

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COOK INC., COOK GROUP INC., and COOK MEDICAL LLC,  
Petitioner,

v.

MEDTRONIC, INC.,  
Patent Owner.

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Case IPR2019-00123  
Patent 6,306,141 B1

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Before JAMESON LEE, KEN B. BARRETT, and JAMES A. TARTAL,  
*Administrative Patent Judges.*

BARRETT, *Administrative Patent Judge.*

TERMINATION  
Due to Settlement After Institution of Trial  
*35 U.S.C. § 317; 37 C.F.R. § 42.74*

Petitioner and Patent Owner (collectively, “the parties”) have requested that the above-identified proceeding be terminated pursuant to a settlement. The Board authorized the parties to file a joint motion to terminate the proceeding on September 17, 2019.

On September 25, 2019, and pursuant to 35 U.S.C. § 317(a), the parties filed a Joint Motion to Terminate this proceeding (“Joint Motion to Terminate”) (Paper 16) and a Joint Request to file the settlement agreement as business confidential information and to be kept separate from the patent file pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) (“Joint Request”) (Paper 17), along with a copy of the written settlement agreement (Ex. 1035<sup>1</sup>).

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.” It is also provided in 35 U.S.C. § 317(a) that, if no petitioner remains in the *inter partes* review, the Office may terminate the review.

Additionally, 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). We instituted trial in this proceeding. Paper 11 (dated June 11, 2019). Thus, this proceeding is a trial subject to termination under 37 C.F.R. § 42.72. *See* 37 C.F.R. §42.72.

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<sup>1</sup> The parties initially filed the settlement agreement as a paper rather than as an exhibit. On September 26, 2019, the parties filed, at the Board’s request, the settlement agreement as an exhibit. The Board subsequently expunged the version initially filed as a paper.

We have not decided yet the merits of this proceeding, and a final written decision has not been entered in this proceeding. Notwithstanding that this proceeding has moved beyond the preliminary stage, the parties have shown adequately that the termination of this proceeding is appropriate. Under these circumstances, we determine that good cause exists to terminate this proceeding with respect to the parties.

The parties represent that Exhibit 1035 is a true and correct copy of the settlement agreement between the parties. Paper 16, 1. The parties state that they “further represent that there are no other agreements, oral or written, between the parties made in connection with, or in contemplation of, the termination of this proceeding.” *Id.*

Based on the facts of these proceedings, and in view of the parties’ Joint Motion to Terminate, we are persuaded that it is appropriate to terminate this proceeding with respect to both Petitioner and Patent Owner without rendering any further decisions. *See* 37 C.F.R. §§ 42.5(a), 42.72. Therefore, the Joint Motion to Terminate and the Joint Request to treat the settlement agreement as business confidential information are *granted*.

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

Accordingly, it is

ORDERED that the Joint Request that the settlement agreement (Ex. 1035) be treated as business confidential information and be kept separate from the files of the involved patent under the provisions of 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) is *granted*;

FURTHER ORDERED that the Joint Motion to Terminate this proceeding is *granted*; and

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FURTHER ORDERED that this proceeding is *terminated* with respect to both Petitioner and Patent Owner pursuant to 35 U.S.C. § 317(a) and 37 C.F.R. § 42.72.

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