

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT LABORATORIES and ABBOTT CARDIOVASCULAR
SYSTEMS INC.,
Petitioner,

v.

CARDINAL HEALTH 529, LLC,
Patent Owner.

IPR2019-00098
Patent 6,699,278 B2

Before MICHAEL L. WOODS and ERIC C. JESCHKE,
Administrative Patent Judges.

WOODS, *Administrative Patent Judge.*

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

I. INTRODUCTION

The parties filed a joint motion to terminate this *inter partes* review under 35 U.S.C. § 317. Paper 29 (“Motion” or “Mot.”).

In support of their Motion, the parties represent that they settled their dispute and executed a settlement agreement, a copy of which was filed as an exhibit. Mot. 1–2 (filing Ex. 1061 as the parties’ settlement agreement (“Agreement”)).

In another paper, the parties jointly filed a motion requesting that the Agreement be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 30 (“Joint Request”).

For the reasons discussed below, the Motion and Joint Request are *granted*.

II. ANALYSIS

Generally, the Board expects that a proceeding will terminate after the filing of a settlement agreement. See Patent Trial and Appeal Board Consolidated Trial Practice Guide 86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>. The Leahy–Smith America Invents Act further provides:

(a) *In general*.—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*. If the inter partes review is terminated with respect to a petitioner under this section, no estoppel under section 315(e) shall attach to the petitioner, or to the real party in interest or privy of the petitioner, on the basis of that petitioner’s institution of that inter partes review.

35 U.S.C. § 317(a) (second emphasis added).

We find that the parties settled their dispute, as set out in the parties' executed Agreement. Ex. 1061. We further find that the Agreement contains information that is reasonably understood to be confidential. We also note that we have not yet held an oral hearing, we have not yet entered a final written decision, and we have not yet decided the merits of the proceeding.

Upon review of the procedural posture and the facts before us, we determine that it is appropriate to terminate this proceeding and grant the parties' Motion and Joint Request.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the joint motion to terminate this *inter partes* review (Paper 29) is *granted*;

FURTHER ORDERED that this proceeding is *terminated* as to all parties; and

FURTHER ORDERED that the joint request (Paper 30) to treat the settlement agreement (Ex. 1061) as business confidential information is also *granted*.

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