

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CONMED CORPORATION and LINVATEC CORPORATION,
Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC,
Patent Owner.

Case IPR2013-00628
Patent 5,527,343

Before MICHAEL R. ZECHER, BENJAMIN D. M. WOOD, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

DECISION
Termination of Trial
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

On April 18, 2014, the parties filed a joint motion to terminate this proceeding (Paper 12), as well as a joint request (Paper 13) to have their settlement agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed a true copy of their written settlement agreement. Ex. 4001. The parties indicated in their joint motion that termination of this proceeding is appropriate because they have reached an agreement regarding their dispute with respect to U.S. Patent No. 5,527,343 (“the ’343 patent”). Paper 12, 2. The parties indicated that the related district court litigation involving the ’343 patent was dismissed without prejudice. *Id.* The parties identified one other related district court litigation involving the ’343 patent that is still pending. *Id.* at 3.

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.” We instituted a trial in this proceeding as to claims 1 and 4-7 of the ’343 patent (Paper 8) on March 28, 2014, but we have not decided the merits of this proceeding.

Further, under 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.” *See also* 37 C.F.R. §§ 42.72; 42.73(a). As the parties have filed their written settlement agreement, and the related district court litigation was dismissed without prejudice, we determine that it is appropriate to terminate this

proceeding without rendering a final written decision as to the patentability of claims 1 and 4-7 of the '343 patent. *See* 37 C.F.R. §§ 42.72, 42.73, 42.74.

ORDER

Accordingly, it is hereby:

ORDERED that the joint request of the parties that the settlement agreement (Ex. 4001) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

ORDERED that the joint motion of the parties to terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

Case IPR2013-00628

Patent 5,527,343

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