

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MASIMO CORPORATION,
Petitioner,

v.

MINDARY DS USA, INC.,
Patent Owner.

Case IPR2015-01240
Patent 5,987,343

Before MICHAEL W. KIM, MITCHELL G. WEATHERLY, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

KIM, *Administrative Patent Judge*.

JUDGMENT
Termination of Proceeding
37 C.F.R. 42.72

On November 17, 2015, Petitioner and Patent Owner filed a Joint Motion to Terminate Proceedings (Paper 9; “Mot.”) under 35 U.S.C. § 317(a), and a Joint Request to File Settlement Agreement as Business Confidential (Paper 10) in order to have the settlement agreement kept separate from the files of the involved patent under 37 C.F.R. § 317(b) and 37 C.F.R. § 42.74(c). The settlement agreement was filed as confidential Exhibit 1014.

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.”

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement, if the settlement agreement includes all parties. *See, e.g.*, Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). The parties have filed such an agreement. Ex. 1014.

In their Motion, the parties indicate that they have settled their dispute with regard to U.S. Patent No. 5,987,343, that all other related litigation involving U.S. Patent No. 5,987,343 between the parties will be terminated, and that U.S. Patent No. 5,987,343 has been assigned to Petitioner. Mot. 1. Petitioner represents that it will no longer participate substantively in this proceeding, even if the Board does not terminate this proceeding. *Id.*

The trial phase of this proceeding is in its early stages, as Patent Owner has not yet filed a Patent Owner Response and Petitioner has not yet filed a Reply. Under these circumstances, we are persuaded that it is

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appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner.

Accordingly, it is

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

FURTHER ORDERED that this proceeding is terminated with respect to both Petitioner and Patent Owner; and

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential is *granted*, and Exhibit 1014 will be kept as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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For PETITIONER:

Irfan Lateef
2IAL@knobbe.com

Brent Babcock
2BRB@knobbe.com

Jarom Kesler
2JZK@knobbe.com

For PATENT OWNER:

Chun Ng
MindrayMasimoIPR@perkinscoie.com

Rodney Tullett
RTullett@perkinscoie.com