

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LOMBARD MEDICAL TECHNOLOGIES PLC
Petitioner

v.

MEDTRONIC, INC.
Patent Owner

Case IPR2013-00269
Patent 6,306,141 B1

Before SALLY C. MEDLEY, STEPHEN C. SIU, and JOSIAH C. COCKS,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

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

Lombard Medical Technologies PLC (“Lombard”) filed a Petition for *inter partes* review on May 6, 2013. Patent Owner Medtronic, Inc. (Medtronic) filed a preliminary response on August 8, 2013. On October 17,

2013, a conference call was held between counsel for the respective parties and Judges Medley, Siu and Cocks.

The purpose of the conference call was to discuss a settlement agreement entered into by the parties. Counsel explained that the parties have a written settlement agreement which contemplates the termination of the *inter partes* review proceeding. 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.* 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 proceeding¹ shall be in writing and filed with the Board. 37 C.F.R. § 42.74.

Based on the facts of this proceeding, the parties were authorized to, and shall file, in addition to the confidential settlement agreement, a joint motion to terminate the proceeding briefly explaining why termination is appropriate in this case. As explained, the parties also must file, as an exhibit, a true copy of their settlement agreement to terminate the proceeding. Any request that the agreement be treated as business confidential information and be kept separate from the files of the involved patent must be filed with the settlement agreement. 37 C.F.R. § 42.74(c). The parties are directed to 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").

¹ A "proceeding" includes a preliminary proceeding. 37 C.F.R. § 42.2.

Counsel agreed to file the joint motion to terminate and the settlement agreement by close of business Monday, October 21, 2013.

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 October 21, 2013;
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").

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PETITIONER:

Steven D. Hemminger
Christopher B. Kelly
ALSTON & BIRD LLP
steve.hemminger@alston.com
chris.kelly@alston.com

PATENT OWNER:

Justin J. Oliver
Daniel S. Glueck
FITZPATRICK, CELLA, HARPER & SCINTO
MEDVASCIPR@fchs.com