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Paper 16
Entered: March 21, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARESTREAM HEALTH, INC.
Petitioner

v.

SMARTPLATES, LLC
Patent Owner

IPR2013-00600
Patent 8,374,461

Before TREVOR M. JEFFERSON, SCOTT E. KAMHOLZ, and DAVID C. McKONE, *Administrative Patent Judges.*

McKONE, *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, and a true copy of their written settlement agreement (Ex. 1013) made in connection with the termination, in accordance with 35 U.S.C. § 317 and 37 C.F.R. § 42.74(b). Paper 14. The parties also filed a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 15.

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, U.S. Patent No. 8,374,461 ("the '461 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).

On March 5, 2014, the Board issued a decision instituting the instant trial as to the challenged claims of the '461 patent. Paper 9. In that decision, the Board determined that there is a reasonable likelihood that the challenged claims are unpatentable. *Id*. SmartPlates has not yet filed a patent owner response and no oral hearing has been requested or held. The parties have also moved to dismiss related litigation in *Smart Plates, LLC v. Carestream Health, Inc., et al.,* No. 2:13-cv-00540 (E.D. La.).

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), the Board determines that it is appropriate to terminate the involvement of Carestream. Moreover, in view of the early stage of this proceeding, and the concurrent settlement of the district court litigation, the Board determines that it also is

appropriate to terminate the proceeding with respect to SmartPlates. Based on the facts of this case, it is appropriate to enter judgment.[1]

It is

ORDERED that the joint motion to terminate IPR2013-00600 is granted, and this proceeding is hereby terminated as to all parties including petitioner Carestream Health and patent owner SmartPlates; 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.

[1] A judgment means a final written decision by the Board, or a termination of a proceeding. *See* 37 C.F.R. § 42.2.

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