

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATTENDS HEALTHCARE PRODUCTS, INC.,
Petitioner,

v.

PAUL HARTMANN AG,
Patent Owner.

IPR2020-01479 (Patent 8,771,249 B2)
IPR2020-01480 (Patent 8,708,990 B2)¹

Before PATRICK R. SCANLON, HYUN J. JUNG, and NEIL T. POWELL,
Administrative Patent Judges.

POWELL, *Administrative Patent Judge.*

TERMINATION
Due to Settlement After Remand
35 U.S.C. § 317; 37 C.F.R. § 42.74

¹ This Order applies to all of the captioned proceedings. These cases have not been consolidated or joined. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

I. INTRODUCTION

We issued a Final Written Decision for IPR2020-01479 on February 23, 2022, and for IPR2020-01480 on February 24, 2022. Paper 30. Patent Owner appealed the decision in each of the above-identified proceedings, and the United States Court of Appeals for the Federal Circuit vacated the Final Written Decision in each of the above-identified proceedings on March 4, 2024, and remanded the proceedings to the Board. Paper 33.

With the Board’s authorization, Petitioner and Patent Owner (collectively referred to as “the Parties”) filed a Joint Motion to Terminate the above-identified *inter partes* review proceedings due to settlement (“Joint Motion”) in each of the above-identified proceedings. Paper 39.² In support of the Joint Motion, the Parties filed a Settlement and License Agreement (Ex. 2008 (“Settlement Agreement”)), along with agreements referenced in the Settlement and License Agreement (Exs. 2009, 2010 (“Referenced Agreements”)), as well as a Joint Motion to Treat Settlement Agreement as Business Confidential Information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (Paper 40 (“Joint Request”)), in each of the above-identified proceedings.

II. DISCUSSION

Under 35 U.S.C. § 317(a), “[a]n *inter partes* review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed.” Section 35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.

² For expediency, we cite to the Papers filed in IPR2020-01479, unless otherwise indicated. Similar Papers and Exhibits were filed in IPR2020-01480.

IPR2020-01479 (Patent 8,771,249 B2)
IPR2020-01480 (Patent 8,708,990 B2)

For each of the above-identified proceedings, in the Joint Motion, the Parties represent that they have reached an agreement to jointly seek termination of *inter partes* review proceedings, and that the filed copies of the Settlement Agreement and Referenced Agreements are true copies. Joint Motion 1–2. The Parties confirm that “there are no other agreements (other than those filed with the Board), oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

The Parties have shown adequately that the termination of the proceedings is appropriate. Under these circumstances, we determine that good cause exists to terminate the proceedings with respect to the Parties.

For each of the above-identified proceedings, the Parties also filed joint requests to file the Settlement Agreement and Referenced Agreements as business confidential information and to keep the Settlement Agreement and Referenced Agreements separate from the files of the patents at issue. Joint Request 1–2. After reviewing the Settlement Agreement and Referenced Agreements between Petitioner and Patent Owner, we find that the Settlement Agreement and Referenced Agreements contain confidential business information regarding the terms of settlement. We determine that good cause exists to treat the Settlement Agreement and Referenced Agreements between Petitioner and Patent Owner as confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

This Order does not constitute a final written decision pursuant to 35 U.S.C. § 318(a).

III. ORDER

Accordingly, for the reasons discussed above, it is:

ORDERED that the Joint Motion to Terminate is *granted* in each of the above-identified proceedings, and IPR2020-01479 and IPR2020-01480 are

IPR2020-01479 (Patent 8,771,249 B2)

IPR2020-01480 (Patent 8,708,990 B2)

terminated pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72; and

FURTHER ORDERED that the Joint Motion to Treat Settlement Agreement as Business Confidential Information is *granted* in each of the above-identified proceedings, and the Settlement Agreement and Referenced Agreements shall be kept separate from the files of Patent 8,771,249 B2 and Patent 8,708,990 B2 and made available only to Federal Government agencies on written request, or to any person on a showing of good cause, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

IPR2020-01479 (Patent 8,771,249 B2)

IPR2020-01480 (Patent 8,708,990 B2)

For PETITIONER:

Eagle H. Robinson

Michael J. Pohl

Jeremy B. Albright

NORTON ROSE FULBRIGHT US LLP

eagle.robinson@nortonrosefulbright.com

michael.pohl@nortonrosefulbright.com

jeremy.albright@nortonrosefulbright.com

For PATENT OWNER:

Joshua L. Goldberg

Kathleen A. Daley

Justin E. Loffredo

FINNEGAN, HENDERSON, FARABOW,

GARRETT & DUNNER, LLP

joshua.goldberg@finnegan.com

kathleen.daley@finnegan.com

justin.loffredo@finnegan.com