

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioners

v.

OMNI MEDSCI, INC.,  
Patent Owner.

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Cases IPR2019-00912; IPR2019-00915  
Patent 9,885,698 B2<sup>1</sup>

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Before BRIAN J. McNAMARA, JOHN F. HORVATH,  
and SHARON FENICK, *Administrative Patent Judges*

McNAMARA, *Administrative Patent Judge.*

ORDER AUTHORIZING FILING OF MOTION TO DISMISS  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

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<sup>1</sup> Each case involves the same patent. This order is to be filed in each case. The parties are not authorized to use this style heading in any subsequent papers.

In e-mail correspondence on June 25, 2019, the parties requested authorization to move to terminate the current proceedings because a settlement agreement had been reached concerning U.S. Patent 9,885,698 B2 (“the subject patent”).

The parties may agree to settle any issue in a proceeding pursuant to a written agreement, a copy of which shall be filed with the Board before termination of the trial. 37 C.F.R. § 42.74(a)-(b). Any agreement or understanding between the patent owner and a petitioner, including any collateral agreements referred to in such agreement or understanding made in connection with, or in contemplation of the termination shall be in writing and a true copy of such agreement or understanding shall be filed in the Office before the termination of such proceeding as between the parties. 35 U.S.C. § 317(b). Any such agreement should be filed as a separate exhibit.

This matter is in the preliminary stage. Patent Owner has not filed a Patent Owner Preliminary Response. Under these circumstances, it may be appropriate to dismiss the proceeding.

The parties are authorized to file a Joint Motion To Dismiss each proceeding. The Joint Motion To Dismiss must update the Board concerning the status of any litigation or proceeding, including, but not limited to proceedings in the U.S. Patent and Trademark Office, involving the subject patent, and advise the Board whether any litigation or proceeding involving the subject patent is contemplated in the foreseeable future. The Joint Motion To Dismiss also must include a copy of any agreement and include a statement certifying that there are no collateral agreements or

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understandings made in connection with, or in contemplation of, the termination of the proceeding.

A party to a settlement may request that any written agreement be treated as business confidential information and be kept separate from the files of an involved patent. 35 U.S.C. § 317(b); 37 C.F.R. § 42.74(c). The request must be filed with the settlement. *Id.*

It is **ORDERED** that the parties are authorized to file a Joint Motion To Dismiss the proceeding and a Joint Request That The Settlement Agreement Be Treated As Business Confidential Information.

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