

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*.

DECISION  
Settlement Prior to Institution of Trial  
*37 C.F.R. § 42.74*

As authorized in our order of June 5, 2020 (Paper 11), the parties have filed an Amended Motion to Terminate this proceeding. Paper 12 (“Amended Motion to Terminate”). In the Amended Motion to Terminate 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. Amended Mot. to Terminate, 1–2. The Amended Motion to Terminate explains reasons termination is appropriate and states that no other *inter partes* reviews of U.S. Patent 10,213,113 B2 (“the ’113 patent”) are pending, and the parties do not contemplate any future litigation or proceeding involving the ’113 patent. *Id.* at 1–3. The parties previously filed a copy of a written settlement agreement (Ex. 1067) and we granted their joint request to keep the settlement agreement 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). Paper 11. In the Amended Motion to Terminate, the parties “certify that this settlement agreement (Ex. 1067) represents the complete agreement, including all terms and conditions, between the parties and includes all (and there are no other) collateral agreements or understandings made in connection with, or in contemplation of, the termination of this proceeding as required by 35 U.S.C. § 317(b).” Paper 12, 1.

In consideration of the above, we agree that it is appropriate to terminate this proceeding without rendering a final written decision. 37 C.F.R. § 42.72.

It is, therefore,

ORDERED that the Amended Joint Motion to Terminate the proceeding is GRANTED and the proceeding is hereby terminated.

IPR2020-00209  
Patent 10,213,113 B2

For PETITIONER:

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

For PATENT OWNER:

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