

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW WORLD MEDICAL, INC.,
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,
Patent Owner.

IPR2022-00684
Patent 10,888,460 B2

Before JAMES A. TARTAL, ROBERT A. POLLOCK, and
RYAN H. FLAX, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

TERMINATION

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

ORDER

Granting Joint Motion to Keep Confidential and Separate
35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c)

New World Medical, Inc. (“Petitioner”) and MicroSurgical Technology, Inc. (“Patent Owner”) filed, with our prior authorization, a Joint Motion to Terminate *Inter Partes* Review Under 35 U.S.C. § 317 and 37 C.F.R. § 42.74. Paper 13. Along with the motion to terminate, the parties filed a copy of a Confidential Settlement Agreement (Ex. 2002), as well as a Joint Motion to Keep Confidential and Separate Under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 14) direct to Exhibit 2002. *See* 37 C.F.R. § 42.74(c) (a party to a settlement may request that the settlement agreement be treated as business confidential and be kept separate from the patent file).

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” It is also provided in 35 U.S.C. § 317(a) that if no petitioner remains, the Office may terminate the *inter partes* review.

In this case, the Board issued a decision to institute *inter partes* review. Paper 16. However, the Board has not yet decided the merits of the proceeding or entered a final written decision. In the joint motion, the parties state that they have settled their dispute and have reached an agreement to request termination of this *inter partes* review. Paper 11, 1. Accordingly, in the circumstances present here, we determine that it is appropriate to terminate the proceeding. 37 C.F.R. § 42.71(a). This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

The parties also ask that the Confidential Settlement Agreement be treated as business confidential information and be kept separate from the file of the challenged patents. Paper 14. We determine that it is appropriate

to treat the Confidential Settlement Agreement as business confidential information, and to keep that document separate from the files of the challenged patents, pursuant to 37 C.F.R. § 42.74(c).

For the foregoing reasons, it is:

ORDERED that the Joint Motion to Terminate (Paper 13) is granted and this proceeding is terminated with respect to Petitioner and Patent Owner; and,

FURTHER ORDERED that the Joint Motion to Keep Confidential and Separate (Paper 14) is granted, and that the Confidential Settlement Agreement (Ex. 2002) is to be treated as business confidential information and is to be kept separate from the patent file.

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