

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STERIS CORPORATION,
Petitioner,

v.

KARL STORZ ENDOSCOPY-AMERICA, INC.,
Patent Owner.

IPR2019-01386
Patent 8,069,420 B2

Before BRYAN F. MOORE, BARRY L. GROSSMAN, and
NABEEL U. KHAN, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Settlement Prior to Institution of Trial
37 C.F.R. § 42.74

On December 9, 2019, with Board authorization via e-mail the same day, the parties filed a Joint Motion to Terminate this proceeding. Paper 6 (“Mot.”). Along with the Joint Motion, the parties filed a copy of a document they describe as “a true copy” (*id.* at 1) of their written settlement agreement (Ex. 1043) covering various matters, including those involving the patent at issue in this proceeding. The parties also filed a Joint Request to Treat the Settlement Agreement as Business Confidential Information under 37 C.F.R. § 42.74(c). Paper 7.

This proceeding is still in its preliminary stages. Petitioner filed a Petition requesting an *inter partes* review of claims 3 and 81 of U.S. Patent No. 8,069,420 B2 (Ex. 1001, “the ’420 patent”). Paper 2, 1. We have not entered a decision on whether to institute an *inter partes* review.

In their Joint Motion, the parties represent that the settlement agreement completely resolves the underlying disputes between the parties involving the ’420 patent at issue in this proceeding. Mot. 1–2. The parties indicate that the settlement encompasses this proceeding and the co-pending district court case where Patent Owner asserted the ’420 patent against Petitioner. *Id.* The parties also state that the settlement agreement filed as Exhibit 1043 represents all agreements made in connection with, or in contemplation of, the termination of this proceeding. Mot. 1; Ex. 1043, § 8.9.

Under these particular circumstances, we determine that it is appropriate to dismiss the Petition without rendering any further decisions, thereby terminating this proceeding. *See* 37 C.F.R. § 42.71(a). We also have reviewed the settlement agreement, and we determine that the settlement agreement contains business confidential information regarding

the terms of the settlement and that good cause exists to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c).

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

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the parties' Joint Request (Paper 7) to treat the settlement agreement (Exhibit 1043) as business confidential information under 37 C.F.R. § 42.74(c) is *granted*; and

FURTHER ORDERED that the parties' Joint Motion to Terminate (Paper 6) is *granted*, and the Petition is dismissed resulting in termination of this proceeding.

IPR2019-01386
Patent 8,069,420 B2

PETITIONER:

Steven Auvil
steven.auvil@squirepb.com

Tamara Fraizer
tamara.fraizer@squirepb.com

Bryan Jaketic
bryan.jaketic@squirepb.com

PATENT OWNER:

William Meunier
wameunier@mintz.com

Michael Renaud
mtrenaud@mintz.com

Peter Corless
pcorless@mintz.com

Carolina Save
csave@mintz.com

Kevin Amendt
kcamendt@mintz.com