

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FISHER & PAYKEL HEALTHCARE LIMITED,
Petitioner,

v.

RESMED LIMITED,
Patent Owner.

Cases¹

IPR2017-00061 (Patent 9,119,931 B2)

IPR2017-00062 (Patent 9,119,931 B2)

Before BARRY L. GROSSMAN, BEVERLY M. BUNTING, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order addresses issues that are the same in each case. Therefore, we exercise our discretion to issue one paper to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

Petitioner and Patent Owner (collectively referred to as “the Parties”) have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On September 13, 2019, we granted authorization, via email, for the Parties to file the present joint motions to terminate these proceedings pursuant to a settlement agreement under 37 C.F.R. § 42.74. On September 16, 2019, the Parties filed a Joint Motion to Terminate each of these proceedings pursuant to a settlement agreement. Paper 51 (“Joint Motion”).² The parties also filed a true copy of their written settlement agreement (Ex. 1033), made in connection with the termination of these proceedings, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72. Additionally, the parties submitted a joint request to have their written settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 52.

The Parties submit that termination is appropriate because the Parties have settled their dispute and have reached agreement to terminate these proceedings. Paper 51, 1. The Parties represent that this settlement agreement ends all disputes as to this patent, and that “[t]here are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this IPR.” *Id.*

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. 48756, 48768 (Aug. 14, 2012).

² Paper and exhibit numbers refer to IPR2017-00061.

IPR2017-00061 (Patent 9,119,931 B2)

IPR2017-00062 (Patent 9,119,931 B2)

We note that the Board has issued a final written decision in each of these proceedings addressing the instituted claims. Paper 33. Subsequently, Petitioner filed a request for rehearing of the non-instituted claims (Paper 35) in view of *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018), which the Board granted (Paper 37). Supplemental oral argument was heard on September 27, 2018. Paper 49. We have not yet issued a supplemental final written decision.

Under the circumstances, based on the record before us, we determine that it is appropriate to terminate these proceedings with respect to both parties. At this juncture, termination is suitable because it promotes efficiency and minimizes unnecessary costs. As such, based on the facts, it is appropriate to terminate these proceedings without rendering a supplemental final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

In consideration of the foregoing, it is

ORDERED that the Parties' joint request that the settlement agreement (Exhibit 1033) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to be kept separate from the patent file in these proceedings, is GRANTED;

FURTHER ORDERED that the joint motions to terminate IPR2017-00061 and IPR2017-00062 are GRANTED; and

FURTHER ORDERED that both of these proceedings are TERMINATED.

IPR2017-00061 (Patent 9,119,931 B2)

IPR2017-00062 (Patent 9,119,931 B2)

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