

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

McKESSON CORPORATION, McKESSON TECHNOLOGIES, INC.,
InTOUCH TECHNOLOGIES, INC., and MEDICAL DEPOT, INC.,
Petitioner,

v.

MY HEALTH, INC.,
Patent Owner.

Case IPR2017-00312
Patent 6,612,985 B2

Before BRIAN J. McNAMARA, JAMES A. TARTAL, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION

Granting Joint Motion to Terminate
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

Petitioner, McKesson Corporation, McKesson Technologies Inc., InTouch Technologies, Inc., and Medical Depot, Inc., and Patent Owner, My Health, Inc., jointly move to terminate this proceeding. (Paper 7, “Motion” or “Mot.”). The Motion sets forth the following chronology:

1. On November 29, 2016, Petitioners filed a petition for *inter partes* review of the ’985 Patent. Paper No. 2.

2. On March 27, 2017, the District Court in a related proceeding between the parties invalidated all claims of the ’985 Patent as directed to ineligible subject matter under 35 U.S.C. § 101. Exh. 1014.

3. On April 25, 2017, Patent Owner filed a notice in the District Court to appeal the District Court’s § 101 ruling to the Court of Appeals for the Federal Circuit.

4. On June 9, 2017, the Board instituted *inter partes* review of the ’985 Patent. Paper No. 5.

5. On July 3, 2017, the Federal Circuit dismissed Patent Owner’s appeal. Exh. 1015.

6. Patent Owner did not file a response to the petition for *inter partes* review, which response had a deadline of September 8, 2017 (Paper No. 6).

7. On January 3, 2018, the Board authorized [a] motion to terminate the instant IPR proceeding.

Mot. 1–2.

As noted in the Motion, a joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office, and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” Mot. 2 (quoting

Heartland Tanning, Inc. v. Sunless, Inc., IPR2014-00018, Paper 26 at 2 (PTAB Jul. 28, 2014).

The Parties contend termination is appropriate because “there are currently no existing claims to cancel in the IPR” in light of the “District Court order invalidating all claims of the ’985 Patent and the Federal Circuit’s subsequent dismissal of Patent Owner’s appeal of the District Court order.” Mot. 2. Further, there is no related court proceeding or Office proceeding involving the patent at issue that would be affected by the termination of this case. *Id.* at 3. Accordingly, we agree that under the circumstances presented, termination of this case is appropriate.

ORDER

For the foregoing reasons, it is hereby:

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

FURTHER ORDERED that *inter partes* review in IPR2017-00312 is terminated as to all parties.

IPR2017-00312
Patent 6,612,985 B2

PETITIONER

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