

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GN RESOUND A/S,
Petitioner,

v.

OTICON A/S,
Patent Owner.

Case IPR2015-00104
Patent 8,300,863 B2

Before MICHELLE R. OSINSKI, NEIL T. POWELL, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

ORDER

Joint Motion to Terminate
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74

On January 8, 2016, the parties filed a Joint Motion to Terminate Proceeding (Paper 21) along with a true copy of a License Agreement¹ (Paper 23) and a Joint Request to File Settlement Agreement as Business Confidential Pursuant to 35 U.S.C. § 317 (Paper 22). The above filings were authorized pursuant to an email sent by the Board on January 7, 2016.

Under 35 U.S.C. § 317(a), applicable to *inter partes* review proceedings, a proceeding shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. This matter is at a stage prior to its final hearing, with no decision on the merits having been made.

Under 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. The Joint Motion to Terminate indicates that the parties request termination of this proceeding pursuant to settlement, and have memorialized the parties' agreement with respect to termination of this proceeding in the License Agreement. Paper 21, 1; Paper 23.

With respect to related matters, the parties have requested dismissal of

¹ The parties refer to a "Settlement Agreement" attached as "Exhibit 1" to the Joint Motion to Terminate. However, the License Agreement is filed as Paper 23 and there is no Exhibit 1 in the record. Accordingly, we treat the parties' reference to the "Settlement Agreement" as citing the License Agreement shown in Paper 23.

a related district court proceeding based on the License Agreement. Paper 21, 2. The parties further represent that claims 6–8 and 14 of the '863 patent are the subject of *ex parte* reexamination 90/013,592. *Id.* The parties indicate that claims 6–8 and 14 are not at issue in the instant proceeding, which involves claims 1, 4, 5, 11, 12, 16–20, and 25. Additionally, we note that claims 9, 10, 15, and 21–24 of the '863 patent were the subject of IPR2015-00103, which is no longer pending following the grant of adverse judgment. IPR2015-00103, Paper 19.

Under these circumstances, we determine that it is appropriate to grant the Joint Motion to Terminate the trial without rendering a final written decision pursuant to 35 U.S.C. § 318(a). *See* 37 C.F.R. §§ 42.5(a), 42.72.

Accordingly, it is

ORDERED that the Joint Motion to Terminate Proceeding is *granted*;

FURTHER ORDERED that the License Agreement, Paper 23, be treated as business confidential information, be designated “Board Only,” and be kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the proceeding is terminated.

PETITIONER:

Scott A. McKeown

Greg Gardella

OBLON, MCCLELLAND, MAIER, & NEUSTADT LLP

cpdocketMcKeown@oblon.com

cpdocketGardella@oblon.com

IPR2015-00104
Patent 8,300,863 B2

PATENT OWNER:

D. Richard Anderson
George S. Dolina
BIRCH, STEWART, KOLASCH & BIRCH, LLP
dra@bskb.com
gsd@bskb.com