

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED LIMITED, RESMED INC. AND RESMED CORP.,
Petitioner,

v.

FISHER & PAYKEL HEALTHCARE LIMITED,
Patent Owner.

Case IPR2019-00180
Patent 9,517,317 B2

Before THOMAS L. GIANNETTI, JAMES J. MAYBERRY,
AMANDA F. WIEKER, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

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

I. INTRODUCTION

Per our authorization provided on September 9, 2019, the parties filed a Joint Motion to Terminate the above-identified *inter parties* review proceeding (Paper 14, “Joint Motion to Terminate”) and a Joint Request to File Settlement Agreement as Business Confidential Information (Paper 15, “Joint Request”). Pursuant to 37 C.F.R. § 42.74(b), the parties also filed a true copy of their written settlement agreement. See Paper 14, 1 (“A true copy of the settlement agreement is being submitted herewith as Exhibit FPH2006.”); Ex. 2006.

II. DISCUSSION

In the Joint Motion to Terminate, the parties represent that they “have settled their dispute and have reached agreement to terminate this IPR.” Paper 14, 1. The parties state that “termination of the IPR is appropriate under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(a).” *Id.* at 2. The parties represent that there are no related proceedings currently pending before the Patent Office (*id.* at 1) and no pending litigation involving the patent at issue in this proceeding (*id.* at 1). The parties also state that “[t]here are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this IPR.” *Id.* at 1.

We instituted a trial on the above-identified proceeding on July 16, 2019. Paper 12. We have not yet decided the merits of the proceeding, and a final written decision has not been entered. Notwithstanding that the proceeding has moved beyond the preliminary stage, we determine that good cause exists to terminate this proceeding with respect to the parties. 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 patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”).

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

III. ORDER

Accordingly, it is:

ORDERED that, as was timely requested by the parties, the settlement agreement, Exhibit 2006, shall be treated as business confidential information and kept separate from the file of U.S. Patent 9,517,317 B2 pursuant to 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted*, and the proceeding is hereby *terminated*.

Case IPR2019-00180

Patent 9,517,317 B2

PETITIONER:

Edward H. Sikorski

Tiffany C. Miller

James Heintz

DLA PIPER LLP (US)

Ed.Sikorski@dlapiper.com

Tiffany.Miller@dlapiper.com

Jim.Heintz@dlapiper.com

PATENT OWNER:

Jon W. Gurka

Douglas G. Muehlhauser

Benjamin J. Everton

KNOBBE, MARTENS, OLSON & BEAR, LLP

BoxFPH892-6@knobbe.com

2jwg@knobbe.com

2dgm@knobbe.com

2bje@knobbe.com