

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED LIMITED, RESMED INC., AND
RESMED CORP.,
Petitioner,

v.

FISHER & PAYKEL HEALTHCARE LIMITED,
Patent Owner.

Case IPR2019-00172
Case IPR2019-00173
Patent 9,974,914 B2

Before THOMAS L. GIANNETTI, MICHAEL L. WOODS, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

TERMINATION
Due to Settlement After Institution of Trial
35 U.S.C. § 317; 37 C.F.R. § 42.74

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On September 9, 2019, upon request from Petitioner and Patent Owner (collectively, “the Parties”), we authorized the Parties to file joint motions to terminate these proceedings pursuant to a settlement agreement under 37 C.F.R. § 42.74. On September 12, 2019, the Parties filed Joint Motions to Terminate each of these proceedings pursuant to a settlement agreement. Paper 22 (“Joint Motion”).¹ The Parties also filed true copies of their written settlement agreement (Ex. 2005), made in connection with the termination of these proceedings, in accordance with 35 U.S.C. § 317(b) and 37 C.F.R. § 42.72. Additionally, the Parties submitted joint requests to have their written settlement agreement treated as confidential business information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c). Paper 23.

The Parties submit that termination is appropriate because the Parties have settled their dispute and have reached agreement to terminate these proceedings. Paper 22, 1. The Parties represent that their settlement agreement ends all disputes as to the challenged patent, and that “[t]here are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of this IPR.” *Id.*

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).

¹ Unless otherwise indicated, the referenced paper numbers and exhibit numbers are identical for both IPR2019-00172 and IPR2019-00173.

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On May 30, 2019, the Board instituted trial in these proceedings. Paper 19. At this stage of the proceedings, the Board does not have before it full briefing on the trial issues and the Board has not reached a final decision in either proceeding. Under these circumstances and based on the record before us, we determine that it is appropriate to terminate these proceedings with respect to the Parties, to promote efficiency and to minimize unnecessary costs. Based on these facts, it is appropriate to enter judgement terminating these proceedings without rendering a final written decision and to treat the Confidential Settlement and License Agreement (Ex. 2005) as business confidential information. *See* 35 U.S.C. §§ 317(a), 317(b); 37 C.F.R. §§ 42.72, 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

ORDER

In consideration of the foregoing, it is
ORDERED that the Parties' joint requests (Paper 23) that the settlement agreement (Exhibit 2005) be treated as business confidential information under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and be kept separate from the patent file in these proceedings are *granted*;

FURTHER ORDERED that the Joint Motions to Terminate (Paper 22) IPR2019-00172 and IPR2019-00173 are *granted*; and

FURTHER ORDERED that both of these proceedings are *terminated*.

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