

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALGREEN COMPANY
Petitioner,

v.

ROBERT LORSCH
MYMEDICALRECORDS, INC.
Patent Owner

Case IPR2014-00433
Patent 8,301,466

Before WILLIAM A. CAPP, TRENTON A. WARD and STACEY G. WHITE,
Administrative Patent Judges.

WARD, *Administrative Patent Judge.*

ORDER
Motion to Terminate
37 C.F.R. § 42.72

On March 14, 2014, the parties filed a joint motion to terminate the trial proceedings under 35 U.S.C. § 317(a). Paper 10. Along with the motion, the parties filed a copy of a document they described as the written settlement agreement (Ex. 1027), as well as a separate joint request to treat the settlement agreement as business confidential information under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 11, 1.

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.” The parties stated in their motion that “the parties have settled their dispute, and the civil litigation has been dismissed.” Paper 10, 2. Furthermore, a trial has not been instituted in this proceeding.

The joint motion indicates that, upon stipulation of the parties on March 10, 2014, the following related District Court litigation between the parties was dismissed by order of the Court: *MyMedicalRecords, Inc. v. Walgreen Co*, Case No. CV13-00631 (C.D. Cal, 2013), Dkt. No. 55. Paper 10, 3.

The parties are reminded that the Board is not a party to the settlement, and may independently identify any question of patentability. 37 C.F.R § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). These proceedings are still in the preliminary stages, as the Board has not instituted a trial. The Board is persuaded that, under these circumstances, it is appropriate to terminate this proceeding without rendering a final written decision. 37 C.F.R. § 42.72.

Accordingly, it is:

ORDERED that the joint motion to terminate this proceeding is GRANTED and this proceeding is hereby terminated;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1027) be treated as business confidential information, kept separate from the file of the involved patent, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

PETITIONER:

Ashley L. Kirk
WILLENKEN WILSON LOH & DELGADO LLP
akirk@willenken.com

Wen Liu
LIU & LIU
wliu@liulaw.com

PATENT OWNER:

John D. Goodhue
Jeffrey D. Harty
MCKEE, VOORHEES & SEASE, PLC
John.goodhue@ipmvs.com
Jeff.harty@ipmvs.com