

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEXEON LTD.,
Petitioner,

v.

ONED MATERIAL, LLC
Patent Owner.

Case IPR2017-00851
Patent 8,440,369 B2

Before JO-ANNE M. KOKOSKI, JON B. TORNQUIST, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

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

On October 25, 2018, with Board authorization, the parties filed a joint motion to terminate this proceeding (Paper 40), along with what they indicate is a copy of their written settlement agreement (Ex. 1090). On the same day, the parties also filed a joint motion requesting that the settlement agreement be treated as confidential information and kept separate from the file of U.S. Patent No. 8,440,369 B2. Paper 41.

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.” We instituted a trial in this proceeding on August 25, 2017,¹ but we have not yet decided the merits of the proceeding.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.” The parties have filed what they indicate is a copy of their written settlement agreement, which they represent constitutes the entire agreement between the parties with respect to this *inter partes* review. Paper 40, 2. In view of the foregoing, we determine that it is appropriate to terminate this proceeding without rendering a final written decision. *See* 37 C.F.R. §§ 42.72, 42.74.

¹ On June 6, 2018, the one-year period for issuing a Final Written Decision in this proceeding was extended by up to six months. Paper 34; Paper 35; *see* 37 C.F.R. § 42.100(c).

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As requested by the parties, the settlement agreement will be treated as business confidential information and kept separate from the patent file.
37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the joint motion to terminate the proceeding (Paper 40) is *granted*;

FURTHER ORDERED that the parties' joint request that the settlement agreement (Ex. 1090) be treated as business confidential information (Paper 41) is *granted*; and

FURTHER ORDERED that this proceeding is hereby *terminated*.

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