

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OLYMPUS AMERICA INC. and
OLYMPUS MEDICAL SYSTEMS CORPORATION,
Petitioner,

v.

PERFECT SURGICAL TECHNIQUES, INC.,
Patent Owner.

Case IPR2014-00233
Patent 6,030,384

Before FRANCISCO C. PRATS, KEN B. BARRETT, and JAMES B. ARPIN,
Administrative Patent Judges.

ARPIN, *Administrative Patent Judge.*

DECISION
Termination of the Proceeding
37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

On March 29, 2017, the Parties filed a Joint Motion to Terminate this proceeding (Paper 67), a true copy of the Parties' settlement agreement (Ex. 1030), and a Joint Request to File Settlement Agreement as Business Confidential Information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 68).

Petitioner filed a corrected Petition for *inter partes* review on December 20, 2013. Paper 7. The Board issued a Final Written Decision on June 8, 2015. Paper 56. Petitioner appealed the Final Written Decision to the U.S. Court of Appeals for the Federal Circuit ("the Federal Circuit"). See Paper 57. On November 15, 2016, the Federal Circuit issued a Judgment and Opinion vacating the Board's Final Written Decision and remanding the case. See Paper 61. The Federal Circuit issued the Mandate returning jurisdiction to the Board on January 30, 2017. Paper 62.

On February 21, 2017, the Board issued an order requiring the Parties to submit additional briefing in the remand of this proceeding (Paper 64), and on March 6, 2017, in response to the Parties' joint request, the Board authorized the filing of a joint motion to terminate this proceeding and extended the deadlines for responding to the Board's remand briefing order (Paper 66). Consequently, the Board's consideration of the remand of this proceeding is still in its preliminary stages.

In the Joint Motion to Terminate this proceeding, the Parties represent that they have settled all of their disputes regarding the Patent No. US 6,030,384 (Ex. 1011, "the '384 patent"). Paper 67, 2. The Parties further represent that:

After executing the Settlement Agreement, the parties jointly dismissed with prejudice their claims and counterclaims in the district court litigation involving the '384 Patent. See *Perfect Surgical*

Techniques, Inc. v. Olympus America, Inc., No 4:12-cv-05967-PJH (N.D. Cal. Nov. 21, 2012), D.N. 150 and 151.

Thus, there are no other proceedings between the parties – either in district court or in the Patent Office – involving the '384 Patent, and none is contemplated in the foreseeable future.

Id. at 3. Under these circumstances, we determine that it is appropriate to terminate this proceeding without rendering any further decision. *See* 37 C.F.R. § 42.72.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Parties' Joint Request to File Settlement Agreement (Ex. 1030) as Business Confidential Information (Paper 68) under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate (Paper 67) this proceeding is *granted*, and this proceeding is hereby terminated; and

FURTHER ORDERED that, because this proceeding has been terminated, the Order Requiring Additional Briefing on Remand (Paper 64) is *withdrawn*.

IPR2014-00233
Patent 6,030,384

PETITIONER:

Deborah E. Fishman
Katie Scott
Robert E. Bugg
KAYE SCHOLER LLP
DFishmanPTAB@kayescholer.com
KScottPTAB@kayescholer.com
Robert.bugg@kayescholer.com

Steven I. Weisburd
ARENT FOX LLP
steven.weisburd@arentfox.com

Eric Kurtycz
eric.kurtycz@olympus-osta.com

PATENT OWNER:

Jason S. Angell
Robert E. Freitas
Daniel J. Weinberg
FREITAS ANGELL & WEINBERG LLP
jangell@fawlaw.com
rfreitas@fawlaw.com
dweinberg@fawlaw.com