

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, Inc.,
Petitioner,

v.

UAB RESEARCH FOUNDATION,
Patent Owner.

Cases IPR2015-01199 and IPR2015-01200
Patent 6,290,699 B1

Before PHILLIP J. KAUFFMAN, BENJAMIN D.M. WOOD, and
RICHARD E. RICE, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

TERMINATION
Dismissal of the Petition
37 C.F.R. §§ 42.5(a), 42.71(a)

The parties request that the above-captioned proceedings be terminated pursuant to a settlement and that the settlement agreement be treated as business confidential information under 37 C.F.R. § 42.74(c). Papers 5, 6; Ex. 1017 (true and unredacted copy of the settlement agreement).¹ The parties indicate that the underlying case in the Northern District of Alabama (*The Board of Trustees of the University of Alabama v. Medtronic, Inc.*, No. 2:2014-cv-01799) was settled and dismissed. Paper 5, 1.

The motions do not state explicitly why termination is appropriate, but such is fairly implied from the statement that the underlying district court litigation was settled and dismissed. It appears that Petitioner is the sole defendant in the district court litigation so that all defendants have been identified. The motions do not identify any related proceedings before the office and it appears there are none. The settlement agreement appears to be the entire agreement between the parties. *See* Ex. 1017 ¶ 8.9. The parties' joint motions to terminate were filed at a preliminary stage of these proceedings, and the Board has not yet determined whether to institute an *inter partes* review.

Under these circumstances, we determine that it is appropriate to dismiss the Petitions. *See* 37 C.F.R. §§ 42.5(a), 42.71(a). This paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

In consideration of the foregoing, it is hereby:

ORDERED that the parties' joint request that the settlement agreement be treated as business confidential information, kept separate from the files of U.S. Patent No. 6,290,699 B1 and made available only to

¹ The paper and exhibit numbers are the same in each case.

IPR2015-01199 (Patent 6,290,699 B1)

IPR2015-01200 (Patent 6,290,699 B1)

Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the joint motions to terminate the instant proceeding are *granted*; and

FURTHER ORDERED that the Petitions for *Inter Partes* Review of the above-referenced patent are *dismissed*.

PETITIONER:

John Josef Molenda
Jeffrey C. Lee
STEPTOE & JOHNSON, LLP
jmolenda@steptoe.com
699IPR@steptoe.com

PATENT OWNER:

Lance Lawson
Peter Siddoway
MYERS BIGEL SIBLEY & SAJOVEC, P.A.
psiddoway@myersbigel.com
llawson@myersbigel.com