

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTUITIVE SURGICAL, INC.,
Petitioner,

v.

REX MEDICAL, L.P.,
Patent Owner.

IPR2020-00375
Patent 10,136,892 B2

Before GEORGE R. HOSKINS, MICHAEL L. WOODS, and
JOHN E. SCHNEIDER, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

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

I. INTRODUCTION

On January 3, 2020, Intuitive Surgical, Inc., filed a petition seeking *inter partes* review of claims 1–15 of U.S. Patent No. 10,136,892 B2 (the “’892 patent”). Paper 2. Rex Medical, L.P. filed mandatory notices pursuant to 37 C.F.R. § 42.8 identifying itself as the patent owner of the ’892 patent. Paper 4, 1.

In an e-mail dated April 10, 2020, the parties represented that they settled their dispute and sought permission to file a motion dismissing the proceeding.

On April 13, 2020, we e-mailed the parties authorizing them to file such a motion.

On April 14, 2020, the parties filed a Joint Motion to Dismiss Proceeding (Paper 6, the “Joint Motion”), a copy of their written settlement agreement (Exhibit 1018, the “Settlement Agreement”), and a Joint Request to Keep Agreement Confidential and Separate Under 37 C.F.R. § 42.74(c) (Paper 7, the “Joint Request”).

II. ANALYSIS

There are strong public policy reasons to favor settlement between the parties to a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). When, as here, we have not yet instituted trial, we generally expect that the proceeding will terminate after the filing of a settlement agreement. *See id.*

In the Joint Motion, the parties represent that they have settled their dispute involving the ’892 patent and agreed to seek dismissal of this

proceeding. Paper 6, 1. The parties further represent that the '892 patent was dismissed from the underlying district court litigation and that there are no other pending litigations or any other proceedings between the parties relating to the '892 patent. *Id.* at 3. We find the executed Settlement Agreement to be consistent with the parties' representations. Ex. 1018, 1, 3.

In the Joint Request, the parties request that the Settlement Agreement be treated as business confidential information. Paper 7, 3. We find that the Joint Request was timely filed along with a true copy of the Settlement Agreement. 37 C.F.R. § 42.74(b)–(c). We also find that the parties agreed to keep the Settlement Agreement confidential. Ex. 1018, 3.

Upon review of the procedural posture and the facts before us, we determine that it is appropriate to dismiss this proceeding and treat the Settlement Agreement as business confidential. Accordingly, we grant the parties' Joint Motion and Joint Request.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion (Paper 6) to dismiss this *inter partes* review is *granted*; and

FURTHER ORDERED that the Joint Request (Paper 7) to treat the settlement agreement (Ex. 1018) as business confidential information is also *granted*.

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