

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM and
TISSUEGEN, INC.,
Patent Owner.

IPR2019-00037 (Patent 6,596,296 B1)
IPR2019-00038 (Patent 7,033,603 B2)¹

Before SUSAN L. C. MITCHELL, AVELYN M. ROSS,
KRISTI L. R. SAWERT, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

DECISION

Settlement Prior to Institution of Trial
Granting Request to Treat Settlement Agreement as
Business Confidential Information
37 C.F.R. §§ 42.74, 42.72(c)

¹ We exercise our discretion to issue one order to be entered in both cases. The parties are not authorized to use this style heading for subsequent papers without Board approval.

IPR2019-00037 (Patent 6,596,296 B1)
IPR2019-00038 (Patent 7,033,603 B2)

On June 4, 2020, with our prior authorization, Medtronic, Inc. (“Petitioner”)² and The Board of Regents, The University of Texas System and TissueGen, Inc. (“Patent Owner”) (collectively, “the parties”) filed a Joint Motion to Terminate. IPR2019-00037, Paper 19; IPR2019-00038, Paper 21 (collectively “Motion”). Together with the Motion, the parties filed a copy of their written Confidential Release and Settlement Agreement (IPR2019-00037, Ex. 1057; IPR2019-00038, Ex. 1044, collectively “Agreement”) and a Joint Request to Treat Settlement Agreement as Business Confidential Information and to Keep Separate. IPR2019-00037, Paper 20; IPR2019-00038, Paper 22 (collectively “Joint Request”).

The Board generally expects that a case “will terminate after the filing of a settlement agreement, unless the Board has already decided the merits.” *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012); *see* 35 U.S.C. §317(a) and 37 C.F.R. § 42.72. Though a decision on institution has not yet issued, that decision is set to issue no later than June 12, 2020. The parties, however, indicate that the Agreement resolves the dispute regarding U.S. Patent Nos. 6,596,296 and 7,033,603 and related patents. Motion 1; Agreement 2–4. The parties state that “[n]o dispute remains between the Parties involving the challenged patent[s]” and “[t]here are no currently pending district court litigations involving the challenged patent[s], and all currently pending IPR proceedings between the Parties involving the challenged patent[s] will be dismissed with prejudice” according to the terms of the Agreement. Motion 1.

² Medtronic, Inc remains as the sole Petitioner in this matter. “Tyrx, Inc. no longer exists as a separate entity,” having merged into Medtronic, Inc. IPR2019-00037, Paper 21, IPR2019-00038, Paper 23.

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IPR2019-00038 (Patent 7,033,603 B2)

Under these circumstances, we determine that it is appropriate to terminate this preliminary proceeding with respect to both Petitioner and Patent Owner. Accordingly, we grant the parties' joint motion to terminate. *See* 35 U.S.C. § 317(a); 37 C.F.R. §§ 42.5(a), 42.74. After reviewing the Agreement, we find that it contains confidential business information regarding the terms of the settlement and that good cause exists to treat the Agreement as business confidential information to be kept separate from the patent file. *See* 35 U.S.C. § 317(b); 37 C.F.R. § 42.74.

ORDER

In view of the foregoing, it is

ORDERED that the Joint Request to Treat Settlement Agreement as Business Confidential (IPR2019-00037, Paper 20; IPR2019-00038, Paper 22) is *granted*;

FURTHER ORDERED that the Settlement Agreement (IPR2019-00037, Ex. 1057; IPR2019-00038, Ex. 1044) shall be treated as business confidential information and shall be kept separate from the patent file; and

FURTHER ORDERED that the Parties' Joint Motion to Terminate (IPR2019-00037, Paper 19; IPR2019-00038, Paper 21) is *granted* and this proceeding is hereby terminated.

IPR2019-00037 (Patent 6,596,296 B1)
IPR2019-00038 (Patent 7,033,603 B2)

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