

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LEVITA MAGNETICS INTERNATIONAL CORP.,
Petitioner,

v.

ATTRACTIVE SURGICAL, LLC,
Patent Owner.

IPR2019-01294 (9,386,973 B2)
IPR2019-01295 (8,602,981 B2)

Before GRACE KARAFFA OBERMANN, SHERIDAN K. SNEDDEN,
and AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

TERMINATION

Due to Settlement After Institution of Trial
Granting Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74(c)

IPR2019-01294 (9,386,973 B2)

IPR2019-01295 (8,602,981 B2)

On October 20, 2020, with our prior authorization, Levita Magnetics International Corp. (“Petitioner”) and Attractive Surgical, LLC (“Patent Owner”) (collectively, “the Parties”) filed a Joint Motion to Terminate the *inter partes* review in both in IPR2019-001294 and IPR2019-001295.

Paper 27 (“Motion”).¹ Together with the Motion, the parties filed a copy of their written Settlement, Release, and Assignment Agreement (Ex. 1027, “Settlement Agreement”), and a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 28 (“Joint Request”).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Consolidated Trial Practice Guide*, 86 (Nov. 2019) (“Consolidated TPG”)²; *see* 35 U.S.C. §317(a) and 37 C.F.R. § 42.72. Petitioner filed two petitions for *inter partes* review, i.e., IPR2019-001294 and IPR2019-001295, challenging U.S. Patent Nos. 9,386,973 and 8,602,981 respectively (collectively “the challenged patents”). On January 21, 2020, we instituted *inter partes* review of both cases. The oral hearing is scheduled for November 17, 2020.

The Parties explain that “[t]ermination of this proceeding is proper because briefing is not yet complete and oral argument has not taken place, thus the Board has not yet ‘decided the merits of the proceeding before the

¹ Citations in this Order are to papers filed in IPR2019-001294. Similar papers were filed IPR2019-001295. *See, e.g.*, IPR2019-001295, Paper 26 (Motion to Terminate), Paper 27 (Joint Request to File Settlement Agreement as Business Confidential Information), Ex. 1027 (Settlement Agreement).

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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request for termination is filed.” Motion 1 (citing 35 U.S.C. § 317(a); Consolidated TPG at 86). The parties indicate that the agreement reached resolves all disputes regarding the challenged patents, including the *inter partes* review in IPR2019-001294 and IPR2019-001295 as well as the related district court litigations in both Ohio and California, which have been dismissed with prejudice. *Id.* at 2; Ex. 1027, 4.

Under these circumstances, we determine that it is appropriate to enter judgment and terminate this proceeding without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.72. After reviewing the Agreement, we further find that it contains confidential business information regarding the terms of the settlement and that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). This Paper does not constitute a Final Written Decision under 35 U.S.C. § 318(a).

ORDER

In view of the foregoing, it is

ORDERED that the Joint Request to File Settlement as Business Confidential Information (Paper 28) is *granted*; and

FURTHER ORDERED that the Settlement Agreement (Ex. 1027) shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that the parties’ Joint Motion to Terminate the *inter partes* review (Paper 27) is *granted* and this proceeding is hereby terminated.

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