

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC.
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS
Patent Owner

Case IPR2013-00604
Patent 7,087,073 B2

Before MICHAEL R. ZECHER and RICHARD E. RICE,
Administrative Patent Judges.

ZECHER, Administrative Patent Judge.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call in the above proceeding was held on January 7, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Zecher and Rice. The parties sought authorization to file a joint motion to terminate the proceeding on the basis that the parties have reached

a settlement.

Generally, 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). The rule governing settlement indicates that any agreement between the parties made in connection with, or in contemplation of, the termination of a proceeding shall be in writing and a true copy filed with the Board. 37 C.F.R. § 42.74(b).

During the conference call, the Board authorized the filing of a joint motion to terminate the proceeding. The Board also provided guidance as to the procedure for filing the parties' settlement agreement, as well as how to treat the settlement agreement as business confidential information under 37 C.F.R. § 42.74(c). The joint motion must: (1) include a brief explanation as to why termination is appropriate; (2) identify all defendants in any related district court litigation involving U.S. Patent No. 7,087,073 B2; and (3) discuss specifically the current status of the related litigation with respect to each party to the litigation. The joint motion to terminate must be accompanied by a true copy of the parties' settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). A redacted version of the settlement agreement will not be accepted as a true copy of the settlement agreement.

With respect to having the settlement agreement treated as business confidential information under 37 C.F.R. § 42.74(c), the parties must file the confidential settlement agreement electronically in the Patent Review Processing System ("PRPS") as an exhibit in accordance with the instructions provided on the Board's website (uploading as "Parties and

Board Only”). The parties are directed to FAQ G2 on the Board’s website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential.

In consideration of the foregoing, it is hereby

ORDERED that the parties are authorized to file a joint motion to terminate this proceeding;

FURTHER ORDERED that the joint motion is due by January 14, 2014;

FURTHER ORDERED that the joint motion must be accompanied by a true copy of the parties’ settlement agreement, as required by 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b). The true copy must be filed separately as an exhibit;

FURTHER ORDERED that, for the exhibit that is the settlement agreement filed in this proceeding, the parties may file a separate paper requesting that the settlement agreement be treated as business confidential information, as specified in 37 C.F.R. § 42.74(c); and

FURTHER ORDERED that any confidential settlement agreement must be filed electronically in PRPS in accordance with the instructions provided on the Board’s website (uploading as “Parties and Board Only”).

Case IPR2013-00604

Patent 7,087,073 B2

PETITIONER:

David L. Cavanaugh

Jacob S. Oyloe

WILMER CUTLER PICKERING HALE and DORR LLP

David.Cavanaugh@wilmerhale.com

Jacob.Oyloe@wilmerhale.com

PATENT OWNER:

Cary Kappel

William Gehris

Davidson, Davidson & Kappel, LLC

ckappel@ddkpatent.com

wgehris@ddkpatent.com