

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMMER BIOMET HOLDINGS, INC.,
Petitioner,

v.

FOUR MILE BAY, LLC,
Patent Owner.

Case IPR2018-00052
Patent 9,308,093 B2

Before JOSIAH C. COCKS, GEORGE R. HOSKINS, and FRANCES L.
IPPOLITO, *Administrative Patent Judges*.

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DECISION

Joint Motion to Terminate
35 U.S.C. § 317 and 37 C.F.R. § 42.74(c)

In an email dated June 29, 2018, we authorized the parties to file a joint motion to terminate the instant proceeding with a true copy of their agreement(s) in contemplation of termination and a request to treat the filed copy of their agreement(s) as business confidential information under 37 C.F.R. § 42.74(c). On July 5, 2018, the parties filed a joint motion (Paper 11) to terminate the instant proceeding on the basis of a settlement reached by the parties. *See* 35 U.S.C. § 317(a). The parties also filed a copy of their written settlement agreement (Exhibit 1025) and requested that the settlement agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 12.

The parties indicate that they have settled their underlying disputes and have executed a settlement agreement to terminate the present proceeding, as well as the district court litigation involving the '093 patent: *Four Mile Bay LLC v. Zimmer Holdings, Inc. et al.*, Civil Action No. 3:15-CV-00063 (PPS)-(MGG) (N.D. Ind.). Mot. 1–2. The parties further indicate that they filed a stipulation of dismissal in the above-referenced district court action on June 28, 2018 and that the district court granted the stipulation of dismissal on July 2, 2018. *Id.* at 2.

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See* 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint 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.”); 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including

... pursuant to a joint request under 35 U.S.C. 317(a)"); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) ("The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding."). Here, the proceeding is at a relatively early stage and a final written decision has not been entered. Accordingly, we are persuaded that, under these circumstances, termination of this proceeding is appropriate.

Additionally, as was requested timely by the parties (Paper 12), the settlement agreement (Ex. 1025) will be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Decision does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

In consideration of the foregoing, it is hereby:

ORDERED that the settlement agreement (Exhibit 1025) be treated as business confidential information, kept separate from the file of U.S. Patent No. 9,308,093 B2, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the joint motion to terminate the proceeding is *granted* and this proceeding is hereby *terminated*.

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