

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC PLC,
Petitioner,

v.

MASIMO CORP.,
Patent Owner.

Case IPR2016-00056
Patent 7,496,393 B2

Before KEN B. BARRETT, BENJAMIN D. M. WOOD, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

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

I. INTRODUCTION

On September 21, 2016, the parties filed a Second Joint Motion to Terminate Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 (Paper 20, “Motion”), along with a true copy of a Settlement Agreement, Amendment to Settlement Agreement, Second Amendment to Settlement Agreement (collectively, the “Previous Agreements,” Ex. 2035), and a Third Amendment to Settlement Agreement (Ex. 2036).¹ The parties also jointly request that the Previous Agreements be treated as business confidential information. For the reasons set forth below, the Motion is granted and the request to treat the Previous Agreements as business confidential information is granted.

II. DISCUSSION

Under 35 U.S.C. § 317(a), an *inter partes* review proceeding shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Patent and Trademark Office has decided the merits of the proceeding before the request for termination is filed. This proceeding is in a relatively early stage and the merits have not yet been decided. 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.

¹ The Board authorized this filing via order dated September 20, 2016 (Paper 19), in which the Board denied, without prejudice, the parties First Joint Motion to Terminate for failure to comply with 35 U.S.C. § 317(b).

Under 35 U.S.C. § 317(b), any agreement or understanding between a 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 parties state that they have settled their dispute and have reached a written agreement to terminate this proceeding. Paper 20, 1. In support of the Motion, the parties submitted a true copy of their written agreement (the Previous Agreements, Ex. 2035; and the Third Amendment, Ex. 2036).

Upon consideration of the facts in the proceeding before us, we grant the Motion and terminate this proceeding as to both Petitioner and Patent Owner without rendering a final written decision. 37 C.F.R. § 42.74. We also grant the joint request to maintain the Previous Agreements as business confidential information in accordance with 37 C.F.R. § 42.74(c).

III. ORDER

For the reasons given, it is

ORDERED that the second joint motion to terminate this proceeding is *granted*, and this proceeding is, hereby, *terminated*, and

FURTHER ORDERED that the parties' joint request that the Previous Agreements (Ex. 2035) be treated as business confidential information and kept separate from the file of the involved patent under 35 U.S.C. § 317(b) and 37 C.F.R. 42.74(c) is *granted*.

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