Trials@uspto.gov
Tel: 571-272-7822

Paper No. 8
Entered: April 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEPUY SYNTHES SALES, INC. and
DEPUY SYNTHES PRODUCTS, INC.,
Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC,
Patent Owner.

IPR2016-00403 (Patent 6,099,531)
IPR2016-00405 (Patent 6,423,063 B1)
IPR2016-00406 (Patent 7,001,385 B2)
IPR2016-00411 (Patent 8,486,066 B2)
IPR2016-00412 (Patent 8,795,363 B2)

Before MEREDITH C. PETRAVICK, ERICA A. FRANKLIN, and BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Terminate
35 U.S.C. § 317 and 37 C.F.R § 42.73

Pursuant to authorization by the Board via email sent March 30, 2016, Depuy Synthes Sales, Inc. and Depuy Synthes Products, Inc. (collectively, "Petitioner") and Bonutti Skeletal Innovations LLC ("Patent Owner") filed joint motions to terminate these proceedings (Paper 8[1], "Mot.") and joint requests that the settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) (Paper 9).

Under 35 U.S.C. § 317(a), an *inter partes* review proceeding shall be terminated with respect to any petitioner upon the 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. The present proceedings are in an early stage. Decisions on institution have not yet been entered in any of the proceedings. The merits have not been decided, and these proceedings are eligible for termination. *See* Mot. 2.

Under 35 U.S.C. § 317(b), any agreement or understanding between Patent Owner and 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 that they have settled their dispute and have reached an agreement to terminate these proceedings. Mot. 1. In support of their joint motions, the

[1] For the purposes of this Order, IPR2016-00403 is representative and all citations are to papers in IPR2016-00403 unless otherwise noted.

parties filed Exhibit 2001, in each proceeding, as a true copy of their written agreement. *Id.* at 1–2.

Upon consideration of the facts in the case before us, we grant the joint motions and terminate these proceedings as to both Petitioner and Patent Owner without rendering final written decisions. 37 C.F.R. § 42.72. We also grant the joint requests to maintain the settlement agreement as business confidential in accordance with 37 C.F.R. § 42.74(c).

It is:

ORDERED that the parties' joint requests that the settlement agreements be treated as business confidential information, to be kept separate from the patent file are *granted*; and

FURTHER ORDERED that the joint motions to terminate the proceedings are *granted*.

IPR2016-00403 (Patent 6,099,531)
IPR2016-00405 (Patent 6,423,063 B1)
IPR2016-00406 (Patent 7,001,385 B2)
IPR2016-00411 (Patent 8,486,066 B2)
IPR2016-00412 (Patent 8,795,363 B2)

PETITIONER:

Jeremy Lowe
Matthew J. Becker
David K. Ludwig
Dan Feng Mei
AXINN, VELTROP & HARKRIDER LLP
jlowe@axinn.com
dmei@axinn.com
mbecker@axinn.com
dludwig@axinn.com

PATENT OWNER:

Kevin K. McNish
Andrew G. Heinz
Tamir Packin
DESMARAIS LLP
BSIIPRService@desmaraisllp.com
kmcnish@desmaraisllp.com
aheinz@desmaraisllp.com
tpackin@desmaraisllp.com