

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMENIS LTD. and POLLOGEN LTD.,
Petitioners,

v.

THE GENERAL HOSPITAL CORPORATION,
Patent Owner.

IPR2019-01180 (Patent 9,095,357 B2)
IPR2019-01181 (Patent 9,510,899 B2)¹

Before SHERIDAN K. SNEDDEN, CHRISTOPHER G. PAULRAJ, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

DECISION

Dismissal of Petition; Termination of the Proceeding
37 C.F.R. § 42.71(a) and 37 C.F.R § 42.72

¹ We exercise our discretion to issue one Decision and Order to be filed in each case. The parties are not authorized to use this style of heading.

On July 26, 2019, the parties filed joint motions to dismiss the Petitions for inter partes review in two-related cases: IPR2019-01180 and IPR2019-01181. *See* Paper 5 (both cases). The parties have also filed what they indicate is a true copy of their written settlement agreement (Ex. 1028) “that resolves all underlying disputes between Petitioners and Patent Owner” related to the two patents—US 9,095,357 and US 9,510,800—challenged by Petitioners in these cases. *See id.* at 1–2.

The parties contend that, aside from the settlement of the underlying dispute over the challenged patents, other factors favor dismissing the Petitions. *See* Paper 5 (both cases), 3–5. According to the parties, the early stage of the cases (in the pre-institution phase) and conservation of Board resources also justify dismissal of the Petitions and termination of the proceedings. *Id.*

On July 26, 2019, the parties also filed joint requests that the settlement agreement (Ex. 1028) be treated as business confidential information and kept separate from the files of US 9,095,357 and US 9,510,800 pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c)(1)-(2). *See* Paper 6 (both cases), 1.

Under 37 C.F.R. § 42.71, the Board may take up petitions or motions for decisions in any order, and may “dismiss any petition” as appropriate. *Cf.* 35 U.S.C. § 317 (regarding settlement and termination of instituted proceedings upon joint request of the parties as appropriate). The above-captioned cases are at an early stage, as the Petitions were filed on June 6, 2019, and Patent Owner has not yet filed a Preliminary Response.

Further, under 37 C.F.R. § 42.74(b), “[a]ny agreement or understanding between the parties made in connection with, or in

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contemplation of, the termination of a proceeding shall be in writing and a true copy shall be filed with the Board before the termination of the trial.”

The parties have filed what they state is a true copy of their written settlement agreement (Ex. 1028). The parties also represent that “[t]here are no other agreements or understandings, oral or written, between the parties beyond those of Exhibit 1028 made in connection with, or in contemplation of, dismissal of Petitioners’ request[s] for *inter partes* review,” and “certify that they have complied with the requirements of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b).” *See* Paper 5 (both cases), 5. In view of the foregoing, we determine that it is appropriate to dismiss the Petitions and to terminate the proceedings (IPR2019-01180 and IPR2019-01181). 37 C.F.R. §§ 42.71, 42.72, 42.74.

As requested by the parties, the settlement agreement (Exhibit 1028) will be treated as business confidential information and kept separate from the patent files. 37 C.F.R. § 42.74(c).

Accordingly, it is

ORDERED that the parties’ Joint Motion to Dismiss Petition for *Inter Partes* Review (Paper 5) is *granted*;

FURTHER ORDERED that the parties’ Joint Request to File Settlement Agreement as Business Confidential Information (Paper 6) is *granted*; and

FURTHER ORDERED that this proceeding is hereby *terminated*.

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