

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

NIAZI LICENSING CORPORATION,
Patent Owner.

Case IPR2018-00609 (Patent 6,638,268 B2)
Case IPR2018-00610 (Patent 6,638,268 B2)

Before JAMES A. TARTAL, GEORGE R. HOSKINS, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

DECISION

Joint Motion to Terminate
35 U.S.C. § 317 and 37 C.F.R. §§ 42.72 & 42.74

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IPR2018-00610 (Patent 6,638,268 B2)

In an email dated January 18, 2019, we authorized the parties to file a joint motion to terminate in each of these two proceedings, 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. On January 28, 2019, the parties filed joint motions ('609 Paper 19 ("Mot."), '610 Paper 19) to terminate these two instant proceedings on the basis of a settlement reached by the parties. See 35 U.S.C. § 317(a); 37 C.F.R. § 42.72. The parties also filed a copy of their written settlement agreement ('609 Exhibit 2075, '610 Exhibit 2075), 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). '609 Paper 18, '610 Paper 18.

The parties indicate they have entered a settlement agreement, pursuant to which they agreed to seek dismissal of these two proceedings, and to dismiss the district court litigation involving the '268 patent: *Niazi Licensing Corporation v. Medtronic*, Case No. 17-cv-5095 (D. Minn.). Mot. 1.

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

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the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”). Here, the two proceedings are at a mid-point stage, and a final decision has not been reached or entered. Accordingly, we are persuaded that, under these circumstances, termination of these two proceedings is appropriate.

Additionally, as was requested timely by the parties, the Agreement (’609 Exhibit 2075, ’610 Exhibit 2075) 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 Agreement (’609 Exhibit 2075, ’610 Exhibit 2075) be treated as business confidential information, kept separate from the file of U.S. Patent No. 6,638,268 B2, and be 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 motions to terminate these two proceedings are *granted*, and the proceedings are hereby *terminated*.

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