

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BOMTECH ELECTRONICS, CO. LTD.  
Petitioner

v.

MEDIUM-TECH MEDIZINGERÄTE GMBH  
Patent Owner

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Case IPR2014-00138  
Patent 6,505,530 B2

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Before KARL D. EASTHOM, BENJAMIN D. M. WOOD, and PHILIP J.  
HOFFMANN, *Administrative Patent Judges*.

EASTHOM, *Administrative Patent Judge*.

ORDER

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

Petitioner filed a Petition requesting an *inter partes* review of claims 1–20 of U.S. Patent No. 6,505,530 B2. Paper 3 (“Pet.”); Ex. 1002 (“the ’530 Patent”). Patent Owner filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). The panel instituted *inter partes* review on April 22, 2014. Paper 8.

On May 2, 2014, counsel for the parties and two members of the panel participated in a conference call. The parties informed the panel that they contemplate filing a settlement agreement to terminate the *inter partes* review trial and to seek dismissal of a related district court proceeding in which the ’530 Patent is asserted against Petitioner. *See* Ex. 1001 (patent infringement complaint: *Medium-Tech Medizingeräte GMBH v. Bomtech Electronics Co. Ltd.*, No. 1:13-cv-2933 (E.D.N.Y. filed May 17, 2013).

The parties sought guidance on filing their settlement agreement and terminating the Board proceeding. 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. 48,756, 48,768 (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 filed with the Board.<sup>1</sup> 37 C.F.R. § 42.74.

During the conference call, counsel for the respective parties represented that they agree to, and understand that they must, file a copy of their settlement

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<sup>1</sup> “*Proceeding* means a trial or preliminary proceeding.” 37 C.F.R. § 42.2.

agreement to terminate the proceeding. Counsel represented that they were prepared to file the settlement agreement and indicated that they may further request that the agreement be treated as business confidential information and be kept separate from the files of the involved patent. As discussed, such a request must be filed with the settlement agreement. 37 C.F.R. § 42.74(c). In furtherance of the discussion, the parties indicated that they were aware of FAQ G3 on the Board's website page at <http://www.uspto.gov/ip/boards/bpai/prps.jsp> for instructions on how to file their settlement agreement as confidential (*e.g.*, uploading as "Parties and Board Only"). Should a question arise regarding the confidential filing of the settlement agreement, the parties may contact the Board at 571-272-7822 for assistance.

Based on the facts of this proceeding, the parties are authorized to file, in addition to the confidential settlement agreement, a joint motion to terminate the proceeding briefly explaining why termination is appropriate in this case. Counsel agreed to file the joint motion to terminate and the settlement agreement within two weeks.

Accordingly, it is

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

**FURTHER ORDERED** that the joint motion is due by May 16, 2014; and

**FURTHER ORDERED** that the joint motion shall be accompanied by a true copy of the settlement agreement as required by 37 C.F.R. § 42.74(b);

**FURTHER ORDERED** that the parties may request that the settlement agreement be treated as business confidential information as specified by 37 C.F.R. § 42.74(c); and

**FURTHER ORDERED** that any confidential settlement agreement must be filed electronically via the Patent Review Processing System (PRPS) in accordance with the instructions provided on the Board's website (*e.g.*, uploading as "Parties and Board Only").

**FOR PETITIONER:**

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