

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMVIE, INC. AND ZIMMER BIOMET SPINE, LLC,
Petitioners

v.

ROGER P. JACKSON,
Patent Owner

Case IPR2023-01431
U.S. Patent No. 10,548,641

**JOINT REQUEST TO FILE SETTLEMENT AGREEMENT AS BUSINESS
CONFIDENTIAL INFORMATION PURSUANT TO 35 U.S.C. § 317 AND 37
C.F.R. § 42.74**

Pursuant to 35 U.S.C. § 317(b), 37 C.F.R. § 42.74(c), and the Board’s email of April 30, 2024, Petitioners ZimVie, Inc. and Zimmer Biomet Spine, LLC (collectively, “Petitioners”) and Patent Owner Dr. Roger P. Jackson (“Patent Owner”) (collectively, the “Parties”) have reached a resolution and jointly agree to terminate the above-captioned proceeding. As permitted by statute, the Parties request that the Board treat as business confidential information, the true and correct copy of the settlement agreement (the “Agreement”) which has been filed as Confidential Exhibit 1045.

35 U.S.C. § 317(b) provides that:

At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and shall be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.

37 C.F.R. § 42.74(c) provides that:

A party to a settlement may request that the settlement be treated as business confidential information and be kept separate from the files of an involved patent or application. The request must be filed with the settlement. If a timely request is filed, the settlement shall only be available:

- (1) To a Government agency on written request to the Board; or
- (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in § 42.15(d) and on a showing of good cause.

The Parties respectfully submit that the present request, which is filed contemporaneously with the Agreement and with the Parties' Joint Motion to Terminate, is timely and in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74. Therefore, the Parties request that the Agreement (Confidential Exhibit 1045) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the U.S. Patent No. 10,548,641, and (iii) be made available only to Federal Government agencies on written request, or to person showing good cause on written request, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Respectfully submitted,

FAEGRE DRINKER BIDDLE & REATH
LLP

Dated: May 1, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on May 1, 2024, I caused a true and accurate copy of the Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317 and 37 C.F.R. § 42.74 to be served on counsel for Patent Owner via email, as follows:

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Dated: May 1, 2024

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