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571-272-7822

Paper 13
Entered: February 2, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXACTECH, INC.,
Petitioner,

v.

ORTHOSOFT ULC,
Patent Owner.

IPR2022-00837 (Patent 7,715,602 B2)
IPR2022-00838 (Patent 7,857,821 B2)
IPR2022-00839 (Patent 8,147,496 B2)
IPR2022-00910 (Patent 7,715,602 B2)[1]

Before HUBERT C. LORIN, BARBARA A. PARVIS, SCOTT C. MOORE, and SEAN P. O'HANLON, *Administrative Patent Judges*.[2]

PER CURIAM.

TERMINATION
Due to Settlement After Institution of Trial and
Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information
35 U.S.C. § 317; 37 C.F.R. § 42.74

[1] This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.
[2] This listing of Administrative Patent Judges does not reflect an expanded panel under SOP 1 § III.M. This order addresses multiple proceedings that collectively involve more than three Administrative Patent Judges.

I. INTRODUCTION

Petitioner and Patent Owner (collectively "the Parties") have requested that the above-identified *inter partes* review proceedings be terminated pursuant to a settlement. On January 23, 2023, the Parties filed a Joint Motion to Terminate Proceeding ("Joint Motion") in each of the above-identified proceedings. Paper 8.[3] The Parties previously sought authorization to file the Joint Motions and received that authorization via email on January 19, 2023. The Parties also filed a copy of a settlement agreement (Paper 10, "Settlement Agreement") and filed a Joint Request that the Settlement Be Treated as Business Confidential Information and Be Kept Separate from the Files (Paper 9, "Joint Request") in each of the proceedings.

II. DISCUSSION

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 in the *inter partes* review, the Office may terminate the review.

In the Joint Motions, the Parties represent that they have reached an agreement that resolves this proceeding and the related district court

[3] For expediency, we cite to the Papers and Exhibits filed in IPR2022-00837, unless otherwise indicated. Similar Papers were filed in IPR2022-00838, IPR2022-00839, and IPR2022-00910.

litigation, and that the filed copy of the Settlement Agreement is a true and correct copy. Motion 2.

We instituted trial in the above-identified proceedings. Paper 6. We have not yet decided the merits of the proceedings, and final written decisions have not been entered. Notwithstanding that the proceedings have moved beyond the preliminary stage, the Parties have shown adequately that termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

The Parties also requested that the Settlement Agreement be treated as business confidential information and be kept separate from the files of Patent 7,715,602 B2, Patent 7,857,821 B2, Patent 8,147,496 B2, and Patent 7,715,602 B2. Request 2. After reviewing the Settlement Agreement, we find that the Settlement Agreement contains confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 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 the Joint Motions are *granted*, and IPR2022-00837, IPR2022-00838, IPR2022-00839, and IPR2022-00910 are *terminated* with respect to Petitioner and Patent Owner, pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of Patent 7,715,602 B2, Patent 7,857,821 B2, Patent 8,147,496 B2, and Patent 7,715,602 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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