

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACTA MEDICAL L.L.C.,
Petitioner,

v.

CURLIN MEDICAL INC.,
Patent Owner.

Case IPR2017-00324
Patent 6,164,921

Before BEVERLY M. BUNTING and AMANDA F. WIEKER,
Administrative Patent Judges.

BUNTING, *Administrative Patent Judge.*

JUDGMENT

Termination of the Proceeding
35 U.S.C. § 317(a) and 37 C.F.R. § 42.72

ACTA Medical LLC, (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 15–34 (“the challenged claims”) of U.S. Patent No. 6,164,921 (Ex. 1001, “the ’921 patent”). Paper 1 (“Pet.”). Curlin Medical Inc., (“Patent Owner”), the assignee of the ’921 patent, filed a Preliminary Response to the Petition. Paper 9 (“Prelim. Resp.”). In an email to the Board dated June 5, 2017, Petitioner requested leave to file a motion for adverse judgement under 37 C.F.R. § 42.73(b)(4). During a June 6, 2017 telephone conference between the parties and Judges Bunting and Wieker, the parties indicated that they had settled their dispute. Because the parties have settled their dispute, we granted authorization to file the present joint motion to terminate this proceeding pursuant to a settlement agreement under 37 C.F.R. § 42.74.

On June 7, 2017, the parties filed this joint motion to terminate the present proceeding pursuant to a settlement agreement. Paper 13. The parties also filed a true copy of their written settlement agreement, made in connection with the termination of this proceeding, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72. Ex. 2002. Additionally, the parties submitted a joint request to have their settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 14.

The parties submit that termination is appropriate because the parties have settled their dispute and have reached agreement to terminate this proceeding. Paper 13, 1. The parties represent that this settlement agreement ends all disputes as to this patent, including the pending district court lawsuit. *Id.*

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. 48756, 48768 (Aug. 14, 2012). We note that this proceeding is still in the preliminary stage, and the Board has not yet issued a decision whether to institute an *inter partes* review.¹

Under the circumstances, based on the record before us, we determine that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner. At this juncture, termination is suitable because it promotes efficiency and minimizes unnecessary costs. Based on the facts, it is appropriate to terminate this proceeding without rendering a final written decision. *See* 35 U.S.C. § 317(a); 37 C.F.R. § 42.72.

ORDER

In consideration of the foregoing, it is

ORDERED that the parties' joint request that the settlement agreement (Exhibit 2002) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), to be kept separate from the patent file in this proceeding, is GRANTED;

FURTHER ORDERED that the joint motion to terminate IPR2017-00324 is GRANTED; and

FURTHER ORDERED that this proceeding is TERMINATED.

¹ We remind the parties that the statutory deadline for institution of trial is June 13, 2017.

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Patent 6,164,921

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