

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMVIE, INC. AND ZIMMER BIOMET SPINE, INC.,
Petitioner,

v.

ROGER P. JACKSON,
Patent Owner.

IPR2023-01431
Patent 10,548,641 B2

Before ULRIKE W. JENKS, SHERIDAN K. SNEDDEN, and
ZHENYU YANG, *Administrative Patent Judges*.

JENKS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On May 1, 2024, and with our authorization (Ex. 3001), Petitioner and Patent Owner (collectively, “the Parties”) filed a joint motion to terminate the above-captioned *inter partes* review proceedings. Paper 11 (“Joint Motion”). Along with the Joint Motion, the Parties filed a copy of a settlement agreement (Ex. 1045 “the Agreement”), as well as a joint motion requesting that the Agreement be treated as business confidential information and kept separate from the file of 10,548,641 B2 (“the ’641 patent”). Paper 12, 1 (“Joint Request”).

In the Joint Motion, the Parties represent that the Agreement resolves all disputes between the Parties involving the ’641 patent. Joint Motion 1, 1. The Parties also represent that they have filed a true copy of the Agreement made in connection with, or in contemplation of, the termination of the above-captioned proceeding. *Id.* (referencing Ex. 1045). However, the Joint Motion does not certify that there are no other agreements or understandings, oral or written, between the parties made in connection with, or in contemplation of, the termination of the above-referenced proceeding. *See* 35 U.S.C. § 317(b). The parties are granted leave to file an Amended Motion to Terminate certifying that there are no such agreements or understandings.

The Parties also request that the Agreement be treated as business confidential information and kept separate from the file of the ’641. Joint Request 1. After reviewing the Agreement, we find that they contain confidential business information regarding the terms of settlement. Thus, good cause exists to treat the Agreement as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Accordingly, we grant the Joint Request.

I. ORDER

Accordingly, it is:

ORDERED that the parties' request that the Agreement (Ex. 1045) be treated as business confidential information, to be kept separate from the files of U.S. Patent No. 10,548,641 B2, under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate the above referenced proceeding is *denied* without prejudice; and

FURTHER ORDERED that the parties are granted leave to file an Amended Joint Motion to Terminate containing a certification that there are other agreements or understandings no later than May 14, 2024.

IPR2023-01431
Patent 10,548,641 B2

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