

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*.

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

I. INTRODUCTION

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 our Order dated May 3, 2024 we noted that Joint Motion was defective and granted the Parties leave to file an amended joint motion to terminate. Paper 13. The parties filed their amended joint motion to terminate on May 7, 2024. Paper 14 (“Amended Joint Motion.”).

II. CONCLUSION

In the Amended Joint Motion, the Parties represent that the Agreement resolves all disputes between the Parties involving the ’641 patent. Amended 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.* In addition, “[t]he Parties 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.” *Id.*

We instituted trial for the above-captioned *inter partes* review proceedings on April 1, 2024. *See* Paper 8. We have not yet decided the merits of the proceeding, and a final written decision has not been entered.

Notwithstanding that the proceeding has moved beyond the preliminary stage, the Parties have shown adequately that the termination of the proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceeding with respect to the Parties.

In our Order dated May 3, 2024 we granted the Parties request to treat the Agreement as business confidential information to be kept separate from the file of the '641 patent. Paper 13, 3; *see* Joint Request 1.

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, it is:

ORDERED that the Joint Motion to terminate (Paper 11) is *granted*, and IPR2023-01431 is terminated with respect to Petitioner and Patent Owner; and

FURTHER ORDERED that this paper does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

IPR2023-01431
Patent 10,548,641 B2

FOR PETITIONER:

Victor Jonas
Victor.jonas@faegredrinker.com

Lauren Barta
Lauren.barta@faegredrinker.com

FOR PATENT OWNER:

James Murphy
jpmurphy@polsinelli.com

Patrick Muffo
pmuffo@polsinelli.com