

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC XOMED, INC.,
Petitioner,

v.

NEUROVISION MEDICAL PRODUCTS, INC.,
Patent Owner.

Case IPR2016-01405
Patent 8,634,894 B2

Before MEREDITH C. PETRAVICK, MITCHELL G. WEATHERLY, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

JUDGMENT

Termination Due to Settlement after Institution of *Inter Partes* Review
35 U.S.C. § 317 and 37 C.F.R. § 42.74

I. Introduction

We instituted trial on December 29, 2016. Paper 12. On May 8, 2017, Petitioner, Medtronic Xomed, Inc. (“Medtronic”), and Patent Owner, Neurovision Medical Products, Inc. (“Neurovision”), (collectively referred to as “the parties”), filed a Joint Motion to Terminate *Inter Partes* Review under 35 U.S.C. § 317(a). Paper 27 (“Joint Motion to Terminate”).¹ Along with the Joint Motion to Terminate, the parties filed a true copy of a Settlement and License Agreement (Ex. 2058, “Settlement Agreement”), as well as a Joint Request to Keep Separate Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 28 (“Joint Request to Keep Separate”)).

II. Discussion

The parties are reminded that the Board is not a party to the settlement, and may identify independently any question of patentability. 37 C.F.R. § 42.74(a). Generally, however, the Board expects that a proceeding will terminate after the filing of a settlement agreement. *See, e.g., Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

In the Joint Motion to Terminate, the parties represent that they have settled their dispute and have reached an agreement “that resolves the disputes in the . . . *inter partes* reviews and all disputes between” the parties relating to the ’894 patent. Paper 27, 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

¹ Filing of the Joint Motion to Terminate was authorized in e-mail correspondence from Board personnel on May 8, 2017.

request of the petitioner and patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.”

At this stage of the proceeding, Medtronic has not filed a Petitioner Reply, and such a reply is not due until July 12, 2017. Paper 13, 7 (identifying Petition’s Reply as due by Due Date 2); Paper 24, 2 (stipulating new Due Date 2). Additionally, the panel has not decided the merits of the challenges presented in the Petition and Patent Owner Response. Upon consideration of the circumstances of this case, the panel has determined to terminate this *inter partes* review as to both Medtronic and Neurovision without rendering a final written decision.

III. Orders

It is

ORDERED that the Joint Motion to Terminate (Paper 27) is *granted*, and this proceeding is hereby *terminated*; and

FURTHER ORDERED that the Joint Request to Keep Separate (Paper 28) is also *granted*, and the Settlement Agreement (Ex. 2058) will be treated as business confidential information and kept separate from the files of the ’894 patent under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

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