UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDELA LLC and MEDELA AG,
Petitioners

v.

M.E.A.C. ENGINEERING LTD.,
Patent Owner

Case IPR2024-01076
Patent U.S. 8,858,534 B2

JOINT MOTION TO TERMINATE PROCEEDING IN VIEW OF SETTLEMENT PURSUANT TO 35 U.S.C. § 317(a),

JOINT NOTICE OF SETTLEMENT PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74, AND

JOINT REQUEST TO KEEP SEPARATE PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c)

Pursuant to 35 U.S.C. §§ 317(a), (b) and 37 C.F.R. §42.74, Petitioners Medela LLC and Medela AG and Patent Owner M.E.A.C. Engineering Ltd. (collectively, the "Parties") jointly request termination of the *Inter Partes* Review of U.S. Patent No. 8,858,534 B2 (the "'534 patent"), Case No. IPR2024-01076. The Board authorized the Parties to file this Motion on September 20, 2024. No other petitioners remain in the proceeding.

Petitioners and Patent Owner have reached an agreement resolving the dispute in the above-captioned *inter partes* review and agreed to terminate these proceedings. The Board has not yet instituted this IPR petition nor decided this IPR on its merits. Moreover, because an institution decision has not yet been made, the Parties have not taken any discovery in these proceedings, nor engaged in oral argument.

As required under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72(b), a true copy of the written Settlement resolving the dispute in the above captioned *inter partes* review and the related litigation is filed with the Board as **Exhibit 1033**.

Petitioner Medela LLC and Patent Owner are concurrently seeking to terminate the other district court litigation involving the '534 patent: *M.E.A.C. Engineering Ltd. v. Medela LLC, et al.*, Case No. 1:23-cv-14045 (N.D. Ill.). Additionally, a Joint Motion to Terminate Proceeding Pursuant to 37 C.F.R. § 42.72 is being concurrently filed in IPR2024-01076 which involves a related

patent—U.S. Patent No. 8,506,554 B2—which is also asserted in the above-referenced pending district court litigation.

The ’534 patent is also involved in the following pending proceedings of which the Petitioners are not a party:

- *MEAC Engineering LTD v. Solventum Corp.*, Case No. 5:23-cv-01256 (W.D. Tex.)
- IPR2024-01001. Petition for *Inter Partes* review of the ’554 Patent filed by Solventum Corp. on June 5, 2024.

Because there is no longer a case-in-controversy between the Parties involving the ’534 patent and because the Board has not yet reached an institution decision nor final decision on this IPR, the Parties jointly request that the Board terminate this IPR pursuant to 35 U.S.C. § 317(a). Good cause exists to terminate this IPR. The Board has yet to reach any decisions on the merits (or institution), termination would preserve the Board’s and the Parties’ resources, and no parties will be prejudiced by the termination.

35 U.S.C. § 317(a) provides in relevant part: “An 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.” *See also* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a

final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a)"). Indeed, the November 2019 Office Patent Trial Practice Guide indicates that "There are strong public policy reasons to favor settlement between the parties to a proceeding."

Petitioner and Patent Owner hereby additionally request that the Settlement filed separately as **Exhibit 1033** be treated as business confidential information, be kept separate from the file of the involved patents, and be 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).

For the foregoing reasons, the Parties jointly and respectfully request that the Board terminate the instant proceeding.

If any fees are due in connection with this matter, the Commissioner is hereby authorized to charge them to Attorney Deposit Account 50-3081.

Date: September 23, 2024

/ Erik N. Lund/
Erik N. Lund (Reg. No. 77,473)
Attorney for Patent Owner

/Erik B. Milch/
Erik B. Milch (Reg. No. 42,887)
Attorney for Petitioners

EXHIBIT APPENDIX

Exhibit	Description
1033	Settlement Agreement (Business Confidential)

CERTIFICATE OF SERVICE

The undersigned certifies that copies of this **JOINT MOTION TO TERMINATE PROCEEDING IN VIEW OF SETTLEMENT PURSUANT TO 35 U.S.C. § 317(a), NOTICE OF SETTLEMENT PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74, AND REQUEST TO KEEP SEPARATE PURSUANT TO 35 U.S.C. § 317(b) AND 37 C.F.R. § 42.74(c), (EXHIBIT 2001)** were served on September 23, 2024 in their entirety electronically on:

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