties filed a joint motion to terminate the instant proceeding (Paper 26 ("Mot.")) and a true copy of their written settlement agreement (Ex. 2035) made in connection with the termination, in accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b). The parties also jointly requested that their settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 27.

For the reasons provided below, the joint motion to terminate is granted. The joint request that the settlement agreement be treated as business confidential information is also granted.

While the parties may agree to settle their issues related to the involved patent, the Board is not a party to the settlement and may determine independently any question of patentability. 37 C.F.R. § 42.74(a).

Patent Owner has already filed a Response (Paper 14), and Petitioner has filed a Reply (Paper 23), but the record is not yet closed, and the Board has not yet decided the merits of this proceeding. The parties represent that the '267 patent is the subject of an exclusion order issued in ITC investigation No. 337-TA-879, as well as a stayed district court action, *ResMed Inc. et al v. Apex Medical Corp. et al.*, No. 8:13-cv-00498 (C.D. Cal.). Mot. 5-7. The parties further represent that these matters are covered by the settlement agreement. *Id.* at 6, 7.

The parties also represent that the '267 patent is the subject of another ITC investigation, No. 337-TA-890, and another district court action, *ResMed Inc. et al v. BMC Medical Co., Ltd. et al.*, No. 3:13-cv-0146 (S.D. Cal.), both of which remain ongoing. Mot. 8-9. Petitioner Apex Medical Corp. is not a party to these other proceedings. *Id.*

In view of the parties' settlement agreement made in connection with the termination in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), we determine that it is appropriate to terminate the involvement of Petitioner. Moreover, we determine that it also is appropriate to terminate the proceeding with respect to Patent Owner, because we have not yet decided the merits of this proceeding, and the record is not yet closed. As a result, it is appropriate to enter judgment in the form of termination. *See* 37 C.F.R. § 42.2.

Accordingly, it is

ORDERED that the joint motion to terminate IPR2013-00516 is *granted*, and this proceeding is hereby terminated as to all parties, including Petitioner Apex Medical Corp. and Patent Owner ResMed Limited; and

FURTHER ORDERED that the joint request that the settlement agreement be treated as business confidential information and be kept separate from the patent files under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*.

FOR PETITIONER:

Henry A. Petri, Jr.
James P. Murphy
Margaux Aviguetero
NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP
henry.petri@novakdruce.com
james.murphy@novakdruce.com
margaux.aviguetero@novakdruce.com

FOR PATENT OWNER:

Stephen R. Schaefer
Timothy W. Riffe
Michael Kane
FISH & RICHARDSON P.C.
schaefer@fr.com
riffe@fr.com
IPR36784-0013IP1@fr.com