

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

OMNI MEDSCI, INC.,
Patent Owner.

IPR2020-00209
Patent 10,213,113 B2

Before GRACE KARAFFA OBERMANN, JOHN F. HORVATH, and
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER DENYING JOINT MOTION TO TERMINATE,
GRANTING LEAVE TO FILE AMENDED MOTION TO TERMINATE,
AND GRANTING JOINT REQUEST THAT SETTLEMENT
AGREEMENT BE TREATED AS BUSINESS CONFIDENTIAL
INFORMATION AND KEPT SEPARATE
35 U.S.C. § 317; 37 C.F.R. § 42.74

The parties have requested that this proceeding be terminated pursuant to a settlement. On May 27, 2020, the Board authorized the parties to file a Joint Motion to Terminate and a Joint Request to Keep Separate, requesting that the settlement agreement be treated as business confidential information under 37 C.F.R. 42.74(c). On June 2, 2020 the parties filed a Joint Motion to Terminate, Paper 9 (“Mot. To Terminate”), and a Joint Request to Keep Separate, Paper 10. *See* 35 U.S.C. § 317(a) (2018); 37 C.F.R. § 42.72. The parties also filed a copy of a written settlement agreement. Paper 10; Ex. 1067.

A Decision on Institution has not yet been issued. The parties note that in the district court they dismissed their respective claims and counterclaims concerning the patent that is the subject of this proceeding. Mot. to Terminate 1. The Motion to Terminate explains reasons termination is appropriate and states that the parties have not identified any other related matters. *Id.* at 1–3.

In the Motion to Terminate, the parties represent that the written settlement agreement has been filed as Exhibit 1067. *Id.* at 4. However, the Motion to Terminate does not certify that there are no collateral agreements or understandings made in connection with, or in contemplation of, the termination of the proceeding. *See* 35 U.S.C. § 317(b). In the absence of such a certification, it is not appropriate to terminate the proceeding at this time.

The parties are granted leave to file an Amended Motion to Terminate certifying there are no such collateral agreements or understandings.

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It is, therefore,

ORDERED that the Joint Motion to Terminate the proceeding is DENIED;

FURTHER ORDERED that the parties are granted leave to file an Amended Joint Motion to Terminate containing a certification that there are no collateral agreements or understandings not later June 12, 2020; and

FURTHER ORDERED that the parties' Joint Request to Keep Separate, requesting that the settlement agreement be treated as business confidential information and kept separate from the file of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), is GRANTED.

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PETITIONER: (via electronic transmission)

Jeffery Kushan
Ching-Lee Fukuda
Thomas Broughan
SIDLEY AUSTIN LLP
jkushan@sidley.com
clfukuda@sidley.com
tbroughan@sidley.com

PATENT OWNER: (via electronic transmission)

Thomas Lewry
John LeRoy
Robert Tuttle
John Halan
Christopher Smith
Andrew Turner
BROOKS KUSHMAN P.C.
tlewry@brookskushman.com
jleroy@brookskushman.com
rtuttle@brookskushman.com
jhalan@brookskushman.com
csmith@brookskushman.com
aturner@brookskushman.com