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Paper 20
Date: July 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

W. L. GORE & ASSOCIATES, INC.,
Petitioner,

v.

LIFEPORT SCIENCES LLC,
Patent Owner.

Case IPR2014-01321
Patent 5,716,365

Before JOSIAH C. COCKS, PHILLIP J. KAUFFMAN, and BENJAMIN D. M. WOOD, *Administrative Patent Judges.*

COCKS, *Administrative Patent Judge.*

ORDER
Termination of the Proceeding
37 U.S.C. § 317 and 37 C.F.R. § 42.72

LifePort Sciences, LLC ("Patent Owner") and W.L. Gore & Associates, Inc. ("Petitioner") filed a "Joint Motion to Terminate," (Paper 18) jointly requesting termination of this *inter partes* review proceeding, and a "Joint Request to Keep Separate" (Paper 19) requesting that we treat as confidential the submitted settlement agreement (Ex. 2001).[1]

The parties indicate that they "have agreed to settle their dispute and have reached a written agreement . . . to terminate this IPR." Paper 18, 2. The parties also state the following:

> The petitioner filed its petition on August 18, 2014. The patent owner did not file a preliminary response. The Board instituted trial on February 25, 2015. The patent owner has not yet substantively responded to the petition nor to the Board's decision instituting trial. The Patent-in-Review is expired. Termination of this IPR is appropriate, consistent with the strong public policy reasons to favor settlement between the parties to a proceeding. *See* Patent Trial Practice Guide § II.N.

Id. at 2–3.

The parties are reminded that the Board is not a party to the settlement, and may identify independently 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).

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

[1] The parties were authorized to file the noted documents in e-mail correspondence from Board personnel on July 14, 2015.

merits of the proceeding before the request for termination is filed." The requirement for terminating review with respect to Petitioner is met. Furthermore, under 35 U.S.C. § 317(a), "[i]f no petitioner remains in the *inter partes* review, the Office may terminate the review or proceed to a final written decision under section 318(a)." Petitioner is the sole petitioner in this review. The Board has discretion to terminate this review with respect to Patent Owner.

Pursuant to 35 U.S.C. § 317(b), any agreement or understanding between the Patent Owner and a Petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of the proceeding shall be in writing, and a true copy of such agreement or understanding shall be filed in the Office. Patent Owner and Petitioner state in the Joint Motion that the parties and Patent Owner's parent corporation, Acacia Research Corporation, have agreed to settle their dispute and have reached a written agreement to terminate this proceeding. Paper 19, 2. Also, as noted by the parties, briefing is not yet complete, and we have not decided the merits in this proceeding.

Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Petitioner and Patent Owner without rendering a final written decision.

It is

ORDERED that the "Joint Motion to Terminate" (Paper 18) is *granted* and this proceeding is *terminated*; and

FURTHER ORDERED that, as was requested timely by the parties, the settlement agreement (Ex. 2001) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

For PETITIONER:

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