

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PARAGON 28, INC.,
Petitioner,

v.

WRIGHT MEDICAL TECHNOLOGY, INC.,
Patent Owner.

IPR2023-00013 (Patent 10,888,336 B2)
IPR2023-00015 (Patent 9,907,561 B2)¹

Before GEORGE R. HOSKINS, ROBERT A. POLLOCK, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

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

ORDER
*Granting Joint Request to Treat Settlement Agreement as
Business Confidential Information*

¹ This Order is being filed in each proceeding listed in the caption. The parties may use this style caption only if the paper includes a statement certifying that the identical paper is being filed in each proceeding listed in the caption.

I. INTRODUCTION

In both of these two proceedings, on January 9, 2023, Petitioner filed revised Motions to Dismiss the respective Petitions. *See, e.g.*, IPR2023-00013, Paper 8 (“the Motion” or “Mot.”). This Order cites to papers filed in IPR2023-00013 unless otherwise specified. Identical papers were also filed in in IPR2023-00015.

The Motions represent that the parties have entered into a settlement agreement in connection with termination of the proceedings. *See* Mot. 2; Ex. 1039 (“the Settlement Agreement”). The parties accordingly have filed a Joint Request that the Settlement Agreement be treated as business confidential information. *See* Paper 9 (“the Joint Request”).

II. DISCUSSION

The Motions request that we dismiss the respective Petitions, and represent that Patent Owner does not oppose this request. *See* Mot. 2–3. Petitioner asserts good cause exists for the requested relief, because the proceedings are in the preliminary phase without any decision on institution having been issued, and dismissal would preserve the Board’s and the parties’ resources. *See id.* at 2–4 (citing 37 C.F.R. § 42.71(a) and three PTAB decisions). The Motion “further certifies that there are no . . . agreements or understandings [other than the Settlement Agreement], oral or written, between Petitioner and Patent Owner, including any collateral agreements, made in connection with, or in contemplation of, the dismissal of the present proceeding[s] as set forth in 35 U.S.C. § 317(b).” *Id.* at 2.

We have not yet decided whether to institute review in these two proceedings. Indeed, the deadline for Patent Owner to file a Preliminary

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Response (January 17, 2023)² has not yet passed. The Motions have shown adequately that termination of both proceedings is appropriate, given that Patent Owner does not oppose the Motions, and termination would preserve the parties' and the Board's resources. Under these circumstances, we determine that good cause exists to terminate both proceedings.

The parties also have requested jointly that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the two challenged patents. *See* Joint 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 Motions are each *granted*, and IPR2023-00013 and IPR2023-00015 are each *terminated*, pursuant to 37 C.F.R. § 42.74; and

FURTHER ORDERED that the Joint Requests are *granted*, and the Settlement Agreement shall be kept separate from the files of U.S. Patent Nos. 10,888,336 B2 and 9,907,561 B2, and made available only to Federal

² *See* 37 C.F.R. § 42.107(a)–(b) (a patent owner may file a preliminary response no later than three months after a notice granting a filing date to a petition); Paper 3 (Notice of Filing Date Accorded to Petition, dated October 17, 2022).

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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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