

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELADOC, INC.,
Petitioner,

v.

AMERICAN WELL CORP.,
Patent Owner.

Case IPR2016-00100
Patent 7,590,550 B2

Before BRIAN J. McNAMARA, MICHAEL J. FITZPATRICK, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

DECISION
Termination of Trial
35 U.S.C. § 317, 37 C.F.R. §§ 42.72 and 42.74

I. DISCUSSION

On November 29, 2016, the parties filed a Joint Motion to Terminate this proceeding (Paper 20) pursuant to a written agreement, as well as a Joint Request (Paper 21) to have the agreement treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). The parties also filed a true copy of their written agreement. Ex. 1011. The parties contend that termination of this proceeding is appropriate, representing that they “have settled their disputes via a written agreement.” Paper 20, 2.

Under 35 U.S.C. § 317(a), “[a]n inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Further, under 35 U.S.C. § 317(b), “[a]ny agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding, made in connection with, or in contemplation of, the termination of an inter partes review under this section shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination.”

As the parties have filed their written agreement and jointly requested termination, we determine that it is appropriate to terminate this proceeding without rendering a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 12, 13, 16–22, and 24–29 of the ’550 patent, which are all the claims on which trial has been instituted (Paper 10, 24). *See* 35 U.S.C. § 317; 37 C.F.R. §§ 42.72, 42.74.

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II. ORDER

Accordingly, it is:

ORDERED that the parties' Joint Request that their agreement (Ex. 1011) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is GRANTED; and

ORDERED that the parties' Joint Motion to Terminate this proceeding is GRANTED, and this proceeding is hereby terminated.

PETITIONER:

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