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Paper 21
Entered: February 4, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

IPR2019-00914 (Patent 9,861,286 B1)
IPR2019-00917 (Patent 9,757,040 B2)[1]

Before GRACE KARAFFA OBERMANN, JOHN F. HORVATH, and SHARON FENICK, *Administrative Patent Judges.*

FENICK, *Administrative Patent Judge*.

ORDER
Granting Joint Motion to Terminate
Granting Joint Request to Keep Confidential and Separate
35 U.S.C. § 317; 37 C.F.R. §§ 42.71, 42.74

[1] This order is to be filed in each proceeding. The parties are not authorized to use this style heading in any subsequent papers.

I. INTRODUCTION

Petitioner and Patent Owner (collectively referred to as "the Parties") have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On January 22, 2020, we authorized the Parties to file a joint motion to terminate in each proceeding. On January 27, 2020, the Parties filed, in each proceeding, a Joint Motion to Terminate (collectively, "Joint Motions"). IPR2019-00914, Paper 19; IPR2019-00917, Paper 20. The Parties filed, in each proceeding, a copy of their Confidential Settlement Agreement ("Settlement Agreements"). IPR2019-00914, Ex. 1060; IPR2019-00917, Ex. 1060. The Parties also filed, in each proceeding, a Joint Request to Keep Separate, requesting the Settlement Agreements be filed as business confidential information and be kept separate from the file of the involved patent pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (collectively, "Joint Requests"). IPR2019-00914, Paper 20; IPR2019-00917, Paper 21.

II. DISCUSSION

In the Joint Motions, the Parties represent that they have reached an agreement regarding U.S. Patent Nos. 9,757,040 B2 and 9,861,286 B1, that they jointly seek termination of the above-identified *inter partes* review proceedings, that the filed Settlement Agreements are true and accurate copies, and that there are no collateral agreements made in connection with the termination of the proceedings. IPR2019-00914, Paper 19, 1, 3–4; IPR2019-00917, Paper 20, 1, 3–4.

We have instituted a trial in each proceeding (IPR2019-00914, Paper 13; IPR2019-00917, Paper 14), but, as the Parties indicate, no patent owner response has been filed in either proceeding. The panel has not decided the

merits of the challenges presented in each of the proceedings. In view of the stage of these proceedings and the settlement between the Parties, we determine that good cause exists to terminate each of the *inter partes* review proceedings.

In the Joint Requests the Parties ask that the Settlement Agreements be treated as business confidential information and be kept separate from the files of the patents involved in these *inter partes* review proceedings. IPR2019-00914, Paper 20, 1; IPR2019-00917, Paper 21, 1. After reviewing the Settlement Agreements between Petitioner and Patent Owner, we find that the Settlement Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreements between Petitioner and Patent Owner as business confidential information pursuant to 37 C.F.R. § 42.74(c).

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

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that, in each of IPR2019-00914 and IPR2019-00917, the Joint Motion to Terminate is *granted*, and each proceeding is hereby *terminated*; and

FURTHER ORDERED that the parties' Joint Requests to keep confidential and separate are *granted*, and the Settlement Agreements shall be kept separate from the files of U.S. Patent Nos. 9,757,040 B2 and 9,861,286 B1, and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 37 C.F.R. § 42.74(c).

IPR2019-00914 (Patent 9,861,286 B1)
IPR2019-00917 (Patent 9,757,040 B2)

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