Trials@uspto.gov
571-272-7822

Paper 19
Date: May 11, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC XOMED, INC.,
Petitioner,

v.

NEUROVISION MEDICAL PRODUCTS, INC.,
Patent Owner.

Case IPR2016-01847
Patent 8,467,844 B2

Before MEREDITH C. PETRAVICK, MITCHELL G. WEATHERLY, and MICHAEL L. WOODS, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

JUDGMENT
Termination Due to Settlement after Institution of *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.74

I. Introduction

We instituted trial on March 23, 2016. Paper 14. On May 8, 2017, Petitioner, Medtronic Xomed, Inc. ("Medtronic"), and Patent Owner, Neurovision Medical Products, Inc. ("Neurovision"), (collectively referred to as "the parties"), filed a Joint Motion to Terminate *Inter Partes* Review under 35 U.S.C. § 317(a). Paper 17 ("Joint Motion to Terminate").[1] Along with the Joint Motion to Terminate, the parties filed a true copy of a Settlement and License Agreement (Ex. 2026, "Settlement Agreement"), as well as a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 18 ("Joint Request to Keep Separate")).

II. Discussion

The parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g.*, *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

In the Joint Motion to Terminate, the parties represent that they have settled their dispute and have reached an agreement that resolves the dispute in this *inter partes* review and all disputes between the parties relating to the '844 patent. Paper 17, 2.

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

[1] Filing of the Joint Motion to Terminate was authorized in e-mail correspondence from Board personnel on May 8, 2017.

request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed."

At this stage of the proceeding, Neurovision has not filed a Patent Owner's Response, and such a response is not due until June 21, 2017. Paper 16, 6. The panel has not decided the merits of the challenges presented in the Petition. Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Medtronic and Neurovision without rendering a final written decision.

III. Orders

It is

ORDERED that the Joint Motion to Terminate (Paper 17) is *granted,* and this proceeding is hereby *terminated*; and

FURTHER ORDERED that the Joint Request to Keep Separate (Paper 18) is also *granted*, and the Settlement Agreement (Ex. 2026) will be treated as business confidential information and kept separate from the files of the '844 patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

For PETITIONER:

Justin J. Oliver
Jason Dorsky
FITZPATRICK, CELLA, HARPER & SCINTO
joliver@fchs.com
Medtronic894IPR@fchs.com

For PATENT OWNER:

Neil A. Rubin
Kent Shum
C. Jay Chung
RUSS AUGUST & KABAT
nrubin@raklaw.com
kshum@raklaw.com
jchung@raklaw.com